

# **EXHIBIT A**



US006221.1.B1

(12) **United States Patent**  
**McClain**(10) **Patent No.:** **US 6,221,145 B1**  
(45) **Date of Patent:** **\*Apr. 24, 2001**(54) **METHOD OF PRODUCING AND AQUEOUS  
PAINT COMPOSITION FROM A PLURALITY  
OF PREMIXED COMPONENTS**(75) **Inventor:** **C. Daniel McClain, Tempe, AZ (US)**(73) **Assignee:** **Coating Management Systems, Inc.,  
Gilbert, AR (US)**(\*) **Notice:** This patent issued on a continued prosecution application filed under 37 CFR 1.53(d), and is subject to the twenty year patent term provisions of 35 U.S.C. 154(a)(2).

Subject to any disclaimer, the term of this patent is extended or adjusted under 35 U.S.C. 154(b) by 0 days.

(21) **Appl. No.:** **09/221,332**(22) **Filed:** **Dec. 23, 1998**(51) **Int. Cl.<sup>7</sup>** ..... **C09C 1/36; C09D 1/00**(52) **U.S. Cl.** ..... **106/443; 106/436; 106/447**(58) **Field of Search** ..... **106/443, 241,  
106/236, 445**(56) **References Cited****U.S. PATENT DOCUMENTS**

3,956,206 5/1976 Sellars et al. .... 260/17

4,373,930	2/1983	Rothwell .....	8/527
5,521,234	5/1996	Brown et al. ....	524/44
5,773,752	6/1998	Blume et al. ....	102/513
5,877,234 *	3/1999	Xu et al. ....	523/161
5,989,331 *	11/1999	Bauer et al. ....	106/444
6,074,474	6/2000	Broome et al. ....	106/486

**FOREIGN PATENT DOCUMENTS**

59-172559 9/1984 (JP) .

\* cited by examiner

*Primary Examiner*—Mark L. Bell*Assistant Examiner*—Michael J. DiVerdi(74) *Attorney, Agent, or Firm*—Schmeiser, Olsen & Watts;  
Albert L. Schmeiser(57) **ABSTRACT**

A process for producing water-based paint from a plurality of premixed compositions includes mixing at least two of a pigment composition, a dispersant thickening agent, a high resin content binder, and a low resin content binder. The pigment composition includes a pigment, water, a mixture of clay and silica, a viscosity controlling agent, and a dispersant thickener. The dispersant thickening agent includes a phosphate-based dispersant, water, a cellulosic thickener, and a coalescent.

**6 Claims, No Drawings**

# METHOD OF PRODUCING AND AQUEOUS PAINT COMPOSITION FROM A PLURALITY OF PREMIXED COMPONENTS

## BACKGROUND OF THE INVENTION

This invention relates to the production of an aqueous paint from a plurality of premixed compositions which include a pigment, a dispersant thickening agent, and low resin content and high resin content aqueous components.

The traditional manufacture of paint has utilized processes which continuously fill containers with a neutral or base color at the central facility. The containers are transported to the point of sale and stored until resale. The transport and storage in the individual containers adds significantly to the cost of the sold product for it is necessary to inventory a wide variety of paints having different finish characteristics to satisfy consumer demand. For example, the finishes offered for sale range from the traditional flat paint through varying resin compositions up to a high gloss finish. Inventory is maintained for all the different finishes at the point of sale by the merchant.

The manufacture of paint at the central facility can be either a batch process or an extended continuous mixing process. The process typically calls for mixing a pigment containing ground titanium dioxide along with a thickener, a viscosity controlling agent and resin added to the water base. The pigment composition is a composition with a high percentage of solids suspended in water. Storage for any significant period of time of a premixed pigment composition typically results in settling and a non-uniform distribution of constituents throughout the premix. Consequently, manufacturing process are designed to limit the residence time in premixing containers in order to promote the manufacture of more uniform products.

The present invention is directed to the provision of premixed aqueous compositions which can be used to provide a paint mixture of varying finish characteristics at the point of sale. Thus, the merchant distributing the paint composition made from the subject premixed compositions need only maintain inventory of four compositions. The particular compositions which are the subject of the invention exhibit stable characteristics during storage in their respective reservoirs.

## SUMMARY OF THE INVENTION

This process utilizes a plurality of aqueous compositions to provide the opportunity to mix the full range of finishes at the point of sale. The compositions include a pigment composition, a dispersant-thickening agent, a high resin content binder and a low resin content binder. From these four compositions, the process enables the seller to use from two to four of the premixed compositions to create flat, satin, low sheen, semi-gloss up to high gloss finishes. The pigment composition is common to all combinations and is characterized by the use of a combination dispersant-thickener, a mixture of clay and silica and a viscosity controlling agent along with water and finely-divided titanium dioxide.

The pigment composition contains the titanium dioxide in the range of 40 to 50 percent by weight and the water is about 25 percent by weight of the composition. The clay-silica mixture is about 15 percent and serves to maintain the suspension. The viscosity controlling agent is added at about 10 percent. The combination of dispersant and thickener is added at less than 5 percent and enables the premixed pigment composition to maintain a uniform distribution of the solid throughout its volume.

The second component is an aqueous composition used primarily as a dilutant and contains a dispersant, a thickener and a coalescent. The second component is combined with the pigment composition for all desired finishes with the exception of a high gloss finish. The high resin component is predominantly resin at about 80 percent. The low resin component contains more water with the resin in the 45 to 50 percent range. Between one and three components are combined with the pigment composition to provide the various finishes at the point of sale.

## DETAILED DESCRIPTION OF THE INVENTION

The present invention is directed to the provision of four premixed aqueous compositions that are sufficiently stable to be utilized at the point of sale to the user to generate a water-based paint composition having the desired finish characteristics. The process of mixing these compositions to develop paints ranging from a flat finish to a high gloss finish relies primarily on the pigment-containing premixed constituent since it is the one constituent that contains a high percentage of solids and is common to all paint compositions made in accordance with the present process.

The pigment-containing constituent central to the present process contains titanium dioxide finely ground in an amount residing within the range of 40 to 50 percent by weight of the premix dispersion. The ground titanium dioxide is a commercially available product used in a wide variety of paint compositions and its preparation techniques are well-known in the industry. The titanium dioxide is added to water which comprises about 25 percent of the resultant dispersion. During the blending process, a mixture of calcined clay and silica in an amount of 15 percent by weight is added to maintain the titanium dioxide in suspension. A viscosity controlling agent is also added in an amount of about 10 percent of the resultant premix dispersion.

In order to maintain the titanium dioxide in a uniform dispersion, a dispersant-thickener is added during blending in an amount of less than 5 percent of the dispersion. It has been found that the combination of a commercially-available dispersant supplemented by the addition of a phosphate-based dispersant such as potassium tri poly phosphate (KTPP) along with a modest amount of thickener enables the titanium dioxide pigment dispersion to remain uniform in distribution while stored.

The commercially available dispersant sold as BUSPERSE and manufactured by Buckman Chemicals is the primary dispersant and is added in amount of about 3.6 weight percent. In addition, the phosphate based dispersant KTPP is added in amount of about 0.2 weight percent to the dispersion. It is believed that the phosphate ions in this additive replace the carbonate and other ions in the water to enhance the wetting properties of the water and thereby promote the distribution of the titanium dioxide throughout. The thickener added is a cellulosic thickening agent. Several are commercially available for use in the manufacture of aqueous paint compositions. One example is the thickener sold under the trademark 481 by AKZO NOBEL (Sweden).

The novel combination of these additives to the combination of titanium dioxide and water in the stated proportions has been found to enable the aqueous pigment dispersion to be used at point of sale to generate the wide scope of paint products. In tests of the pigment dispersion stored in a 55 gallon reservoir without agitation for a period of 2 1/2 months, no discernible settling was noted. The addition of

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resin in an amount of about 5 percent of the dispersion has been found to aid in reducing the time for the resultant paint to cure. This factor is useful but tends to reduce the storage time of the pigment dispersion and is utilized only when a reduced curing time is important to the user.

At the point of sale, three additional premixed aqueous compositions are available to custom prepare the desired paint. Not all are utilized for each paint product. The second composition in terms of likely usage is a dispersant-thickening agent which serves as a dilutant. The second composition is predominantly water in an amount of about 93 percent by weight. There are three additional additives to the second composition. They include a phosphate-based dispersant such as the potassium tri poly phosphate used in the pigment composition in an amount of less than 1 percent. The phosphate-based dispersant is added along with approximately a like amount of a cellulosic thickener. The combination of dispersant and thickener acts in the same manner as with the pigment composition although it is to be noted that the amount of thickener is several times that used in the pigment composition. The additional additive is a coalescent in an amount of 4 to 5 weight percent. One commercial coalescent found suitable for use is sold under the trademark TEXANOL by Texaco.

The pigment composition and dispersant-thickener agent are intermixed when formulating all paint compositions with the exception of a high gloss finish paint composition. The third and fourth compositions available for mixing are the resin-containing compositions. The low resin composition is about 50 percent by weight and about 28 percent water. To this mixture of resin and water is added diatomaceous earth as a flattening agent in the amount of 7 percent and a combination of ground limestone and calcined clay at 11 percent and 3.5 percent respectively. The combination of a dispersant and thickener are added in the aggregate amount of about 1.2 percent to promote the same long shelf life characteristic evidenced by the pigment composition.

The high resin component contains resin in an amount of about 80 percent, water at about 15 percent and a commercially-available coalescent at about 2 percent. The amount of resin and water in the low and high resin compositions can be varied to achieve different finish characteristics. The resin utilized in the paint products formulated from the different combinations and found to provide the desired results is 6183 made by BASF. However, it is to be noted that other commercially available resins can be used if desired.

The four above-discussed formulations have been determined to be stable and free from settling when stored in reservoirs for extended periods. To produce a desired paint product, each storage reservoir is coupled through fluid pumps and appropriate valving to dispensing outlets with the discharge therefrom being directed into the point of sale container. The pigment composition is common to all products produced as stated previously. A flat finish product utilizes the pigment composition, the dispersant thickening agent and the low resin component. To produce the paint products referred to as eggshell, satin and low sheen finishes a portion of high resin component is concurrently added to the flat finish mixture. In the case of a desired semi-gloss finish paint, the high resin component is used as a replacement for the low resin component. A full gloss paint utilizes only the pigment composition and the high resin component. The actual balances between the components for the different finishes can be varied in accordance with the needs of the purchaser for a particular type of finish.

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Typical compositions suitable for programmed dispensing at the point of sale include the constituents in the weight percentages shown below:

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Finish	Pigment Composition	Disp-Thickening	Low Resin	High Resin
Flat	33.6	51.7	14.7	0
Satin	32.4	35.6	9.8	22.2
Semi Gloss	32.1	36.2	0	31.7
High Gloss	33.0	0	0	67.0

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While the above description has referred to the invention in terms of specific formulations, it is to be noted that variations and modifications may be made therein without departing from the scope of the invention as claimed.

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What is claimed is:

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1. An aqueous coating composition which includes the combination of a finely-divided pigment composition and a dispersant thickening agent wherein said pigment composition comprises:

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a) a pigment including titanium dioxide in the range of 40 to 50 percent;

b) water of about 25 percent;

c) a mixture of clay and silica of about 15 percent;

d) a viscosity controlling agent of about 10 percent; and

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e) a dispersant-thickener combination of less than 5 percent, said percentages being based on weight of the dispersion, and a dispersant thickening agent comprising:

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1) water in an amount of about 93 percent;

2) a phosphate-based dispersant in an amount of less than 1 percent;

3) a cellulosic thickener in an amount of about 1 percent; and

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4) a coalescent in an amount of 4 to 5 percent.

2. The coating composition of claim 1 wherein the dispersant-thickener of said pigment composition includes a phosphate-based dispersant.

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3. The coating composition of claim 2 wherein the phosphate-based dispersant is potassium tri poly phosphate.

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4. The process of producing an aqueous paint from a plurality of premixed aqueous compositions, said compositions comprising a pigment composition and compositions selected from the group consisting of a dispersant-thickening agent, a high resin content binder, a low resin content binder, and mixtures thereof, said process simultaneously or sequentially mixing the pigment composition with at least one of the other compositions wherein the pigment composition includes titanium dioxide in the range of 40 to 50 percent, water of about 25 percent, a mixture of clay and silica of about 15 percent, a viscosity controlling agent of about 10 percent, and a combination of dispersant and thickener in an amount of less than 5 percent, said percentages being based on weight of the pigment composition.

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5. The process of claim 4 wherein said combination of dispersant and thickener in said pigment composition includes a phosphate-based dispersant.

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6. The process of claim 5 wherein said phosphate-based dispersant is potassium tri poly phosphate.

\* \* \* \* \*

**Wood, Elizabeth**

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**From:** hclark@iplawusa.com

**Sent:** Thursday, January 29, 2004 1:07 PM

**To:** Wood, Elizabeth

**Subject:** Here are the Interference papers for 09/578,001 (Part 1)

They are in PDF format and I had to send it in 3 parts. Please make sure to print them in order. Please confirm you have received this email.

Thank you.

**Heather Clark**

Legal Assistant  
SCHMEISER, OLSEN & WATTS LLP  
18 E. University Dr. #101  
Mesa, AZ 85201  
Ph: 480-655-0073 Fx: 480-655-9536

PART 1 is below

## Response Transmittal

In re application of: McClain

Serial No.: 09/578,001

Filed: 05/24/00

For: **METHOD AND APPARATUS FOR PRODUCING AN  
AQUEOUS PAINT COMPOSITION FROM A  
PLURALITY OF PREMIXED COMPOSITIONS**

Mail Stop 313(c)  
Commissioner of Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Sir:

Transmitted herewith for filing in the above-identified Application is a:

1. Petition for Withdrawal from Issue
2. Interference;
3. Exhibits;
4. Associate Power of Attorney(s) forms; and
5. IDS with copies of cited art.

☒ The fee has been calculated as shown below:

(Col. 1)	(Col. 2)	(Col. 3)
CLAIMS REMAINING AFTER AMENDMENT		HIGHEST NO. PREVIOUSLY PAID FOR
TOTAL 241	MINUS	60 = 181
INDEPENDENT 29	MINUS	6 = 23
<input checked="" type="checkbox"/> PETITION TO WITHDRAWAL FROM ISSUE		
<input checked="" type="checkbox"/> REQUEST FOR CONTINUED EXAMINATION		

Small Entity	
RATE	ADDITIONAL FEE
x \$ 9.00=	\$1,629.00
x \$43.00=	\$ 989.00
\$130.00	\$ 130.00
\$385.00	\$ 385.00
Total	\$ 3,133.00

☒ ☒ A check in the amount of \$3,133.00 to cover fees is enclosed.

☒ ☒ The Commissioner is hereby authorized to charge payment of the following fees associated with this communication or credit any overpayment to Deposit Account No. 19-0513. A duplicate copy of this sheet is enclosed.

☒ ☒ Any additional filing fees required under 37 C.F.R. §1.16.

☒ ☒ Any patent application processing fees under 37 C.F.R. §1.17.

Date: October 7, 2003

Respectfully submitted,

Schmeiser, Olsen & Watts LLP  
18 East University Drive, #101  
Mesa, Arizona 85201  
Tel: (480) 655-0073

By Kenneth C. Booth  
Kenneth C. Booth  
Registration No.: 42,342

☐ CERTIFICATION OF FACSIMILE TRANSMISSION

I hereby certify that this paper is being facsimile transmitted to the Patent and Trademark Office on the date shown below.

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I hereby certify that I am depositing the enclosed or attached correspondence with the United States Postal Service as first class mail in an envelope addressed to Mail Stop 313(c), Commissioner of Patents, P.O. Box 1450, Alexandria, VA 22313-1450,

on October 7, 2003

Heather Clark  
Heather Clark

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

**REQUEST  
FOR  
CONTINUED EXAMINATION (RCE)  
TRANSMITTAL**Address to:  
Mail Stop RCE  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Application Number	09/578,001
Filing Date	05/24/2000
First Named Inventor	McClain
Art Unit	1755
Examiner Name	Elizabeth Wood
Attorney Docket Number	ROWL-9955

**This is a Request for Continued Examination (RCE) under 37 CFR 1.114 of the above-identified application.**  
Request for Continued Examination (RCE) practice under 37 CFR 1.114 does not apply to any utility or plant application filed prior to June 8, 1995, or to any design application. See Instruction Sheet for RCEs (not to be submitted to the USPTO) on page 2.

**1. Submission required under 37 CFR 1.114**

Note: If the RCE is proper, any previously filed unentered and amendments enclosed with the RCE will be entered in the order in which they were filed unless applicant instructs otherwise. If applicant does not wish to have any previously filed unentered amendment(s) entered, applicant must request non-entry of such

- a. ☐ Previously submitted. If a final Office action is outstanding, any amendments filed after the final Office action may be considered as a submission even if this box is not checked.
- i. ☐ Consider the arguments in the Appeal Brief or Reply Brief previously filed on \_\_\_\_\_
- ii. ☐ Other \_\_\_\_\_

**b. ☒ Enclosed**

- i. ☐ Amendment/Reply
- ii. ☐ Affidavit(s)/Declaration(s)
- iii. ☒ Information Disclosure Statement (IDS)
- iv. ☒ Other Interference, Petition, Assoc Power of Atty

**2. Miscellaneous**

- a. ☐ Suspension of action on the above-identified application is requested under 37 CFR 1.103(c) for a period of \_\_\_\_\_ months. (Period of suspension shall not exceed 3 months; Fee under 37 CFR 1.17(i) required)
- b. ☐ Other \_\_\_\_\_

**3. Fees** The RCE fee under 37 CFR 1.17(e) is required by 37 CFR 1.114 when the RCE is filed.

- a. ☒ The Director is hereby authorized to charge the following fees, or credit any overpayments, to Deposit Account No. 19-0513
- i. ☒ RCE fee required under 37 CFR 1.17(e)
- ii. ☐ Extension of time fee (37 CFR 1.136 and 1.17)
- iii. ☒ Other \$130 for Petition and \$2,618 for extra claims
- b. ☒ Check in the amount of \$ 3,133.00 enclosed
- c. ☐ Payment by credit card (Form PTO-2038 enclosed)

**WARNING: Information on this form may become public. Credit card information should not be included on this form. Provide credit card information and authorization on PTO-2038.**

**SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT REQUIRED**

Name (Print / Type)	Kenneth C. Booth	Registration No. (Attorney / Agent)	42,342
Signature	<i>Kenneth C. Booth</i>	Date	October 7, 2003

**CERTIFICATE OF MAILING OR TRANSMISSION**

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Name (Print / Type)	Heather Clark	Date	October 7, 2003
Signature	<i>Heather Clark</i>		

This collection of information is required by 37 CFR 1.114. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.14. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing the burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop RCE, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

If you need assistance in completing the form, call 1-800-PTO-9199 and select option 2.

**Associate Power Of Attorney Or Agent (37 CFR 1.34)  
(For Representation Related To A Patent Application)**

Docket No.  
**ROWL-9955**

In Re Application Of: **McClain, et al.**

Serial No.  
**09/578,001**

Filing Date  
**05/24/2000**

Examiner  
**Elizabeth D. Wood**

Group Art Unit  
**1755**

Invention: **METHOD AND APPARATUS FOR PRODUCING AN AQUEOUS PAINT COMPOSITION FROM A PLURALITY OF PREMIXED COMPOSITIONS**

**TO THE COMMISSIONER FOR PATENTS:**

Please recognize the following as ☐ Associate Attorney ☒ Associate Agent in this application.

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**Albert L. Schmeiser  
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Mesa, AZ 85201  
480-655-0073**

*Registration Number & Address of Principal Attorney or Agent of Record*

Dated: **October 3, 2003**

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*Signature of Person Mailing Correspondence*

**Heather Clark**

*Typed or Printed Name of Person Mailing Correspondence*

**Associate Power Of Attorney Or Agent (37 CFR 1.34)  
(For Representation Related To A Patent Application)**

Docket No.  
**ROWL-9955**

In Re Application Of: **McClain, et al.**

Serial No.  
**09/578,001**

Filing Date  
**05/24/2000**

Examiner  
**Elizabeth D. Wood**

Group Art Unit  
**1755**

Invention: **METHOD AND APPARATUS FOR PRODUCING AN AQUEOUS PAINT COMPOSITION FROM  
A PLURALITY OF PREMIXED COMPOSITIONS**

**TO THE COMMISSIONER FOR PATENTS:**

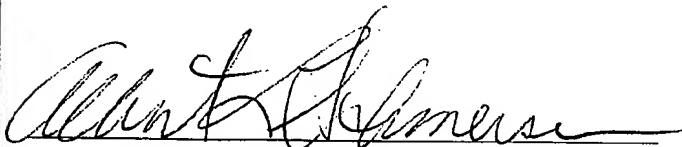
Please recognize the following as ☒ Associate Attorney ☐ Associate Agent in this application.

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Mesa, AZ 85201  
480-655-0073**

*Registration Number & Address of Principal Attorney or Agent of Record*

Dated: **October 3, 2003**

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22313-1450.



*Signature of Person Mailing Correspondence*

**Heather Clark**

*Typed or Printed Name of Person Mailing Correspondence*

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In re application of: McClain et al.

Serial No.: 09/578,001

Group No.: 1755

Filed: May 24, 2000

Examiner: Elizabeth D. Wood

For: METHOD AND APPARATUS FOR PRODUCING AN AQUEOUS PAINT COMPOSITION FROM A PLURALITY OF PREMIXED COMPOSITIONS

Date of mailing "Notice of Allowance and

Base Issue Fee Due" July 28, 2003

Batch No. \_\_\_\_\_

**Mail Stop 313(c)**

**Commissioner for Patents**

**P.O. Box 1450**

**Alexandria, VA 22313-1450**

*NOTE: Petitions to withdraw patent applications from issue (37 C.F.R. 1.313, M.P.E.P. § 1308) are decided by the Deputy Assistant Commissioner of Patents. M.P.E.P. § 1002(b). Letters requesting that the application be withdrawn from issue for purposes of interference with a patent (see M.P.E.P. § 1101.02(f) require the approval of the Group Director. M.P.E.P. § 1003.*

*WARNING: Papers requesting that an application be withdrawn from issue after the issue fee is paid, and any papers associated with the petition, including papers necessary for filing a continuing application, may be addressed as above or be hand-carried to the Office of Petitions, at Two Crystal Park, Suite 913, April 14, 1993, 1150 T.M.O.G. 27-28.*

**PETITION FOR WITHDRAWAL FROM ISSUE (37 C.F.R. 1.313)**

**PETITION**

1. Applicant hereby petitions for the immediate withdrawal of this application from issue under either 37 C.F.R. 1.313(c).

---

**CERTIFICATE OF MAILING/TRANSMISSION (37 C.F.R. 1.8(a))**

I hereby certify that, on the date shown below, this correspondence is being:

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X deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to the Commissioner for Patents, Alexandria, VA 22313.

**FACSIMILE**

☐ transmitted by facsimile to the Patent and Trademark Office.

Date: October 7, 2003

  
Signature

Heather Clark

(type or print name of person certifying)

## PATENT ISSUE FEE

2. The issue fee for this case

(complete (a) or (b))

- (a) ☐ has NOT been paid, but is due for payment on \_\_\_\_\_.
- (b) ☒ has been paid on August 8, 2003.

(complete the following, if known)

This application is scheduled to

- ☐ issue on \_\_\_\_\_
- ☐ as patent \_\_\_\_\_.

NOTE: "While the specific time period varies, an allowed application generally receives a patent number and issue date within two weeks after the issue fee is received in the Patent and Trademark Office." M.P.E.P. 1308.

## REASON(S) FOR WITHDRAWAL REQUEST

NOTE: "When the issue fee has been paid, the application will not be withdrawn from issue for any reason except: (1) A mistake on the part of the Office; (2) A violation of § 1.56, or illegality in the application; (3) Unpatentability of one or more claims; or (4) For interference." 37 C.F.R. 1.313(b).

3. The reason for the request for withdrawal from issue is:

(check applicable item(s) below)

- (a) ☐ there has been a mistake on the part of the Office.
- (b) ☐ there has been a violation of Section 1.56, or illegality in the application.
- (c) ☐ one or more of the claims are unpatentable.
- (d) ☒ for purposes of declaring an interference.
- (e) ☐ other.

Further details as to the reason(s) for this withdrawal request are set forth on the attached 1 sheet(s).

### PETITION FEES

*NOTE: The fee need only be paid, if the reason for withdrawal is not the fault of the Office. 37 C.F.R. 1.313(a).*

4. The petition fee (37 C.F.R. 1.17(i)) is paid as follows:

- ☒ Enclosed is a check in the sum of \$130.00.  
☐ Charge Account 19-0513 the sum of \$130.00.  
A duplicate of this petition is attached.

  
Signature of Practitioner

Reg. No.: 42,342

Kenneth C. Booth  
(type or print name of practitioner)

Tel. No.: (480) 655-0073

18 E. University Drive, Suite 101

Customer No.: ROWL-9955

Mesa, Arizona 85201-5946

Plus 1 Added Page

**PETITION FOR WITHDRAWAL FROM ISSUE (37 C.F.R. 1.313)**

**ADDED PAGE FOR REASON(S)**

Applicants request immediate withdrawal of the present application from issue under 37 C.F.R. 1.313(c) even though the issue fee has been paid because Applicants were not aware that an interference should have been provoked with interfering claims. Due to information, noted below, that has recently come to Applicants' attention, withdrawal of the present application from issue by the Patent Office under the initiative of the Applicants is hereby requested.

1. Applicant became aware of U.S. Patent No. 6,531,537 B2 having claims to the same invention as the present application.

A. The patent was issued March 11, 2003 (less than a year ago as required by 35 USC 135(a))

B. The present application was filed on May 24, 2000, before the pre-grant publication of the patent, which occurred on January 10, 2002. (Thus, the requirements of 35 USC 135(b) do not pertain to this application.)

C. Unless an Interference is provoked between the present application, with its May 24, 2000 filing date, and the issued claims of U.S. Patent No. 6,531,537 B2, Applicants will be significantly limited in their ability to provoke an interference with that patent because 35 USC 135(b) will impose significant restrictions on the claims that can be made in any other related application.

2. The issued claims in the patent could have been claimed in the present application.

A. Although Applicants have an earlier priority date by more than 1 year for the subject matter claimed by Patent No. 6,531,537 B2, the claims of the patent provide rights in that invention to another. Applicants' disclosure, though it uses slightly different language, discloses the same examples for its components and those in the issued patent.

3. There are no other related application(s) in which the patent claims could be presented without changing the thrust of those related applications. Furthermore, Applicants may be restricted from presentation of claims having the same or substantially the same subject matter in any related application under 35 USC 135(b) because all such related applications were filed or will be filed after the publication date of the patent. Alternatively stated, the present application is the only application that can avoid the requirement of 35 USC 135(b) by virtue of its filing date. In view of the nature and scope of the patent claims having an effective filing date more than one year after the effective filing date of the same subject matter in Applicants' application, Applicants need to provoke an interference in the present application with its 5/24/00 filing date.

Hence, Applicants hereby petition the commissioner to withdraw the present application from issue.

*(use additional pages, if necessary)*

Added Page 1

**INFORMATION DISCLOSURE STATEMENT PURSUANT TO**  
**37 C.F.R. §§1.97-1.99**

*PATENT APPLICATION*

Applicant: McClain, et al.

Docket No.: ROWL-9955

FOR: METHOD AND APPARATUS FOR PRODUCING AN AQUEOUS PAINT  
COMPOSITION FROM A PLURALITY OF PREMIXED COMPOSITIONS

Commissioner for Patents  
Mail Stop 313(c)  
P.O. Box 1450  
Alexandria, VA 22313-1450

Sir:

In accordance with the duty of disclosure under 37 C.F.R. §1.56 and pursuant to 37 C.F.R. §§1.97-1.99, Applicant(s) hereby notifies the U.S. Patent and Trademark Office of the documents listed on the attached Form PTO-1449. One copy of each cited document is submitted herewith. Applicant respectfully submits that all pending claims are patentable over the foregoing references, alone or in combination. The Examiner is requested to initial the enclosed Form PTO-1449 and return a copy thereof to the undersigned.

The submission of the listed documents is not intended as an admission that any such document constitutes prior art against the claims of the present application. Applicant reserves the right to dispute any of the listed documents as prior art during examination. Further, Applicant does not waive any right to take any action that would be appropriate to antedate or otherwise remove any listed document as a competent reference against the claims of the present application. Furthermore, the submission of this Information Disclosure Statement is not to be

construed as a representation that a search has been made or that no other material information may exist.

Respectfully submitted,

By Kenneth C. Booth

Date: October 7, 2003

Enclosures: PTO-1449  
Patent copies

ATTY. DOCKET NO.  
ROWL-9955

SERIAL NO.

**INFORMATION DISCLOSURE  
CITATION**

APPLICANT  
McClain, et al.

FILING DATE

GROUP

(Use several sheets if necessary)

**U. S. PATENT DOCUMENTS**

EXAMINER INITIAL	REF	DOCUMENT NUMBER	DATE	NAME	CLASS	SUB- CLASS	FILING DATE IF APPROPRIATE
		4,243,430	01/1981	Sperry, et al.			
		4,403,866	09/1983	Falcoff, et al.			
		4,436,845	03/1984	Kitano			
		5,078,302	01/1992	Hellenberg			
		5,129,551	07/1992	Gott			
		5,527,853	06/1996	Landy et al.			
		5,672,649	09/1997	Brock et al.			
		5,823,670	10/1998	Rushing et al.			
		5,842,641	12/1998	Mazzalveri			
		5,922,398	07/1999	Hermes et al.			
		6,013,721	01/2000	Schall et al.			
		6,308,499	10/2001	Takada et al.			

**FOREIGN PATENT DOCUMENTS**

	REF	DOCUMENT NUMBER	DATE	COUNTRY	CLASS	SUB- CLASS	TRANSLATION	
							YES	NO
	CA	935 255	10/1973					
	DE	39 10 472	10/1990					
	DE	197 14 577	10/1998					
	EP	0 614 951	9/1994					
	EP	0 706 543 B1	4/1996					
	EP	1 094 096	4/2001					
	IT	PS98A000005	2/1998					
	IT	PS98A000005	8/1999					
	WO	94/25238	11/1994					
	WO	95/29960	11/1995					
	WO	98/05417	2/1998					
	WO	00/37568	6/2000					
	WO	00/44834	8/2000					
	IE	940666	8/1994					

**OTHER DOCUMENTS (Including Author, Title, Date, Pertinent Pages, Etc.)**

	Patton, "Latex Critical Pigment Volume Concentration (LCPVC)", <i>Paint Flow and Pigment Dispersion</i> , 1979, p. 193.
	Forsius, "Paint Production by Component Mixing", <i>Faerg Lack Scand.</i> , 1997, 43(2), 5-6.
	Dutheillet, "Integrated Solution to Build Batch Processing Plants for Blending & Formulation Industries", <i>Chemical Engineering World</i> , 1997 32(5), 37-44.

		Orcun, et al., "Scheduling of Batch Processes: An Industrial Application in Paint Industry", <i>Computers Chem. Enng.</i> , 1997, 21, S673-S678.
		"Component Mixing - A New Approach to Customized Paint Production", <i>High Technology Finland</i> , 2000, 156-157.
		Helander, "Benefits of delayed product differentiation", <i>Reprinted from PPCJ</i> , 1999.
		Helander, "Impact of Form Postponement on Channel Members' Performance in Paint Business: A Theoretical Approach", <i>LTA</i> , 1999, p. 225-237.
<b>EXAMINER</b>		<b>DATE CONSIDERED</b>
<p><b>*EXAMINER:</b> Initial if citation considered, whether or not citation is in conformance with MPEP 609; Draw line through citation if not in conformance and not considered. Include copy of this form with next communication to applicant.</p>		

**IN THE UNITED STATES PATENT AND  
TRADEMARK OFFICE**

***AMENDMENT***

Applicant:	McClain	Docket No.:	ROWL-9955
Serial No.:	09/578,001	Group Art Unit:	1755
Filed:	05/24/2000	Examiner:	Wood, Elizabeth D.
TITLE:	METHOD AND APPARATUS FOR PRODUCING AN AQUEOUS PAINT COMPOSITION FROM A PLURALITY OF PREMIXED COMPOSITIONS		

**REQUEST BY APPLICANT FOR INTERFERENCE PURSUANT  
TO 37 C.F.R. § 1.604 & § 1.607  
AND AMENDMENT**

Mail Stop 313(c)  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Dear Sir:

This paper serves three purposes, namely: (1) to serve as a request for continued examination; (2) to amend the claims pending in the application; and (3) to request an Interference by Applicant pursuant to 37 C.F.R. § 1.604 and § 1.607. This paper is being filed in response to Applicants' becoming aware of interfering claims in an issued patent and in a pending application as set forth below. This amendment is accompanied by a petition to

withdraw the application from issue, and a request for continued examination for the same purpose. Applicants respectfully request entry of the amendment prior to further examination.

Applicants also request that the application be forwarded to the **Office of Petitions** to promptly begin the interference proceedings. An associate power of attorney making additional individuals of record is also included.

The following Table of Contents will aid the Examiner in identifying the various portions of this paper.

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### **I. NOTICE OF PETITION TO WITHDRAW FROM ISSUE**

A separate paper filed herewith includes a petition to withdraw from issue pursuant to 37 CFR 1.114 (c). The required fee of \$130.00 is included with this petition and amendment.

### **II. REQUEST FOR CONTINUED EXAMINATION UNDER 37 § CFR 1.114**

Applicants hereby request continued examination of the above referenced application under 37 CFR 1.114 (c) for the purpose of provoking an interference. The required fee of \$385.00 for the RCE and an additional fee of \$2,618.00 for additional claims. These fees together with the petition fee of \$130.00 for the accompanying petition require the total payment of \$3,133.00 included herewith.

### **III. REQUEST FOR INTERFERENCE**

Applicants hereby request the Office to provoke an interference proceeding between the above referenced application, U.S. patent No. 6,531,537 to Friel et al., and U.S. patent application publication No. 2002/0016405 pursuant to 37 CFR 1.607. Priority dates and other pertinent information are provided in the remarks section below.

#### **IV. AMENDMENTS TO THE SPECIFICATION**

Please substitute the following paragraphs for the paragraphs indicated by page and line number as follows:

On page 1, the paragraph beginning at line 13:

The traditional manufacture of paint has utilized processes which continuously fill containers with a neutral or base color at the central facility. The containers are transported to the point of use or point of sale and stored until use or resale. The transport and storage in the individual containers adds significantly to the cost of the sold product for it is necessary to inventory a wide variety of paints having different finish characteristics to satisfy consumer demand. For example, the finishes offered for sale range from the traditional flat paint through varying resin compositions up to a high gloss finish. Inventory is maintained for all the different finishes at the point of sale by the merchant.

On page 2, the paragraph beginning at line 11:

The present invention is directed to the provision of prepaints, which are fluid prepaint compositions or premixed aqueous compositions which can be used to provide a paint mixture of varying finish characteristics at the point of sale. Thus, the merchant distributing the paint composition made from the subject premixed compositions need only maintain inventory of four compositions. The particular compositions which are the subject of the invention exhibit stable characteristics during storage in their respective reservoirs.

On page 3, the paragraph beginning at line 15:

A method of producing an aqueous paint composition or fluid prepaint is also provided. The method includes storing a first premixed composition in a first supply reservoir. The first composition may be any one of four compositions, the four compositions including a pigment composition, a dispersant thickening agent, a high resin content binder, and a low resin content binder. The apparatus also includes a second supply reservoir containing a second premixed composition that is another of the four compositions. The method also includes storing a second premixed composition that is another of the four compositions in a second supply reservoir. The method determines a first predetermined amount of the first premixed composition and a second predetermined amount of the second premixed composition. The first premixed composition is supplied from the first supply reservoir to a receiving reservoir, and the second premixed composition is supplied from the second supply reservoir to the receiving reservoir. A first flow amount of the first premixed composition supplied from the first supply reservoir to the receiving reservoir and a second flow amount of the second premixed composition supplied from the second supply reservoir to the receiving reservoir are measured. Supply of the first premixed composition is ceased when the first flow amount equals the first predetermined amount and supply of the second premixed composition is ceased when the second flow amount equals the second predetermined amount.

On page 6, the paragraph beginning at line 19:

The pigment-containing constituent or premixed pigment composition preferably contains titanium dioxide finely ground in an amount residing within the range of 40 to 50 percent by weight of the pigment. The titanium dioxide is an opacifying pigment. The ground titanium dioxide is a commercially available product used in a wide variety of paint compositions and its preparation techniques are well-known in the industry. The titanium dioxide is added to water which comprises about 25 percent of the resultant pigment composition. During the blending process, a mixture of calcined clay and silica in an amount of 15 percent by weight is added to maintain the titanium dioxide in suspension. A viscosity controlling agent is also added in an amount of about 10 percent of the resultant dispersion or pigment composition.

On page 8, the paragraph beginning at line 20:

The dispersant-thickener agent is preferably used in formulating all paint compositions with the exception of a high gloss finish paint composition. The third and fourth compositions available for mixing are the resin-containing compositions. The low resin composition or extender prepaint is preferably about 50 percent resin by weight and about 28 percent water. However, the percentage of resin by weight can be as low as 10 percent. To this mixture of resin and water is added diatomaceous earth as a flattening agent or an extender pigment in the amount of about 7 percent and a combination of ground limestone and calcined clay at about 11 percent and about 3.5 percent respectively. The ground limestone, or calcium carbonate, is another example of an extender pigment. The combination of a dispersant and thickener are added in the aggregate amount of about 1.2 percent to promote the same long shelf life characteristic of the pigment composition.

On page 9, the paragraph beginning at line 5:

The high resin component preferably contains resin in an amount of about 80 percent, water at about 15 percent and a commercially-available coalescent at about 2 percent. However, the percentage of resin by weight can be as high as about 90 percent. The amount of resin and water in the low and high resin compositions can be varied to achieve different finish characteristics. The resin utilized in the paint products formulated from the different combinations and found to provide the desired results is a 100 percent acrylic acrynol resin, such as the resin sold under the trademark 6183 by BASF. This resin is polymeric and inherently produces a latex paint composition. However, it is to be noted that other commercially available resins can be used if desired.

On page 10, the paragraph beginning at line number 1:

The four compositions can also be varied to produce varying quality levels and to produce paint compositions that are suitable for either interior or exterior use and paint compositions having various color bases so that they are suitable for use as different types of colors. As is well known, a plurality of paint compositions or a paint line includes two or more different paint compositions in which the dried films differ materially from each other in at least one measurable property.

On page 11, the paragraph beginning at line 6:

All the foregoing examples are typical for retail quality paints suitable for exterior use with pastel colors. As can be appreciated from the disclosure provided herein, paint compositions may be provided by combining a set of two or more premixed compositions or prepaints.

## **V. AMENDMENTS TO THE CLAIMS**

Please cancel claims 1-86 and add the following new claims:

### **COUNT 1 - (Product –Prepaints and Paint Composition)**

- 1 87. (new) A set of different, but mutually compatible fluid prepaints, sufficient to form at least  
2 one paint line, which set comprises:
- 3 (i.) at least one opacifying prepaint comprising at least one opacifying pigment;
  - 4 (ii.) at least one extender prepaint comprising at least one extender pigment; and
  - 5 (iii.) at least one binder prepaint comprising at least one latex polymeric binder.
- 1 88. (new) A set of different, but mutually compatible aqueous prepaint compositions, sufficient  
2 to form at least one set of paint products, which set comprises:
- 3 (i.) at least one pigment prepaint composition comprising at least one opacifying  
4 pigment;
  - 5 (ii.) at least one extender prepaint composition comprising at least one extender agent; and
  - 6 (iii) at least one binder prepaint composition comprising at least one polymeric binder.
- 1 89. (new) A plurality of varied, but compatible premixed aqueous compositions, sufficient to  
2 form a variety of paint compositions, which plurality comprises:
- 3 (i) at least one premixed pigment composition provided as an aqueous solution  
4 comprising an opacifying pigment;
  - 5 (ii) at least one premixed low resin composition provided as an aqueous solution  
6 comprising a flattening agent; and
  - 7 (iii) at least one premixed a high resin composition provided as an aqueous solution  
8 comprising a resinous binder.
- 1 90. (new) The set of prepaints of claim 87, wherein the number of prepaints is 3 or more.

- 1 91. (new) The set of aqueous prepaint compositions of claim 88, wherein the number of  
2 prepaint compositions is 3 or more.
- 1 92. (new) The plurality of premixed aqueous compositions of claim 89, wherein the number of  
2 premixed compositions is 3 or more.
- 1 93. (new) The set of prepaints of claim 87, wherein the opacifying prepaint further comprises at  
2 least one particulate polymeric binder adsorbed onto the opacifying pigment.
- 1 94. (new) The set of aqueous prepaint compositions of claim 88, wherein the at least one  
2 pigment prepaint composition further comprises at least one particulate polymeric binder  
3 adsorbed onto the opacifying pigment.
- 1 95. (new) The plurality of premixed aqueous compositions of claim 89, wherein the premixed  
2 pigment composition further comprises at least one particulate resinous binder adsorbed onto the  
3 opacifying pigment.
- 1 96. (new) The set of prepaints of claim 87, wherein the extender prepaint further comprises at  
2 least one particulate polymeric binder absorbed onto the extender pigment.
- 1 97. (new) The set of aqueous prepaint compositions of claim 88, wherein the at least one  
2 extender prepaint composition further comprises at least one particulate polymeric binder  
3 absorbed onto the extender agent.
- 1 98. (new) The plurality of premixed aqueous compositions of claim 89, wherein the premixed  
2 low resin composition further comprises at least one particulate resinous binder absorbed onto  
3 the flattening agent.
- 1 99. (new) The set of prepaints of claim 87, wherein the extender prepaint has a PVC of about  
2 35% to about 100%.

1 100. (new) The set of aqueous prepaint compositions of claim 88, wherein the extender  
2 composition has a PVC of about 35% to about 100%.

1 101. (new) The plurality of premixed aqueous compositions of claim 89, wherein the premixed  
2 low resin composition has a PVC of about 35% to about 100%

1 102. (new) A paint line produced by a process which comprises the steps of:

2 (a.) providing a set of different, but mutually compatible, fluid prepaints, which set  
3 comprises:

4 (i.) at least one opacifying prepaint comprising at least one opacifying pigment,

5 (ii.) at least one extender prepaint comprising at least one extender pigment, and

6 (iii.) at least one binder prepaint comprising at least one latex polymeric binder;

7 and

8 (b.) dispensing a predetermined amount of each of the prepaints into containers to form  
9 the paint line.

1 103. (new) A paint line produced by a process which comprises the steps of:

2 (a) providing a set of different, but mutually compatible, prepaints compositions, which  
3 set comprises:

4 (i) at least one pigment prepaint composition as an aqueous solution comprising  
5 an opacifying pigment;

6 (ii) at least one low resin prepaint composition as an aqueous solution comprising  
7 a extender agent; and

8 (iii) at least one high resin prepaint composition as an aqueous solution  
9 comprising a polymeric binder; and

10 (b) dispensing a predetermined amount of each of the prepaint compositions into  
11 containers to form an aqueous paint composition of the paint line.

1 104. (new) A plurality of aqueous paint products produced by a process which comprises the  
2 steps of :

3 (a) providing a plurality of varied, but compatible premixed pigment compositions as an  
4 aqueous solution, which plurality of compositions comprises;

5 (i) at least one premixed pigment composition as an aqueous solution comprising  
6 an opacifying pigment;

7 (ii) at least one premixed a low resin composition as an aqueous solution  
8 comprising a flattening agent;

9 (iii) at least one premixed high resin composition as an aqueous solution  
10 comprising a resinous binder; and

11 (b) dispensing a predetermined amount of each of the premixed compositions into  
12 containers to form an aqueous paint product of the plurality of paint products.

1 105. (new) A set of different, but mutually compatible, fluid prepaints sufficient to formulate at  
2 least one paint line useful for forming pigmented and clear coatings, which set comprises:

3 (i) at least one prepaint comprising at least one opacifying pigment; and

4 (ii) at least two prepaints each of which comprises at least one latex polymeric binder.

1 106. (new) An plurality of different, but compatible fluid prepaint compositions sufficient to  
2 formulate a plurality of aqueous paint compositions useful for forming pigmented and clear  
3 coatings, which plurality of prepaint compositions comprising:

4 (i) at least one prepaint composition comprising an opacifying pigment; and

5 (ii) at least two prepaint compositions each of which comprises at least one polymeric  
6 binder.

1 107. (new) A plurality of different but compatible aqueous premixed compositions sufficient to  
2 formulate a plurality of paint products useful for forming pigmented coatings, which plurality of  
3 premixed compositions comprising:

4 (i) at least one premixed composition as an aqueous solution having an opacifying  
5 pigment;

6 (ii) at least two premixed compositions as aqueous solutions each of which comprises at  
7 least one resin containing binder.

1 108. (new) A method of forming at least one paint line, which method comprises the steps of:

2 (a) providing the set of prepaints of claim 105; and

3 (b) dispensing a predetermined amount of each of the prepaints into containers or  
4 applicators to form the paint line.

1 109. (new) A method of forming a plurality of aqueous paint compositions, which method  
2 comprises the steps of:

3 (a) providing a plurality of the prepaint compositions of claim 106; and

4 (b) dispensing a predetermined amount of each of the prepaint compositions into  
5 containers to form the plurality of paint compositions.

1 110. (new) A method of forming a plurality of paint products, which method comprises the  
2 steps of:

3 (a) providing a plurality of the premixed compositions of claim 107; and

4 (b) dispensing a predetermined amount of each of the premixed compositions into  
5 containers to form the plurality of paint products.

## COUNT 2 (Method of Producing a Paint Line)

- 1 111. (new) A method of forming at least one paint line, comprising the steps of:  
2 (a) providing a set of different, but mutually compatible, fluid prepaints, comprising:  
3 (i) at least one opacifying prepaint, comprising at least one opacifying pigment;  
4 (ii) at least one extender prepaint comprising at least one extender pigment; and  
5 (iii) at least one binder prepaint comprising at least one latex polymeric binder; and  
6 (b) dispensing a predetermined amount of each of the prepaints into containers or  
7 applicator(s) to form the paint line.
- 1 112. (new) A method of forming a plurality of paint products, comprising the steps of:  
2 (a) providing a set of varied, but mutually compatible aqueous prepaint compositions,  
3 comprising:  
4 (i) at least one pigment prepaint composition comprising an opacifying pigment;  
5 (ii) at least one extender prepaint composition comprising an extender agent; and  
6 (iii) at least one, binder prepaint composition comprising a polymeric binder; and  
7 (b) dispensing a predetermined amount of each of the prepaint compositions into  
8 containers to form the plurality of paint products.
- 1 113. (new) A method of forming a plurality of paint products comprising the steps of:  
2 (a) providing a plurality of varied, but compatible premixed aqueous compositions  
3 comprising:  
4 (i) at least one premixed pigment composition comprising an opacifying pigment;  
5 (ii) at least one premixed low resin composition comprising a flattening agent;  
6 (iii) at least one premixed high resin composition comprising a resin containing  
7 binder; and  
8 (b) dispensing a predetermined amount of each of the premixed compositions into  
9 containers to form the plurality of paint products.
- 1 114. (new) The method of claim 111, further comprising the step of mixing the prepaint before,  
2 while, or after they are dispensed into the containers.

- 1 115. (new) The method of claim 112, further comprising the step of mixing the prepaint  
2 compositions before, while, or after they are dispensed into the containers.
- 1 116. (new) The method of claim 113, further comprising the step of mixing the premixed  
2 compositions before, while, or after they are dispensed into the containers.
- 1 117. (new) The method of claim 111, further comprising the step of mixing the prepaint before  
2 or while they are dispensed into the applicator(s).
- 1 118. (new) The method of claim 112, further comprising the step of mixing the prepaint  
2 compositions before or while they are dispensed into the containers.
- 1 119. (new) The method of claim 113, further comprising the step of mixing the premixed  
2 compositions before or while they are dispensed into the containers.
- 1 120. (new) The method of claim 111, further comprising the step of adjusting the viscosity of  
2 the preprints before, while, or after they are dispensed into the containers.
- 1 121. (new) The method of claim 112, further comprising the step of adjusting the viscosity of  
2 the prepaint compositions before, while, or after they are dispensed into the containers.
- 1 122. (new) The method of claim 113, further comprising the step of adjusting the viscosity of  
2 the premixed compositions before, while, or after they are dispensed into the containers.
- 1 123. (new) The method of claim 111, further comprising the step of adjusting the viscosity of  
2 the dispensed preprints before or while they are dispensed into the applicator(s).
- 1 124. (new) The method of claim 112, further comprising the step of adjusting the viscosity of  
2 the prepaint compositions before or while they are dispensed into the containers.

- 1 125. (new) The method of claim 113, further comprising the step of adjusting the viscosity of  
2 the premixed compositions before or while they are dispensed into the containers.
- 1 126. (new) The method of claim 111, further comprising the step of adding at least one additive  
2 that enhances application or final performance of the paint.
- 1 127. (new) The method of claim 112, further comprising the step of adding at least one additive  
2 that enhances application or final performance of the paint products.
- 1 128. (new) The method of claim 113, further comprising the step of adding at least one additive  
2 that enhances application or final performance of the paint products.
- 1 129. (new) The method of claim 126, wherein the additive is a thickener.
- 1 130. (new) The method of claim 127, wherein the additive is a thickener.
- 1 131. (new) The method of claim 128, wherein the additive is a thickener.
- 1 132. (new) The method of claim 111, further comprising the step of adding at least one colorant  
2 to the prepaints.
- 1 133. (new) The method of claim 112, further comprising the step of adding at least one colorant  
2 to the prepaint compositions.
- 1 134. The method of claim 113, further comprising the step of adding at least one colorant to the  
2 premixed compositions.
- 1 135. (new) The method of claim 111, wherein the opacifying prepaint further comprises at least  
2 one particulate polymeric binder absorbed onto the opacifying pigment.

- 1 136. (new) The method of claim 112, wherein the pigment composition further comprises at  
2 least one particulate polymeric agent absorbed onto the opacifying pigment.
- 1 137. (new) The method of claim 113, wherein the pigment composition further comprises at  
2 least one particulate resin absorbed onto the opacifying pigment.
- 1 138. (new) The method of claim 111, wherein the extender prepaint further comprises at least  
2 one particulate polymeric binder absorbed onto the extender pigment.
- 1 139. (new) The method of claim 112, wherein the extender prepaint composition further  
2 comprises at least one particulate polymeric resin absorbed onto the extender agent.
- 1 140. (new) The method of claim 113, wherein the low resin composition further comprises at  
2 least one particulate resin binder absorbed onto the flattening agent.
- 1 141. (new) The method of claim 111, wherein the method is carried out at a paint manufacturing  
2 facility.
- 1 142. (new) The method of claim 112, wherein the method is carried out at a paint manufacturing  
2 facility.
- 1 143. (new) The method of claim 113, wherein the method is carried out at a paint manufacturing  
2 facility.
- 1 144. (new) The method of claim 111, wherein the number of prepaints is 4 or more.
- 1 145. (new) The method of claim 112, wherein the number of prepaint compositions is 4 or  
2 more.
- 1 146. (new) The method of claim 113, wherein the number of premixed compositions is 4 or  
2 more.

- 1 147. (new) The method of forming at least one paint line of claim 111 wherein the extender  
2 prepaint has a PVC of about 35% to about 100%.
- 1 148. (new) The method of forming a plurality of paint products claim 112, wherein the extender  
2 prepaint composition has a PVC of about 35% to about 100%.
- 1 149. (new) The method of forming a plurality of paint products claim 113, wherein the low resin  
2 composition has a PVC of about 35% to about 100%.
- 1 150. (new) The method of claim 111, wherein the method is carried out at the point-of-sale.
- 1 151. (new) The method of claim 112, wherein the method is carried out at the point-of-sale.
- 1 152. (new) The method of claim 113, wherein the method is carried out at the point-of-sale.
- 1 153. (new) The method of claim 111, wherein the method is carried out at the point-of-use.
- 1 154. (new) The method of claim 112, wherein the method is carried out at the point-of-use.
- 1 155. (new) The method of claim 113, wherein the method is carried out at the point-of-use.
- 1 156. (new) The method of claim 111, wherein the method is controlled by a computer.
- 1 157. (new) The method of claim 112, wherein the method is controlled by a computer.
- 1 158. (new) The method of claim 113, wherein the method is controlled by a computer.

1 159. (new) A method of forming a range of paints, the range comprising at least two paint lines,  
2 which method comprises the steps of:

3 (a) providing a set of different, but mutually compatible, fluid prepaints sufficient to  
4 formulate at least two paint lines, which set comprises:

5 (i) at least one opacifying prepaint, comprising at least one opacifying pigment;

6 (ii) at least one extender prepaint comprising at least one extender pigment;

7 (iii) at least one binder prepaint comprising at least one latex polymeric binder; and

8 (iv) at least one additional, different opacifying, extender, or binder prepaint selected  
9 from the group consisting of (i), (ii), and (iii); and

10 (b) dispensing a predetermined amount of each of the prepaints into containers or  
11 applicator(s) to form the range of paints.

1 160. (new) A method of forming a range of paint products, the range comprising variations in at  
2 least two of the paint products:

3 (a) providing a set of varied, but mutually compatible, aqueous prepaint compositions  
4 sufficient to formulate the at least two varied paint products, which set comprises:

5 (i) at least one pigment prepaint composition comprising an opacifying pigment;

6 (ii) at least one extender prepaint composition comprising an extender agent;

7 (iii) at least one, binder prepaint composition comprising a polymeric binder; and

8 (iv) at least one additional, different opacifying, extender, or binder prepaint

9 composition selected from the group consisting of (i), (ii), and (iii); and

10 (b) dispensing a predetermined amount of each of the prepaint compositions into  
11 containers to form the at least two of paint products.

1 161. (new) A method of forming a range of paint products, the range comprising variations in  
2 the plurality of the paint products:

3 (a) providing a plurality of varied, but compatible premixed aqueous compositions  
4 sufficient to formulate the at plurality of varied paint products, which plurality comprises:

5 (i) at least one premixed pigment composition comprising an opacifying pigment;

6 (ii) at least one premixed low resin composition comprising a flattening agent;

7 (iii) at least one premixed high resin composition comprising a resin containing  
8 binder; and

9 (iv) at least one additional, different premixed pigment, low resin, or high resin  
10 composition selected from the group consisting of (i), (ii), and (iii); and

11 (b) dispensing a predetermined amount of each of the premixed compositions into  
12 containers to form the plurality of paint products.

1 162. (new) The method of claim 159, further comprising the step of mixing the prepaint before,  
2 while, or after they are dispensed into the containers.

1 163. (new) The method of claim 160, further comprising the step of mixing the prepaint  
2 compositions before, while, or after they are dispensed into the containers.

1 164. (new) The method of claim 161, further comprising the step of mixing the premixed  
2 compositions before, while, or after they are dispensed into the containers.

1 165. (new) The method of claim 159, further comprising the step of mixing the prepaint before  
2 or while they are dispensed into the applicator(s).

1 166. (new) The method of claim 160, further comprising the step of mixing the prepaint  
2 compositions before or while they are dispensed into the containers.

1 167. (new) The method of claim 161, further comprising the step of mixing the premixed  
2 compositions before or while they are dispensed into the containers.

- 1 168. (new) The method of claim 159, further comprising the step of adjusting the viscosity of  
2 the prepaints before, while, or after they are dispensed into the containers.
- 1 169. (new) The method of claim 160, further comprising the step of adjusting the viscosity of  
2 the prepaint compositions before, while, or after they are dispensed into the containers.
- 1 170. (new) The method of claim 161, further comprising the step of adjusting the viscosity of  
2 the premixed compositions before, while, or after they are dispensed into the containers.
- 1 171. (new) The method of claim 159, further comprising the step of adjusting the viscosity of  
2 the dispensed prepaints before or while they are dispensed into the applicator(s).
- 1 172. (new) The method of claim 160, further comprising the step of adjusting the viscosity of  
2 the prepaint compositions before or while they are dispensed into the containers.
- 1 173. (new) The method of claim 161, further comprising the step of adjusting the viscosity of  
2 the premixed compositions before or while they are dispensed into the containers.
- 1 174. (new) The method of claim 159, further comprising the step of adding at least one additive  
2 that enhances application or final performance of the paint.
- 1 175. (new) The method of claim 160, further comprising the step of adding at least one additive  
2 that enhances application or final performance of the paint products.
- 1 176. (new) The method of claim 161, further comprising the step of adding at least one additive  
2 that enhances application or final performance of the paint products.
- 1 177. (new) The method of claim 174, wherein the additive is a thickener.
- 1 178. (new) The method of claim 175, wherein the additive is a thickener.

- 1 179. (new) The method of claim 176, wherein the additive is a thickener.
- 1 180. (new) The method of claim 159, further comprising the step of adding at least one colorant  
2 to the prepaints.
- 1 181. (new) The method of claim 160, further comprising the step of adding at least one colorant  
2 to the prepaint compositions.
- 1 182. The method of claim 161, further comprising the step of adding at least one colorant to the  
2 premixed compositions.
- 1 183. (new) The method of claim 159, wherein the opacifying prepaint further comprises at least  
2 one particulate polymeric binder absorbed onto the opacifying pigment.
- 1 184. (new) The method of claim 160, wherein the pigment composition further comprises at  
2 least one particulate polymeric agent absorbed onto the opacifying pigment.
- 1 185. (new) The method of claim 161, wherein the pigment composition further comprises at  
2 least one particulate resin absorbed onto the opacifying pigment.
- 1 186. (new) The method of claim 159, wherein the extender prepaint further comprises at least  
2 one particulate polymeric binder absorbed onto the extender pigment.
- 1 187. (new) The method of claim 160, wherein the extender prepaint composition further  
2 comprises at least one particulate polymeric resin absorbed onto the extender agent.
- 1 188. (new) The method of claim 161, wherein the low resin composition further comprises at  
2 least one particulate resin binder absorbed onto the flattening agent.
- 1 189. (new) The method of claim 159, wherein the method is carried out at a paint manufacturing  
2 facility.

- 1 190. (new) The method of claim 160, wherein the method is carried out at a paint manufacturing  
2 facility.
- 1 191. (new) The method of claim 161, wherein the method is carried out at a paint manufacturing  
2 facility.
- 1 192. (new) The method of claim 159, wherein the number of preprints is 4 or more.
- 1 193. (new) The method of claim 160, wherein the number of preprint compositions is 4 or  
2 more.
- 1 194. (new) The method of claim 161, wherein the number of premixed compositions is 4 or  
2 more.
- 1 195. (new) The method of forming at least one paint line of claim 159 wherein the extender  
2 preprint has a PVC of about 35% to about 100%.
- 1 196. (new) The method of forming a plurality of paint products claim 160, wherein the extender  
2 preprint composition has a PVC of about 35% to about 100%.
- 1 197. (new) The method of forming a plurality of paint products claim 161, wherein the low resin  
2 composition has a PVC of about 35% to about 100%.
- 1 198. (new) The method of claim 159, wherein the method is carried out at the point-of-sale.
- 1 199. (new) The method of claim 160, wherein the method is carried out at the point-of-sale.
- 1 200. (new) The method of claim 161, wherein the method is carried out at the point-of-sale.
- 1 201. (new) The method of claim 159, wherein the method is carried out at the point-of-use.
- 1 202. (new) The method of claim 160, wherein the method is carried out at the point-of-use.

- 1 203. (new) The method of claim 161, wherein the method is carried out at the point-of-use.
- 1 204. (new) The method of claim 159, wherein the method is controlled by a computer.
- 1 205. (new) The method of claim 160, wherein the method is controlled by a computer.
- 1 206. (new) The method of claim 161, wherein the method is controlled by a computer.

### COUNT 3 (A Pigmented Prepaint Composition)

1 207. (new) A fluid opacifying prepaint useful for formulating a one pack, pigmented latex paint  
2 having a volume solids content of about 30% to about 70% and a Stormer viscosity of about 50  
3 to about 250 KU, which prepaint contains other paint ingredients, which prepaint consists  
4 essentially of:

- 5 (i) at least one opacifying pigment,
- 6 (ii) at least one dispersant,
- 7 (iii) at least one thickener, and
- 8 (iv) water;

9 wherein the dispersant(s) and the thickener(s) are mutually compatible with the pigment(s) and  
10 with the other paint ingredients.

1 208. (new) A premixed aqueous pigment composition useful for formulating a one pack,  
2 pigmented aqueous paint composition having a volume solids content of about 30% to about  
3 70% and a Stormer viscosity of about 50 to about 250 KU, which premixed composition contains  
4 other paint ingredients, which premixed aqueous composition consists essentially of:

- 5 (i) at least one opacifying pigment,
- 6 (ii) at least one dispersant,
- 7 (iii) at least one thickener, and
- 8 (iv) water;

9 wherein the dispersant(s) and the thickener(s) are mutually compatible with the pigment(s) and  
10 with the other paint composition ingredients.

1 209. (new) The prepaint of claim 207, wherein the volume solids content is about 35% to about  
2 50% and the Stormer viscosity is about 60 to about 150 KU.

1 210. (new) The premixed aqueous pigment composition of claim 208, wherein the volume  
2 solids content is about 35% to about 50% and the Stormer viscosity is about 60 to about 150 KU.

1 211. (new) The prepaint of claim 207, wherein the opacifying pigment comprises titanium  
2 dioxide.

- 1 212. (new) The premixed aqueous pigment composition of claim 208, wherein the opacifying  
2 pigment comprises titanium dioxide.
- 1 213. (new) The prepaint of claim 207, wherein the dispersant comprises potassium  
2 tripolyphosphate.
- 1 214. (new) The premixed aqueous pigment composition of claim 208, wherein the dispersant  
2 comprises potassium tripolyphosphate.
- 1 215. (new) The prepaint of claim 207, wherein the thickener comprises a cellulosic.
- 1 216. (new) The premixed aqueous pigment composition of claim 208, wherein the thickener a  
2 cellulosic.
- 1 217. (new) The prepaint of claim 207, further consisting essentially of at least one additive  
2 comprising a coalescent, with the additive being present in an amount of less than about 10% by  
3 weight, based on the total weight of the prepaint.
- 1 218. (new) The premixed aqueous pigment composition of claim 208, further consisting  
2 essentially of at least one additive comprising a coalescent, with the additive being present in an  
3 amount of less than about 10% by weight, based on the total weight of the premixed aqueous  
4 pigment composition.
- 1 219. (new) A set of two different, but mutually compatible fluid prepaints useful for formulating  
2 a latex paint, which set comprises:  
3 (a) the opacifying prepaint of claim 207; and  
4 (b) a latex polymeric binder prepaint having volume solids content of about 25% to about  
5 70% or a Brookfield viscosity of less than about 100,000 centipoise at a shear rate of  
6 1.25 reciprocal seconds, which prepaint consists essentially of a water-borne latex  
7 polymeric binder having a Tg of about -430 degrees C. to about 70 degrees C. and  
8 water;  
9 wherein the prepaint ingredients are mutually compatible with each other and with the  
10 ingredients of the other prepaint in the set.

1 220. (new) A set of two different, but mutually compatible premixed aqueous compositions  
2 useful for formulating an aqueous paint composition, which set comprises:

3 (a) the premixed aqueous pigment composition of claim 208; and

4 (b) a premixed polymeric binder composition having volume solids content of about 25%  
5 to about 70% or a Brookfield viscosity of less than about 100,000 centipoise at a  
6 shear rate of 1.25 reciprocal seconds, which binder composition consists  
7 essentially of a water-borne resin containing binder having a Tg of about -430  
8 degrees C. to about 70 degrees C. and water;

9 wherein the ingredients of the premixed compositions are mutually compatible with each other  
10 and with the ingredients of the other premixed compositions in the set.

1 221. (new) The set of prepaints of claim 219, wherein the binder prepaint has a volume solids  
2 content of about 30 to about 65% and a Brookfield viscosity of about 100 to about 50,000  
3 centipoise at a shear rate of 1.25 reciprocal seconds, and consists essentially of a water-borne  
4 polymeric binder having a Tg of about -10 to about 60 degrees C.

1 222. (new) The set of premixed aqueous compositions of claim 220, wherein the premixed  
2 binder composition has a volume solids content of about 30 to about 65% and a Brookfield  
3 viscosity of about 100 to about 50,000 centipoise at a shear rate of 1.25 reciprocal seconds, and  
4 consists essentially of a water-borne resin containing binder having a Tg of about -10 to about 60  
5 degrees C.

1 223. (new) The set of prepaints of claim 219, wherein the binder prepaint further consists  
2 essentially of at least one additive comprising a coalescent, the additive being present in an  
3 amount of less than about 10% by weight, based on the total weight of the binder prepaint.

1 224. (new) The set of premixed aqueous compositions of claim 220, wherein the premixed  
2 binder composition further consists essentially of at least one additive comprising a coalescent,  
3 the additive being present in an amount of less than about 10% by weight, based on the total  
4 weight of the premixed binder composition.

1 225. (new) A set of three different, but mutually compatible, fluid prepaints, useful for  
2 formulating a latex paint, which set comprises:  
3 (a) the set of prepaints of claim 219; and  
4 (b) a fluid pigment extender prepaint which consists essentially of:  
5 (i) at least one mineral extender,  
6 (ii) at least one thickener,  
7 (iii) water, and  
8 (iv) optionally a polymeric binder;  
9 wherein the binder prepaint has a volume solids content of about 30% to about 70%, a PVC of  
10 about 35% to about 100%, and a Stormer viscosity of about 50 to about 250 KU.

1 226. (new) A set of three different, but mutually compatible, premixed aqueous compositions,  
2 useful for formulating a paint product, which set comprises:  
3 (a) the set of premixed compositions of claim 220; and  
4 (b) a premixed aqueous pigment extender composition which consists essentially of:  
5 (i) at least calcined clay,  
6 (ii) at least one thickener,  
7 (iii) water, and  
8 (iv) optionally a resin containing binder;  
9 wherein the premixed binder composition has a volume solids content of about 30% to about  
10 70%, a PVC of about 35% to about 100%, and a Stormer viscosity of about 50 to about 250 KU.

1 227. (new) The set of prepaints of claim 225, wherein the extender prepaint has a volume solids  
2 content of about 35% to about 65%, a PVC of about 40% to about 100% and a Stormer viscosity  
3 of about 60 to about 150 KU.

1 228. (new) The set of premixed aqueous compositions of claim 226, wherein the premixed  
2 aqueous extender composition has a volume solids content of about 35% to about 65%, a PVC of  
3 about 40% to about 100% and a Stormer viscosity of about 60 to about 150 KU.

1 229. (new) The set of prepaints of claim 219, wherein the binder prepaint further consists  
2 essentially of at least one additive comprising a coalescent, with the additive being present in an  
3 amount of less than about 20% by weight, based on the total weight of the binder prepaint.

1 230. (new) The set of premixed aqueous compositions of claim 220, wherein the premixed  
2 binder composition further consists essentially of at least one additive comprising a coalescent,  
3 with the additive being present in an amount of less than about 20% by weight, based on the total  
4 weight of the premixed binder composition.

1 231. (new) A fluid white opacifying prepaint having a volume solids content of about 30% to  
2 about 70%, a PVC of about 35% to about 100%, and a Stormer viscosity of about 50 to about  
3 250 KU, useful for formulating a one pack, pigmented latex paint containing other paint  
4 ingredients, which prepaint consists essentially of:

- 5 (i) at least one opacifying pigment,
- 6 (ii) at least one dispersant,
- 7 (iii) at least one thickener,
- 8 (iv) at least one film-forming or non-film-forming polymer, and
- 9 (v) water; wherein the dispersant(s), the thickener(s), and the polymer(s) are compatible  
10 with the pigment(s) and with the other paint ingredients and wherein the prepaint is  
11 stable to sedimentation.

1 232. (new) A premixed aqueous pigment composition having a volume solids content of about  
2 30% to about 70%, a PVC of about 35% to about 100%, and a Stormer viscosity of about 50 to  
3 about 250 KU, useful for formulating a one pack, pigmented aqueous paint product containing  
4 other paint ingredients, which premixed aqueous composition consists essentially of:

- 5 (i) at least one opacifying pigment,
- 6 (ii) at least one dispersant,
- 7 (iii) at least one thickener,
- 8 (iv) at least one film-forming or non-film-forming resin, and
- 9 (v) water; wherein the dispersant(s), the thickener(s), and the polymer(s) are compatible  
10 with the pigment(s) and with the other premixed aqueous composition ingredients  
11 and wherein the premixed aqueous composition is stable to sedimentation.

- 1 233. (new) The prepaint of claim 231, wherein the volume solids content is about 35% to about  
2 50%, the PVC is about 50 to about 100%, and the Stormer viscosity is about 60 to about 150 KU.
- 1 234. (new) The premixed composition of claim 232, wherein the volume solids content is about  
2 35% to about 50%, the PVC is about 50 to about 100%, and the Stormer viscosity is about 60 to  
3 about 150 KU.
- 1 235. (new) The prepaint of claim 231, wherein the polymer is adsorbed onto the opacifying  
2 pigment.
- 1 236. (new) The premixed resin composition of claim 232, wherein the resin is adsorbed onto the  
2 opacifying pigment.
- 1 237. (new) The prepaint of claim 231, wherein the opacifying pigment comprises titanium  
2 dioxide.
- 1 238. (new) The premixed composition of claim 232, wherein the opacifying pigment comprises  
2 titanium dioxide.
- 1 239. (new) The prepaint of claim 231, wherein the dispersant comprises potassium  
2 tripolyphosphate.
- 1 240. (new) The premixed composition of claim 232, wherein the dispersant comprises  
2 potassium tripolyphosphate.
- 1 241. (new) The prepaint of claim 231, wherein the thickener comprises a cellulosic.
- 1 242. (new) The premixed composition of claim 232, wherein the thickener comprises a  
2 cellulosic.
- 1 243. (new) The prepaint of claim 231, wherein the polymer comprises an acrylic polymer.
- 1 244. (new) The premixed composition of claim 232, wherein the resin comprises an acrylic  
2 resin.

- 1 245. (new) The prepaint of claim 231, further consisting essentially of at least one additive  
2 comprising a coalescent, with the additive being present in an amount of less than about 10% by  
3 weight, based on the total weight of the prepaint.
- 1 246. (new) The premixed composition of claim 232, further consisting essentially of at least one  
2 additive comprising a coalescent, with the additive being present in an amount of less than about  
3 10% by weight, based on the total weight of the premixed composition.
- 1 247. (new) A set of two different, but mutually compatible fluid prepaints useful for formulating  
2 a latex paint, which set comprises:  
3 (a) the opacifying prepaint of claim 231; and  
4 (b) a latex polymeric binder prepaint having volume solids content of about 25% to about  
5 70% or a Brookfield viscosity of less than about 100,000 centipoise at a shear rate  
6 of 1.25 reciprocal seconds, which binder prepaint consists essentially of a water-  
7 borne latex polymeric binder having a Tg of about -430 degrees C. to about 70  
8 degrees C. and water;  
9 wherein the prepaint ingredients are mutually compatible with each other and with the  
10 ingredients of the other prepaint in the set.
- 1 248. (new) A set of two different, but mutually compatible premixed aqueous compositions  
2 useful for formulating a paint composition, which set comprises:  
3 (a) the premixed pigment composition of claim 232; and  
4 (b) a premixed polymeric binder composition having volume solids content of about 25%  
5 to about 70% or a Brookfield viscosity of less than about 100,000 centipoise at a  
6 shear rate of 1.25 reciprocal seconds, which premixed binder composition consists  
7 essentially of a water-borne resin containing binder having a Tg of about -430  
8 degrees C. to about 70 degrees C. and water;  
9 wherein the ingredients of the premixed compositions are mutually compatible with each other  
10 and with the ingredients of the other premixed compositions in the set.

1 249. (new) The set of prepaints of claim 247, wherein the binder prepaint has a volume solids  
2 content of about 30 to about 65% and a Brookfield viscosity of about 100 to about 50,000  
3 centipoise at a shear rate of 1.25 reciprocal seconds, and consists essentially of a water-borne  
4 polymeric binder having a Tg of about -10 to about 60 degrees C.

1 250. (new) The set of premixed compositions of claim 248, wherein the premixed binder  
2 composition has a volume solids content of about 30 to about 65% and a Brookfield viscosity of  
3 about 100 to about 50,000 centipoise at a shear rate of 1.25 reciprocal seconds, and consists  
4 essentially of a water-borne resin containing binder having a Tg of about -10 to about 60 degrees  
5 C.

1 251. (new) The set of prepaints of claim 247, wherein the binder prepaint further consists  
2 essentially of at least one additive comprising a coalescent, the additive being present in an  
3 amount of less than about 10% by weight, based on the total weight of the binder prepaint.

1 252. (new) The set of premixed compositions of claim 248, wherein the premixed binder  
2 composition further consists essentially of at least one additive comprising a coalescent, the  
3 additive being present in an amount of less than about 10% by weight, based on the total weight  
4 of the premixed binder composition.

1 253. (new) A set of three different, but mutually compatible, fluid prepaints, useful for  
2 formulating a latex paint, which set comprises:

3 (a) the set of prepaints of claim 247; and

4 (b) a fluid pigment extender prepaint which consists essentially of:

5 (i) at least one mineral extender,

6 (ii) at least one thickener,

7 (iii) water, and

8 (iv) optionally a polymeric binder;

9 wherein the binder prepaint has a volume solids content of about 30% to about 70%, a PVC of  
10 about 35% to about 100%, and a Stormer viscosity of about 50 to about 250 KU.

1 254. (new) A set of three different, but mutually compatible, premixed aqueous compositions,  
2 useful for formulating a paint product, which set comprises:

3 (a) the set of premixed compositions of claim 248; and

4 (b) a premixed aqueous pigment extender composition which consists essentially of:

5 (i) at least calcined clay,

6 (ii) at least one thickener,

7 (iii) water, and

8 (iv) optionally a resin containing binder;

9 wherein the premixed binder composition has a volume solids content of about 30% to about  
10 70%, a PVC of about 35% to about 100%, and a Stormer viscosity of about 50 to about 250 KU.

1 255. (new) The set of prepaints of claim 253, wherein the extender prepaint has a volume solids  
2 content of about 35% to about 65%, a PVC of about 40% to about 100% and a Stormer viscosity  
3 of about 60 to about 150 KU.

1 256. (new) The set of premixed aqueous compositions of claim 254, wherein the premixed  
2 extender composition has a volume solids content of about 35% to about 65%, a PVC of about  
3 40% to about 100% and a Stormer viscosity of about 60 to about 150 KU.

1 257. (new) The set of prepaints of claim 247, wherein the binder prepaint further consists  
2 essentially of at least one additive comprising a coalescent, with the additive being present in an  
3 amount of less than about 20% by weight, based on the total weight of the binder prepaint.

1 258. (new) The set of premixed aqueous compositions of claim 248, wherein the premixed  
2 binder composition further consists essentially of at least one additive comprising a coalescent,  
3 with the additive being present in an amount of less than about 20% by weight, based on the total  
4 weight of the premixed binder composition.

#### **COUNT 4 (A Pigment Extender Prepaint Composition)**

1 259. (new) A fluid pigment extender prepaint, useful for formulating a one pack, pigmented  
2 latex paint containing other paint ingredients, which prepaint consists essentially of:

- 3 (i) at least one mineral extender having a volume solids content of about 30% to about  
4 70%, a PVC of about 35% to about 100%, and a Stormer viscosity of about 50 to  
5 about 250 KU;
- 6 (ii) at least one thickener,
- 7 (iii) water, and
- 8 (iv) an optional polymeric binder; wherein the prepaint ingredients are compatible with  
9 each other and with the ingredients of the paint.

1 260. (new) A premixed aqueous pigment extender composition, useful for producing a  
2 pigmented aqueous paint product containing other paint ingredients, which premixed  
3 composition consists essentially of:

- 4 (i) at least one calcined clay having a volume solids content of about 30% to  
5 about 70%, a PVC of about 35% to about 100%, and a Stormer viscosity of about  
6 50 to about 250 KU;
- 7 (ii) at least one thickener,
- 8 (iii) water, and
- 9 (iv) an optional polymeric resin containing binder; wherein the premixed  
10 composition ingredients are compatible with each other and with the ingredients  
11 of the paint product.

**COUNT 1 - (Product—Prepaints and Paint Composition)**

1 261. A plurality of premixed aqueous compositions for forming an aqueous paint composition,  
2 the plurality of compositions comprising:  
3 a premixed pigment composition provided as an aqueous solution having an opacifying  
4 pigment;  
5 a premixed low resin composition provided as an aqueous solution having a flattening  
6 agent; and  
7 a premixed a binder composition provided as an aqueous solution having a resin;  
8 wherein mixing a portion of the pigment composition with a portion of at least one of the low  
9 resin composition and the binder composition produces the aqueous paint composition from the  
10 premixed compositions.

1 262. The plurality of premixed aqueous compositions of claim 261, wherein the number of  
2 premixed compositions is 3 or more.

1 263. The plurality of premixed aqueous compositions of claim 261, wherein the premixed  
2 pigment composition further comprises at least one resin adsorbed onto the opacifying pigment.

1 264. The plurality of premixed aqueous compositions of claim 261, wherein the premixed low  
2 resin composition further comprises at least one particulate resin absorbed onto the flattening  
3 agent.

1 265. The plurality of premixed aqueous compositions of claim 261, wherein the premixed low  
2 resin composition has a PVC of about 35% to about 100%.

1 266. An aqueous paint product made by a method comprising:  
2 premixing an pigment composition as an aqueous solution having an opacifying pigment;  
3 premixing a low resin composition as an aqueous solution having a flattening agent;  
4 premixing a binder composition as an aqueous solution having a resin; and  
5 mixing a portion of the pigment composition with a portion of at least one of the low  
6 resin composition and the binder composition to produce an aqueous paint  
7 composition from the premixed compositions.

1 267. An aqueous paint composition comprising:  
2 a premixed pigment composition as an aqueous solution having an opacifying pigment;  
3 a premixed low resin composition as an aqueous solution having a flattening agent;  
4 a premixed binder composition as an aqueous solution having a resin; and  
5 a portion of the pigment composition mixed with a portion of at least one of the low resin  
6 composition and the binder composition to produce the aqueous paint  
7 composition from the premixed compositions.

1 268. A method of forming a plurality of paint products, which method comprises the steps of:  
2 (a) providing a plurality of the premixed compositions of claim 267; and  
3 (b) dispensing a predetermined amount of each of the premixed compositions into  
4 containers to form the plurality of paint products.

**COUNT 2 (Method of Producing a Paint Line)**

1 269. A method of producing a plurality of aqueous paint products, the method comprising:  
2 premixing an opacifying pigment composition as an aqueous solution having an  
3 opacifying pigment;  
4 premixing a low resin composition as an aqueous solution having a flattening agent;  
5 premixing a binder composition as an aqueous solution having a resin; and  
6 mixing a portion of the pigment composition with a portion of at least one of the low resin  
7 composition and the binder composition in containers to produce an aqueous paint product of the  
8 plurality of paint products from the premixed compositions.

1 270. The method of claim 269, further comprising the step of mixing the premixed compositions  
2 before, while, or after they are dispensed into the containers.

1 271. The method of claim 269, further comprising the step of mixing the premixed compositions  
2 before or while they are dispensed into the containers.

1 272. The method of claim 269, further comprising the step of adjusting the viscosity of the  
2 premixed compositions before, while, or after they are dispensed into the containers.

1 273. The method of claim 269, further comprising the step of adjusting the viscosity of the  
2 premixed compositions before or while they are dispensed into the containers.

1 274. The method of claim 269, further comprising the step of adding at least one additive that  
2 enhances application or final performance of the aqueous paint product.

1 275. The method of claim 274, wherein the additive is a thickener.

1 276. The method of claim 269, further comprising the step of adding at least one colorant to the  
2 premixed compositions.

- 1 277. The method of claim 269, wherein the opacifying pigment composition further comprises at  
2 least one resin absorbed onto the opacifying pigment.
- 1 278. The method of claim 269, wherein the low resin composition further comprises at least one  
2 resin absorbed onto the flattening agent.
- 1 279. The method of claim 269, wherein the method is carried out at a paint manufacturing  
2 facility.
- 1 280. The method of claim 269, wherein the number of premixed compositions is 4 or more.
- 1 281. The method of claim 269, wherein the low resin composition has a PVC of about 35% to  
2 about 100%.
- 1 282. The method of claim 269, wherein the method is carried out at the point-of-sale.
- 1 283. The method of claim 269, wherein the method is carried out at the point-of-use.
- 1 284. The method of claim 269, wherein the method is controlled by a computer.
- 1 285. A method of producing variations of a plurality of aqueous paint products, the method  
2 comprising:  
3 (i) premixing an opacifying pigment composition as an aqueous solution having an  
4 opacifying pigment;  
5 (ii) premixing a low resin composition as an aqueous solution having a flattening agent;  
6 (iii) premixing a binder composition as an aqueous solution having a resin; and  
7 (iv) premixing an additional different premixed composition from the group consisting  
8 of the compositions of (i), (ii), and (iii); and  
9 mixing a portion of the pigment composition with a portion of at least one of the low resin  
10 composition and the binder composition in containers to produce an aqueous paint product of the  
11 variations of the plurality of paint products from the premixed compositions.

- 1 286. The method of claim 285, further comprising the step of mixing the premixed compositions  
2 before, while, or after they are dispensed into the containers.
- 1 287. The method of claim 285, further comprising the step of mixing the premixed compositions  
2 before or while they are dispensed into the containers.
- 1 288. The method of claim 285, further comprising the step of adjusting the viscosity of the  
2 premixed compositions before, while, or after they are dispensed into the containers.
- 1 289. The method of claim 285, further comprising the step of adjusting the viscosity of the  
2 premixed compositions before or while they are dispensed into the containers.
- 1 290. The method of claim 285, further comprising the step of adding at least one additive that  
2 enhances application or final performance of the aqueous paint product.
- 1 291. The method of claim 290, wherein the additive is a thickener.
- 1 292. The method of claim 285, further comprising the step of adding at least one colorant to the  
2 premixed compositions.
- 1 293. The method of claim 285, wherein the opacifying pigment composition further comprises at  
2 least one resin absorbed onto the opacifying pigment.
- 1 294. The method of claim 285, wherein the low resin composition further comprises at least one  
2 resin absorbed onto the flattening agent.
- 1 295. The method of claim 285, wherein the method is carried out at a paint manufacturing  
2 facility.
- 1 296. The method of claim 285, wherein the number of premixed compositions is 4 or more.

- 1 297. The method of claim 285, wherein the low resin composition has a PVC of about 35% to  
2 about 100%.
- 1 298. The method of claim 285, wherein the method is carried out at the point-of-sale.
- 1 299. The method of claim 285, wherein the method is carried out at the point-of-use.
- 1 300. The method of claim 285, wherein the method is controlled by a computer.

### **COUNT 3 (A Pigmented Prepaint Composition)**

1 301. A premixed aqueous composition for forming an aqueous paint product, the premixed  
2 composition comprising:  
3 a premixed pigment composition provided as an aqueous solution having:  
4 an opacifying pigment;  
5 a dispersant-thickener comprising:  
6 a dispersant,  
7 a thickener; and  
8 water;  
9 wherein mixing a portion of the pigment composition with other paint ingredients provides the  
10 aqueous paint composition.

1 302. The premixed aqueous composition of claim 301, wherein the volume solids content is  
2 about 35% to about 50% and the Stormer viscosity is about 60 to about 150 KU.

1 303. The premixed aqueous composition of claim 301, wherein the opacifying pigment  
2 comprises titanium dioxide.

1 304. The premixed aqueous composition of claim 301, wherein the dispersant comprises  
2 potassium tripolyphosphate.

1 305. The premixed aqueous composition of claim 301, wherein the thickener comprises a  
2 cellulosic.

1 306. The premixed aqueous composition of claim 301, further consisting essentially of at least  
2 one additive comprising a coalescent, with the additive being present in an amount of less than  
3 about 10% by weight, based on the total weight of the premixed aqueous composition.

1 307. A plurality of different, but mutually compatible premixed aqueous compositions useful for  
2 formulating a paint product, which plurality comprises:

3 (a) the premixed opacifying aqueous composition of claim 301; and

4 (b) a premixed binder composition having volume solids content of about 25% to about  
5 70% or a Brookfield viscosity of less than about 100,000 centipoise at a shear rate  
6 of 1.25 reciprocal seconds, which binder composition consists essentially of a  
7 water-borne resin having a Tg of about -430 degrees C. to about 70 degrees C.  
8 and water;

9 wherein the ingredients of the premixed compositions are mutually compatible with each other  
10 and with the ingredients of the other premixed compositions of the plurality.

1 308. The set of premixed aqueous compositions of claim 307, wherein the premixed binder  
2 composition has a volume solids content of about 30 to about 65% and a Brookfield viscosity of  
3 about 100 to about 50,000 centipoise at a shear rate of 1.25 reciprocal seconds, and consists  
4 essentially of a water-borne resin having a Tg of about -10 to about 60 degrees C.

1 309. The set of premixed fluid compositions of claim 307, wherein the premixed binder  
2 composition further consists essentially of at least one additive comprising a coalescent, the  
3 additive being present in an amount of less than about 10% by weight, based on the total weight  
4 of the premixed binder composition.

1 310. A plurality of different, but mutually compatible, premixed compositions, useful for  
2 formulating a paint product, which plurality comprises:

3 (a) the plurality of premixed fluid compositions of claim 307; and

4 (b) a premixed aqueous pigment extender composition which consists essentially of:

5 (i) at least one flattening agent,

6 (ii) at least one thickener,

7 (iii) water, and

8 (iv) optionally a resin;

9 wherein the premixed extender composition has a volume solids content of about 30% to about  
10 70%, a PVC of about 35% to about 100%, and a Stormer viscosity of about 50 to about 250 KU.

1 311. The plurality of premixed compositions of claim 310, wherein the premixed extender  
2 composition has a volume solids content of about 35% to about 65%, a PVC of about 40% to  
3 about 100% and a Stormer viscosity of about 60 to about 150 KU.

1 312. The plurality of premixed compositions of claim 307, wherein the premixed binder  
2 composition further consists essentially of at least one additive comprising a coalescent, with the  
3 additive being present in an amount of less than about 20% by weight, based on the total weight  
4 of the binder composition.

1 313. A premixed aqueous pigment paint composition having a volume solids content of about  
2 30% to about 70%, a PVC of about 35% to about 100%, and a Stormer viscosity of about 50 to  
3 about 250 KU, useful for formulating an aqueous pigmented paint product containing other paint  
4 ingredients, the premixed pigment composition provided as an aqueous solution comprising:

5 a pigment;

6 a dispersant-thickener comprising:

7 a dispersant, and

8 a thickener;

9 a resin, and

10 water;

11 wherein mixing a portion of the pigment composition with the other paint ingredients provides  
12 the aqueous paint product.

1 314. The premixed aqueous composition of claim 313, wherein the volume solids content is  
2 about 35% to about 50%, the PVC is about 50 to about 100%, and the Stormer viscosity is about  
3 60 to about 150 KU.

1 315. The premixed aqueous composition of claim 313, wherein the resin is adsorbed onto the  
2 pigment.

1 316. The premixed aqueous composition of claim 313, wherein the pigment comprises titanium  
2 dioxide.

1 317. The premixed aqueous composition of claim 313, wherein the dispersant comprises  
2 potassium tripolyphosphate.

1 318. The premixed aqueous composition of claim 313, wherein the thickener comprises a  
2 cellulosic.

1 319. The premixed aqueous composition of claim 313, wherein the resin comprises acrylics.

1 320. The premixed aqueous composition of claim 313, further consisting essentially of at least  
2 one additive comprising a coalescent, with the additive being present in an amount of less than  
3 about 10% by weight, based on the total weight of the premixed aqueous composition.

1 321. A plurality of different, but mutually compatible premixed aqueous compositions useful for  
2 formulating a paint product, which plurality comprises:

3 (a) the premixed aqueous composition of claim 313; and

4 (b) a premixed binder composition having volume solids content of about 25% to about  
5 70% or a Brookfield viscosity of less than about 100,000 centipoise at a shear rate  
6 of 1.25 reciprocal seconds, which binder composition consists essentially of a  
7 water-borne resin having a Tg of about -430 degrees C. to about 70 degrees C.  
8 and water;

9 wherein the ingredients of the premixed compositions are mutually compatible with each other  
10 and with the ingredients of the other premixed compositions in the plurality.

1 322. The plurality of premixed aqueous compositions of claim 321, wherein the premixed binder  
2 composition has a volume solids content of about 30 to about 65% and a Brookfield viscosity of  
3 about 100 to about 50,000 centipoise at a shear rate of 1.25 reciprocal seconds, and consists  
4 essentially of a water-borne resin having a Tg of about -10 to about 60 degrees C.

1 323. The plurality of premixed aqueous compositions of claim 322, wherein the premixed binder  
2 composition further consists essentially of at least one additive comprising a coalescent, the  
3 additive being present in an amount of less than about 10% by weight, based on the total weight  
4 of the premixed binder composition.

1 324. A plurality of different, but mutually compatible, premixed aqueous compositions, useful  
2 for formulating an aqueous paint product, which plurality comprises:

3 (a) the plurality of premixed aqueous compositions of claim 322; and

4 (b) a premixed aqueous pigment extender composition which consists essentially of:

5 (i) at least one flattening agent,

6 (ii) at least one thickener,

7 (iii) water, and

8 (iv) optionally a resin;

9 wherein the premixed binder composition has a volume solids content of about 30% to about  
10 70%, a PVC of about 35% to about 100%, and a Stormer viscosity of about 50 to about 250 KU.

1 325. The plurality of premixed aqueous compositions of claim 324, wherein the premixed  
2 extender composition has a volume solids content of about 35% to about 65%, a PVC of about  
3 40% to about 100% and a Stormer viscosity of about 60 to about 150 KU.

1 326. The plurality of premixed aqueous compositions of claim 321, wherein the premixed binder  
2 composition further consists essentially of at least one additive comprising a coalescent, with the  
3 additive being present in an amount of less than about 20% by weight, based on the total weight  
4 of the premixed binder composition.

#### **COUNT 4 (A Pigment Extender Prepaint Composition)**

- 1 327. An aqueous solution having a premixed pigment extender composition, useful for producing  
2 a paint product containing other premixed compositions, the aqueous solution comprising:
- 3 (i) a flattening agent;
  - 4 (ii) a dispersant thickening dilutant composition having a thickener,
  - 5 (iii) water, and
  - 6 (iv) optionally a resin; wherein the premixed extender composition ingredients are  
7 compatible with each other.

## **VI. REMARKS**

### **A. Identification of Interfering Patent and Application and Establishing of Priority Dates**

Applicants' above captioned application, Serial No. 09/578,001, filed May 24, 2000 is a continuation-in-part of application Serial No. 09/221,332, filed December 23, 1998, which issued as U.S. Patent No. 6,221,145 on April 24, 2001 (hereinafter "the Applicant's patent," Exhibit A).

Claims 87-327 appear in the present application for the Examiner's review and consideration. Previously pending claims 52-86 have been canceled.

Claims 87-327 have been added for the purpose of provoking an interference with unexpired U.S. Patent No. 6,531,537 to Friel et al. (hereinafter "the Friel patent," Exhibit B), which issued on March 11, 2003, and with U.S. Patent application Serial No. 2002/0016405 to Friel et al. (hereinafter "the Friel application," Exhibit C), which was published February 7, 2002.

New claims 87, 90, 93, 96, 99, 102, 105, 108, 111, 114, 117, 120, 123, 126, 129, 132, 135, 138, 141, 144, 147, 207, 209, 219, 221, 225, 227, 231, 233, 235, 247, 249, 253, 255, and 259 correspond exactly or substantially to claims 1-4, 49, 38, 45, 48, 5, 7-11, 13-18, 50, 19-20, 32-33, 35, 36, 21-23, 25, 32, 33, 35, 36, and 31 of the Friel patent. See Exhibit G for a direct comparison between currently pending claims and the claims of the Friel patent.

New claims 150, 153, 156 correspond exactly or substantially with claims 18, 19, and 20 of the Friel application. Claims 87, 90, 93, 96, 99, 102, 105, 108, 111, 114, 117, 120, 123, 126, 129, 132, 135, 138, 141, 144, 147, 207, 209, 219, 221, 225, 227, 231, 233, 235, 247, 249, 253, 255, and 259 also correspond exactly or substantially to claims 1-17 and 21-50 of the Friel application since many of the Friel application claims recite substantially the same elements as the Friel patent. See Exhibit G for a direct comparison between currently pending claims and the claims of the Friel application.

New claims 211, 213, 215, 217, 223, and 229 are partial copies of claims 24, 27, 28, 30, 34, and 37 of the Friel patent as they depend from claims 19. New claims 237, 239, 241, 243, 245, 251, and 257 are partial copies of claims 24, 27-30, 34, and 37 of the Friel patent as they depend on claim 21. See Exhibit G for a direct comparison between currently pending claims and the claims of the Friel patent.

The remaining new claims vary in terminology while claiming substantially the same inventions as recited in the Friel patent and the Friel application as can be appreciated from a comparison of the claims in parallel columns in Table 3 of Exhibit G and Table 4 of Exhibit H.

**B. Presentation of the Proposed Counts**

The Friel patent and the Friel application conflict with the present application on four counts. The first count corresponds to claims 1-4, 49, 38, 45, and 48, of the Friel patent and corresponding claims to the same matter in the Friel application. The second count corresponds to claims 5, 7-11, 13-18, and 50 of the Friel patent and claims to the same matter in the Friel application. The third count corresponds to claims 19-23, 32-33, 35, and 36 of the Friel patent and claims to the same matter in the Friel application. The fourth count corresponds to claim 31 of the Friel patent and claims to the same matter in the Friel application. Table 1 below is useful in showing which claims correspond to which counts. Since none of the counts corresponds exactly to a claim, each of the four counts is a phantom count. Furthermore, since most of the patent claims have been copied, the interference is an interference in fact.

**Table 1: Claims Corresponding to Counts**

	<b>General Descrip- tion of the Counts</b>	<b>Friel Patent Claims</b>	<b>Friel Applica- tion Claims</b>	<b>Copy or Substantially same as Friel Patent or Application Claims</b>	<b>Bridging Claims (Closer to Friel Patent)</b>	<b>Bridging Claims (Closer to Present Application)</b>	<b>Claims Supported Inherently or by Original Terminology</b>
<b>Count 1</b>	A set of prepaints	1-4, 38, 45, 48, and 49	1-4 and 44	87, 90, 93, 96, 99, 102, 105, and 108	88, 91, 94, 97, 100, 103, 106, and 109	89, 92, 95, 98, 101, 104, 107, and 110	261-268
<b>Count 2</b>	A method of formulating a paint	5-11, 13-18, and 50	5-11 and 13-21	111, 114, 117, 120, 123, 126, 129, 132, 135, 138, 141, 144, 147, 150, 153, 156, 159, 162, 165, 168, 171, 174, 177, 180, 183, 186, 189, 192, 195, 198, 201, and 204	112, 115, 118, 121, 124, 127, 130, 133, 136, 139, 142, 145, 148, 151, 154, 157, 160, 163, 166, 169, 172, 175, 178, 181, 184, 187, 190, 193, 196, 199, 202, and 205	113, 116, 119, 122, 125, 128, 131, 134, 137, 140, 143, 146, 149, 152, 155, 158, 161, 164, 167, 170, 173, 176, 179, 182, 185, 188, 191, 194, 197, 200, 203, and 206	269-300
<b>Count 3</b>	A pigmented prepaint	19-24, 27-30, and 32- 37	22-23, 27, 30-34, and 37-43	207, 209, 211, 213, 215, 217, 219, 221, 223, 225, 227, 229, 231, 233, 235, 237, 239, 241, 243, 245, 247, 249, 251, 253, 255, and 257		208, 210, 212, 214, 216, 218, 220, 222, 224, 226, 228, 230, 232, 234, 236, 238, 240, 242, 244, 246, 248, 250, 252, 254, 256, and 258	301-326
<b>Count 4</b>	An extender prepaint	31	35-36	259		260	327

Several Claims are considered to not correspond to any count for the purposes of the present interference, and therefore have not been copied. Other claims are considered to correspond in part to the present interference as shown in Table 2 below. An explanation of claims that are not exact copies is set forth in the explanation of how specific claims are supported below.

**Table 2: Claims that do not Correspond or that Correspond in Part**

	<b>Friel Patent</b>	<b>Friel Application</b>
<b>Claims Not Corresponding to a Count</b>	12, 25, 39-44, and 46-47	12, 28, and 45-48
<b>Claims Corresponding in Part to a Count</b>	24, 27-30, 34, and 37	27, 30-34, 39, and 43

**C. Interference Necessary with *THIS* Application**

The petition for withdrawal of the present application from issue is made under the exception of 37 CFR 1.313 (c) (2), wherein a request for continued examination under 37 CFR 1.114 is being made concurrently. Applicants have requested immediate withdrawal of the present application from issue under 37 C.F.R. 1.313(c) even though the issue fee has been paid because Applicants were not aware that an interference should have been provoked with interfering claims in this application. Due to information, noted below, that has recently come to Applicants' attention, withdrawal of the present application from issue by the Patent Office under the initiative of the Applicants has been requested.

1. Applicants became aware of U.S. Patent No. 6,531,537 B2 having claims to the same invention as the present application.

A. The patent was issued March 11, 2003 (less than a year ago as required by 35 USC 135(a))

B. The present application was filed on May 24, 2000, before the pre-grant publication of the patent, which occurred on January 10, 2002. (Thus, the requirements of 35 USC 135(b) do not pertain to this application.)

C. Unless an Interference is provoked between the present application, with its May 24, 2000 filing date, and the issued claims of U.S. Patent No. 6,531,537 B2, Applicants will be significantly limited in their ability to provoke an interference with that patent because 35 USC 135(b) will impose significant restrictions on the claims that can be made in any other related application.

2. The issued claims in the patent could have been claimed in the present application.

A. Although Applicants have an earlier priority date by more than 1 year for the subject matter claimed by Patent No. 6,531,537 B2, the claims of the patent provide rights in that invention to another. Applicants' disclosure, though it uses slightly different language, discloses the same examples for its components as those in the Friel patent and application.

3. There are no other related application(s) in which the patent claims could be presented without changing the thrust of those related applications. Furthermore, Applicants may be restricted from presentation of claims having the same or substantially the same subject matter in any related application under 35 USC 135(b), and from provoking an interference in fact, because all such related applications were filed or will be filed after the publication date of the patent. Alternatively stated, the present application is the only application that can avoid the requirement of 35 USC 135(b) by virtue of its filing date. In view of the nature and scope of the patent claims having an effective filing date more than one year after the effective filing date of the same subject matter in Applicants' application, Applicants need to provoke an interference in the present application with its 5/24/00 filing date.

Hence, Applicants have petitioned the commissioner to withdraw the present application from issue.

**D. Meets the Requirements for an Interference Under 35 U.S.C. 135**

In accordance with the requirements of 35 USC 135 (a), the claims of the Friel Patent and the Friel application interfere with Applicant's application claims. Applicant's application has an effective filing date that is prior to that of the Friel patent and the Friel application. These facts can be verified by reviewing the following explanations and the filing dates of the pertinent applications and patents supplied in the accompanying Exhibits A-C.

In accordance with 35 USC 135 (b) (1), the Friel patent claims have been copied and submitted herewith as an amendment to the present application. The Friel patent was issued March 11, 2003. Therefore, the copied claims present the same invention and are being submitted less than one year after the Friel patent was issued.

The requirements of 35 USC 135 (b) (2) does not pertain to the present application because Applicant's application was filed before the Friel patent and the Friel Application. Furthermore, the effective filing date of the relevant subject matter for the Applicants application is before the effective filing date of the relevant material in the Friel patent and the Friel application.

The patent claims clearly conflict with the Applicants' claimed inventions presented in the present application as can be seen in the explanation of differing terms for the same features provided herein. These claims are supported by the original disclosure of the Applicants, which is senior to the Friel patent and senior to the Friel application. Furthermore, it is presumed that the Friel patent claims are patentable since they were deemed so by the Office during examination and issuance. As such, the patentee has obtained patent rights that belong to the present Applicants. Therefore, an interference proceeding is needed to obtain judgment on the interfering claims.

**E. Ownership is Not Common**

Ownership of the present application is not the same as the ownership of the Friel patent and the Friel application. All rights title and interest of the present application and the parent application to which it claims priority belong to MicroBlend Technologies, Inc. of Chandler Arizona. All rights title and interest of the Friel patent and the Friel application appear to belong to Rhom & Haas Company of Philadelphia, Pennsylvania, and do not belong to MicroBlend Technologies, Inc.

**F. The Present Application has an Earlier Effective Filing Date for the Claimed Matter**

The Friel patent (Exhibit B) was filed on February 16, 2001 and has an effective filing date for at least some of its matter dating back to February 18, 2000. The Friel application has a filing date of February 16, 2001. All of the filing dates and effective filing dates of the Friel patent (Exhibit B) and the Friel application are later by more than one year after the effective filing date (December 23, 1998) of the Applicant's patent (Exhibit A), which is a parent of the present continuation-in-part application. Consequently, any claim of the present application that is supported by the specification of the parent case under 35 U.S.C. 112 should be allowed in light of the fact that the Friel patent (Exhibit B) was allowed and because the present application is entitled to the benefit of an earlier effective filing date. Support for the currently claimed matter in the Applicant's patent is provided as set forth in greater detail below.

**G. Application Discloses the Same Invention using Different Terminology;  
Patent Terminology Is Supported by Applicant's Prior Disclosure According to the  
Definitions of the Terms**

Applicant's original disclosure inherently describes the same invention described and claimed in both the Friel patent and the Friel application. As shown below, the terms used in the Friel patent and the Friel application correspond directly to the terms used in the Applicant's original disclosure. Therefore, the inventions claimed by Friel are supported by the Applicant's disclosure.

The term "opacifying prepaint" finds antecedent basis in Applicant's patent (Exhibit A) in column 2, lines 25-28 wherein Applicants disclose the use of titanium dioxide as the pigment. A paint dictionary entitled "Coatings Encyclopedic Dictionary" edited by Stanley LeSota and published in 1995, (copied pages of which, showing pertinent excerpts are included herewith as Exhibit D) (hereinafter "Paint Dictionary"), states that titanium dioxide is a "high opacity bright pigment". It is commonly known in the paint industry that titanium dioxide is added to paint mixtures as a pigment for its opacity. Support for the term "prepaint" is provided in part by taking this term in the context in which it is presented in the Friel patent. In this case, "prepaint" means a composition formed in a process prior to forming an actual functional paint and used in conjunction with other compositions in order to form a functional paint. In this sense, the "pre" of "prepaint" is analogous to the "pre" of "premix", which by definition from the Paint Dictionary is: "an admixture of several ingredients designed to be incorporated in a formulation or process as a group as opposed to individually." (See Exhibit D.) Hence, "prepaint" means a premixed composition. Applicant's patent (Exhibit A) clearly provides several prepaint compositions or "prepaints" as set forth in column 1, lines 47-50 of the patent.

The term "extender prepaint" is provided for in the Applicant's patent (Exhibit A) by the description of the constituents of the low resin content prepaint composition. The low resin prepaint composition in Applicant's patent (Exhibit A) includes ground limestone as set forth in column 3, lines 33-34. Limestone or "natural calcium carbonate" is defined as a "white extender pigment" in the Paint Dictionary. (See Exhibit D.) Therefore, the prepaint composition that includes limestone or calcium carbonate is an extender pigment prepaint composition by definition.

The term "latex polymeric binder" is inherent in the aqueous acrylic resin based binder prepaint compositions of Applicant's patent. Applicants disclose that their resin can be resin 6183 made by BASF. BASF's convention for 6183 resin has been changed at BASF so that this material is now referred to by the designation 220 BASF. Furthermore, a more common designation associated with 6183 is Acronal TM DS 6183, (also made by BASF.) See Exhibit E for a description of 6183 BASF/Acronal 220. This material is an acrylic resin, which is also a polymer commonly used in latex paints. Applicant refers to the high and low resin content

compositions as binders in column 1, lines 50-51. Therefore, Applicant's patent has support for a "latex polymeric binder"

As additional support for Applicant's resin being a latex polymer, "Hawley's Condensed Chemical Dictionary - Eleventh Edition" published in 1995, (copied pages of which, showing pertinent excerpts are included herewith as Exhibit F) (hereinafter "Chemical Dictionary") defines "binder" as: "the film-forming ingredient in paint, usually either an oil or a polymeric substance." Furthermore, the Chemical Dictionary further provides a definition for the term "resin", (which includes acrylic resins), as a "high polymer". Thus, by the terms "resin", "binder", and by the description of the specific material "6183" used, Applicant's resin is "polymeric". The term "latex", as provided by the above referenced Paint Dictionary, means: "a stable dispersion of a polymeric substance in an essentially aqueous medium." (See Exhibit D.)

Applicant's patent (Exhibit A) clearly has the "resin" or "binder" in an essentially aqueous medium in accordance with this definition as described in column 3, lines 38-41. One thrust of the present invention is to provide the premixed compositions as stable dispersions that do not separate during storage over long periods of time. Therefore, Applicant's high resin composition or binder composition is, by definition, a latex polymeric binder. Additional details of how Applicant's patent supports the specific claims are provided below.

In accordance with the above known meanings of words, Applicants have placed terms in the Specification of the present application as alternative terms for the same elements that were previously supported. Accordingly, Applicants have not entered new matter by the present amendments.

#### **H. Identification of Correspondence of the Terms in the Claims**

Exhibit G includes Table 3, which is a table of newly presented claims 87-260 in three parallel columns showing correspondingly similar claims in a side-by-side relationship. The table also has the counts grouped so that all of the first count claims come at the top of the table,

under the heading "Count 1", all of the second count claims come below, under the heading of "Count 2", and so forth. This parallel column format is intended to aid the Examiner in seeing the bridge in terminology that is readily supported by the original disclosure of the Applicant's patent. The pertinent terminology has been highlighted to facilitate the comparison. Corresponding Friel patent (P) and application (A) claim numbers have also been indicated in the far right column.

Column 1 of Table 3 (Exhibit G) shows claims 87, 90, 93, 96, 99, 102, 105, 108, 111, 114, 117, 120, 123, 126, 129, 132, 135, 138, 141, 144, 147, 150, 153, 156, 159, 162, 165, 168, 171, 174, 177, 180, 183, 186, 189, 192, 195, 198, 201, 204, 207, 209, 211, 213, 215, 217, 219, 221, 223, 225, 227, 229, 231, 233, 235, 237, 239, 241, 243, 245, 247, 249, 251, 253, 255, 257 and 259 which are copies, or which recite substantially similar material in terms similar to the claims in the Friel patent and the Friel application. Column 2 shows claims 88, 91, 94, 97, 100, 103, 106, 109, 112, 115, 118, 121, 124, 127, 130, 133, 136, 139, 142, 145, 148, 151, 154, 157, 160, 163, 166, 169, 172, 175, 178, 181, 184, 187, 190, 193, 196, 199, 202, and 205 utilizing some terminology from the present application as originally filed and some terminology originating in the Friel patent (Exhibit B) and the Friel application (Exhibit C). Column 3 shows claims 89, 92, 95, 98, 101, 104, 107, 110, 113, 116, 119, 122, 125, 128, 131, 134, 137, 140, 143, 146, 149, 152, 155, 158, 161, 164, 167, 170, 173, 176, 179, 182, 185, 188, 191, 194, 197, 200, 203, 206, 208, 210, 212, 214, 216, 218, 220, 222, 224, 226, 228, 230, 232, 234, 236, 238, 240, 242, 244, 246, 248, 250, 252, 254, 256, 258, and 260, utilizing mostly terminology that was originally recited in the present application.

Exhibit H includes Table 4, which is a table of the newly presented claims 261-327 in a left column and the corresponding Friel claim(s) and claim numbers in the right column in a side-by-side relationship. The table also has the counts grouped so that all of the first count claims come at the top of the table, under the heading "Count 1", all of the second count claims come below, under the heading of "Count 2", and so forth. This parallel column format is intended to aid the Examiner in seeing that the newly presented claims recite substantially the same invention as the Friel patent and the Friel application, while utilizing terminology that is

either expressly recited or inherent in the Applicant's original disclosure. The pertinent terminology has been highlighted to facilitate the comparison.

**I. How Various Specific Claims are Supported by the Original Disclosure**

***Count 1, Claims 87-110 and 261-268***

Claim 87 is a copy of claim 1 of the Friel patent. Claims 88 and 89 correspond to claim 87. Claims 88 and 89 vary from claim 87 only in terminology, which progresses in claims 88 and 89 from terminology used in the Friel patent to terminology found in Applicant's original disclosure. In particular, Claim 87 utilizes the term "set of different" when referring to the "prepaints". Applicant's original disclosure refers to the same thing as a "plurality of premixed compositions" in the title and elsewhere in the Applicant's patent. The term "different" does not appear in applicant's original disclosure with reference to the "premixed compositions", but has a basis by the description of how each of the compositions differs in ingredients from the others. Thus, the term "different" has been placed in the present application by this amendment without adding or removing meaning whatsoever therefrom. The term "varied" has a similar basis in the Applicant's patent. Furthermore, the term varied appears in the Applicant's patent (Exhibit A) in column 3, lines 42-43 and throughout the Specifications with reference to providing materially different premixed compositions and resulting paint compositions. The term "set" is also supported by the Applicant's original disclosure in that Applicant refers to specific numbers in the range of 2 or more "premixed compositions". Thus, the term "set" has also been placed in the present application without addition or loss of meaning.

As can be noted from the added claims, (and from the copy of added claims in parallel columns in Exhibit G), claims 87 and 88 use the term "set of different" while claim 89 uses the term "plurality of varied". Each of these terms refers to the same thing so that the distinction between the claims becomes merely a matter of semantics. Likewise, claim 87 uses the term "fluid" whereas claims 88 and 89 employ the term "aqueous" for the same feature of the invention. Claim 87 recites a "paint line". While this term is not in applicant's original disclosure, "line" is a well known term referring to a set or variety of a specific genus of products. For example, there are product lines of cars, carpets, televisions, etcetera. Thus,

Applicant's original disclosure that a variety of paint compositions or products can be formulated from the premixed compositions provides support and a basis for recitation of a "paint line". On the other hand, claims 87, 88, and 89 recite "paint line", "set of paint products", and "a variety of paint compositions" for the same claim element. These terms mean the same thing so that there is no addition or loss of meaning from one claim to another.

The term "prepaint" in claim 87 corresponds to the term "prepaint composition" in claim 88 and the term "premixed composition" of claim 89, all of which refer to the same claim element. The similar meaning of "premixed composition" and "prepaint" is set forth in section G above with reference to known meanings of words in the terms. Similarly, a progression of the terms "opacifying prepaint", "pigment prepaint composition", and "premixed pigment composition" is provided in claims 87, 88, and 89 respectively. These terms likewise refer to the same thing. For example, titanium dioxide is specifically disclosed as the pigment in both the "premixed pigment composition" of Applicant's patent and the "prepaint" of the Friel patent. A similar progression is provided for the terms "extender prepaint", "extender prepaint composition", and "premixed low resin composition". As disclosed in column 3, lines 29-38 of the Applicant's patent (Exhibit A), the "premixed low resin composition" has well known extenders including diatomaceous earth, ground limestone, and calcined clay. Hence the three terms refer to the same extender prepaint, and the variation in terminology is merely a matter of semantics. The same is true of the terms "extender pigment" of claim 87, "extender agent" of claim 88, and "flattening agent" of claim 89.

A similar progression in terms from "binder prepaint" to "binder prepaint composition" to "premixed high resin composition" in claims 87-89, respectively, is provided. The "high resin composition" contains a "resin" as set forth in column 3, lines 39-40 of the Applicant's patent. The term "resin" in claim 89 corresponds to the term "polymeric binder" of claims 87 and 88. Resins are generally polymeric and the Applicant's patent refers to the high resin composition as a "high resin binder". Furthermore, applicant's specific example of the resin is a polymeric binder as set forth in section G above. Hence, claims 87, 88, and 89 claim the same invention using different terms that mean the same thing, and the differences are merely semantic.

Claim 90 is not a copy of claim 2 of the Friel patent because the original disclosure of the Applicant's patent does not provide a specific statement of the upper limit recited in claim 2 of

the Friel patent. However, the Applicant's original disclosure has a basis for claiming a number of prepaints more broadly. Specifically, the Applicant's patent (Exhibit A) states that paint products can be formed from a plurality of aqueous compositions in column 1, lines 47-49. An example using two to four compositions is disclosed in column 1, lines 50-54. Two, three, and four premixed compositions is shown in the table of column 4, and three compositions is specifically disclosed in column 3, lines 54-57. It would be an obvious modification to merely include more prepaints in the set. Therefore, the range of three or more recited in claim 90 is a broad yet supported recitation. Claims 91 and 92 correspond to claim 90 except for the alternate terms "aqueous prepaint compositions" and "plurality of premixed aqueous compositions" respectively, which replace "set of prepaints" in claim 90 without addition or loss of meaning as explained above.

Claims 93 and 96 are copies of claims 3 and 4 respectively of the Friel patent. While the adsorption and absorption of a particulate polymeric binder onto the opacifying pigment and onto the extender pigment as recited in these claims is not expressly stated in the Applicant's original disclosure, this feature of the invention is inherent in combining the resin compositions with the pigment and extender pigment compositions. That is, adsorption and absorption as recited will occur in the compositions and paint products of the present invention. Claims 94-95 and 97-98 have the alternative terms discussed with regard to the base claims above, but otherwise correspond to claims 93 and 96 respectively.

Claim 99 is a copy of claim 49 of the Friel patent. This claim recites that the extender prepaint has a pigment volume concentration (PVC) is in a range from about 35% to about 100%. Applicants' relative quantities of the various ingredients are disclosed as weight percentages. However, the weight percentages converted to PVC provide the extender prepaint PVC within the claimed range. In further support, Applicant's patent (Exhibit A) states in column 3, lines 41-44 that the amount of resin in the low resin composition can be varied to achieve different finish characteristics. Therefore, there is further support for the potential of the PVC's in the claimed range. Claims 100 and 101 correspond to claim 99 except for the substitute terminology that has been explained as equivalent in meaning to the terms in the copied claims as set forth in the remarks above.

Claim 102 is a copy of independent claim 38 of the Friel patent. This claim is a product by process claim that utilizes the same basic terminology as the copied base claim 87 discussed above. Claims 103 and 104 correspond to claim 102 except for the omission of the term "applicators" in the alternative, and the substitute terminology similar to that discussed above with respect to independent claims 87-89. The substitute terminology can be readily viewed in side-by-side relation in Exhibit G for ease of comparison. The substitute terminology is fully supported by the original disclosure and does not add or remove meaning therefrom. Applicants also hold that the containers into which the premixed compositions are dispensed, may include applicators. Furthermore, it is considered that the "applicators" of Friel may not include substantively more than the "containers" claimed in the alternative in Claim 38 of the Friel patent because the Friel patent does not further define the term "applicator".

Claim 105 is a copy of claim 45 of the Friel patent. Most of the terminology of claim 105 has been discussed above as being supported by the original disclosure of the Applicant's patent. Claims 106 and 107 have substitute terminology that is equivalent to that of claim 105 as has also been discussed above. The similarities can be readily seen by comparison of claims 105-107 in the parallel columns of Exhibit G. The additional term "clear coatings" appears in the preamble of claims 105-106. The term "clear coatings" is not expressly stated in the original disclosure of the Applicant's patent. However, the Applicant discloses of neutral color in column 1, lines 11-12 and high gloss in column 2, lines 18-24, which provide a basis for formulating "clear coatings". Thus, "clear coatings" is within the scope of the original disclosure. On the other hand, the body of each of claims 105 and 106 does not breathe life and meaning into the term "clear coatings" since the claims recites an "opacifying pigment", which does not correspond to clear coatings. In any case, claims 105-107 are considered to be fully supported by the original disclosure and to be substantially equivalent to each other for the reasons set forth above.

Claim 108 is a copy of claim 48 of the Friel patent. Claims 109 and 110 correspond to claim 108 in scope and meaning, but utilize the substitute terminology similar to that discussed above with regard to other claims. Claims 109 and 110 omit the term "applicators" similar to claims 103 and 104, but considered to still be similar in scope to claim 108 for the same reasons set forth in the remarks regarding claims 102-104. Thus, claims 108-110 are considered to vary

from each other only semantically and are supported by the original disclosure of the Applicant's patent.

Each of claims 87-110 is considered to be supported by the original disclosure of the Applicant's patent for purposes of 35 USC 112 1st paragraph. Furthermore, the variations in corresponding claims are considered to be a matter of semantics such that each of three claims in a set of corresponding claims, (the claim copied from the Friel patent and two others), is equivalent to the other claims in the set. This may be readily seen by a comparison in side by side relation with the varied terms highlighted as shown in Exhibit G.

Claims 1-4 and 44 of the Friel application are duplicates of claims 1-4 and 38 of the Friel patent. Therefore, the above explanation of differences and support apply equally to claims 1-4 and 44 of the Friel application.

Claims 261-268 correspond to claims 1-4, 49, 38, 45, 48 of the Friel patent and the corresponding claims of the Friel application. Hence, the same general remarks for each of the corresponding claims above applies to claims 261-268. However, claims 261-268 have been made to include only language that was expressly or inherently provided by the original disclosure of the Applicant's patent. The terminology of claims 261-268 is considered to vary from the terminology of the Friel patent and the Friel application only semantically. Since the terminology and language is supported completely by Applicant's original disclosure, none of the amendments to the specification are required to support claims 261-268. Yet as can be readily seen in the parallel columns of Table 4, claims 261-268 recite the same basic invention as the Friel patent and the Friel application.

#### ***Count 2, Claims 111-158 and 269-300***

Claim 111 is a copy of claim 5 of the Friel patent. Claims 112 and 113 correspond in scope and meaning to claim 111. Claims 112 and 113 omit the term "applicator(s)" that is recited in the alternative in claim 111. However, claims 112 and 113 are considered to be similar in scope to claim 111 for the reasons set forth in the remarks regarding claims 102-104 and 108-110 above. Claim 111 is an independent claim that incorporates many of the same terms that are in base claims 87, 102, and 105. These terms have been shown to be supported in the

Applicant's patent and to be equivalent to terms originally relied upon therein as set forth above. A comparison of claims 111, 112, and 113 in the parallel columns of Exhibit G will permit the Examiner to note that the progression of terminology refers to the same claim elements, and that differences between claims 111, 112, and 113 are merely a matter of semantics.

Claim 114 is a copy of claim 7 of the Friel patent. Claims 115 and 116 correspond to claim 114 in scope and meaning, and vary only in terminology similar to other claims discussed above.

Claim 117 is a copy of claim 8 of the Friel patent. Claims 118 and 119 correspond generally in scope and meaning, but wherein the term "applicator(s)" has been replaced by the term "containers". This variation is considered to be inconsequential for reasons set forth in the remarks regarding claims 102-104 above. Otherwise, claims 118 and 119 vary only in term of the substitute terminology, which is considered to neither add nor remove meaning as set forth above.

Claims 120-134 similarly have sets of three corresponding claims with the first in each set being a copy of claims 9, 10, 11, 13, and 14 of the Friel patent, respectively. The second and third of each set varies only by the substitute terminology, if at all. For example, the first, second, and third claims 129, 130, and 131 are copies of claim 13 of the Friel patent.

Claim 135 is a copy of claim 15 of the Friel patent. Claims 136 and 137 correspond in scope and meaning to claim 135, but vary in terminology. In this case, the substitute term "resin" of claim 137 is recited in column 3, lines 1 of the original disclosure of the Applicant's patent. On the other hand, the substitute term "polymeric agent" is used in claim 136 since resins are polymeric. Furthermore, the Applicant's original disclosure provides support for the copied claim 135 terminology of "polymeric binder" since polymeric materials, including resins, are binders.

Claim 138 is a copy of claim 16 of the Friel patent. Claims 139 and 140 correspond in scope and meaning to claim 138, and vary only in terminology as has been set forth above for the particular terms in these claims. Thus, the variations between claims 138, 139, and 140 are considered to be semantic only.

Claims 141, 142, and 143 are each a substantial copy of claim 17 of the Friel patent.

Claim 144 is similar to claim 18 of the Friel patent and differs therefrom because the original disclosure of the Applicant's patent does not expressly recite the specific upper limit of the range of prepaints recited in claim 18. However, the original disclosure provides support for a plurality of prepaints and specifically recites 2, 3, 4, or more prepaints as set forth in the remarks regarding claims 90-92 above. Therefore claim 144 recites 4 or more prepaints. Claims 145 and 146 correspond in scope and meaning to claim 144, and vary only in terminology similar to other claims set forth above.

Claim 147 is a copy of claim 50 of the Friel patent and is considered to be supported by the Applicant's original disclosure for the same reasons set forth in the remarks regarding claim 99 above. Claims 148 and 149 correspond in scope and meaning to claim 147, and vary only in terminology as discussed with regard to other claims above.

Claims 150, 151, and 152 are substantial copies of claim 18 of the Friel application.

Claims 153, 154, and 155 are substantial copies of claim 19 of the Friel application. The Applicant's original disclosure does not expressly recite that "the method is carried out at the point-of-use" as do claims 153, 154, and 155. However, the Friel application fails to particularly define the "point-of use". For example, on page 5, paragraph [0066] of the publication of the Friel application, Friel et al. fail to define what is meant by "buyer". Therefore, the "buyer" as disclosed includes the buyer of the prepaints, who then becomes the user of the prepaints and the manufacturer of the paints. Likewise, Friel et al. fail to define "contractor" as used in the same paragraph. Thus, "contractor" in the Friel application could mean an entity that has contracted to buy and mix paints from the prepaints. Furthermore, these terms are not correlated so as to provide definition by correlation. Hence, the term "point-of-use" could mean the location at which a manufacturer or any individual uses the prepaints to formulate a paint. Therefore, point-of-use should not be restricted to a meaning outside of the Applicant's own disclosure. That is, the Applicant discloses using "premixed compositions" or "prepaints" to make "paint products", and the place at which the "premixed compositions" are thus used can be termed a "point-of-use".

Claims 156, 157, and 158 are substantial copies of claim 20 of the Friel application. The term "controlled by a computer" of claims 156, 157, and 158 is supported by the original disclosure of column 4, lines 1-13 of the Applicant's patent. On line 1, the Applicant statement

that the "compositions [are] suitable for programmed dispensing" refers to computer controlled dispensing as is evidenced by the precise weight percentages required in the Table of lines 6-13.

Claims 5, 7-17, and 21-22 of the Friel application correspond to claims 5 and 7-18 of the Friel patent. Therefore, claims 5, 7-17, and 21-22 have the same relationship to the copied claims and the corresponding claims incorporating substitute terminology discussed above.

Claims 269-300 correspond to claims 5, 7-11, 13-18, 6, and 50 of the Friel patent and claims 5, 7-11, 13-21, 6, 7-11, and 13-21 of the Friel application. Hence, the same general remarks for each of the corresponding claims above applies to claims 269-300. However, claims 269-300 have been made to include only language that was expressly or inherently provided by the original disclosure of the Applicant's patent. The terminology of claims 269-300 is considered to vary from the terminology of the Friel patent and the Friel application only semantically. Since the terminology and language is supported completely by Applicant's original disclosure, none of the amendments to the specification are required to support claims 269-300. Yet as can be readily seen in the parallel columns of Table 4, claims 269-300 recite the same basic invention as the Friel patent and the Friel application.

### ***Count 3, Claims 207-257 and 301-326***

Claim 207 is a copy of claim 19 of the Friel patent. Claim 208 corresponds in scope and meaning to claim 207. Claims 207 and 208 vary only in semantics of their terminology. In particular, the substitution of "aqueous" for "fluid" and the substitution of "aqueous paint composition" for "latex paint" is considered to neither add nor remove meaning from claim 208. Please note the definition of "latex" as it relates to paints in section G above. With regard to the preamble, Applicants' pigmented latex paint has been calculated to have a volume solids content of about 30% to about 70%. Although the relative quantities of the various ingredients are set forth in weight percentages in Applicant's original disclosure, these values can be converted to volume solids content and shown to reside in the claimed range based on weights and percentages shown in the table in column 4 and the maximum and minimum values of pigment and binder resin. (See column 2, lines 25-37 and column 3, lines 29-41.) The recited range of Stormer viscosity recited is a broad range comparable to a range from the viscosity of water to that of hardened concrete. This range is considered to be met inherently since the materials in

the pigment composition present in their suggested percentages will fall within this range of viscosity. Therefore, claims 207 and 208 are supported by the original disclosure of the Applicant's patent.

Claim 209 is a copy of claim 20 of the Friel patent. The narrower range of volume solids content of about 35% to about 50% has been calculated and is also supported by the original disclosure of the Applicant's patent. The Stormer viscosity of about 60 to about 150 KU is also inherent since the typical viscosity for the paint of the present invention is around 90 to 100 KU, but may vary depending upon the mixture. Claim 210 corresponds in scope and meaning to claim 209, and merely varies in terminology. The substitute terminology of claim 210 is considered to neither add or remove meaning from claim 210 relative to the copied claim 209.

Claims 211, 213, 215, and 217 are only partial copies of corresponding claims 24, 27, 28, and 30 of the Friel patent. Claims 24, 27, 28, and 30 of the Friel patent recite lists that are not expressly recited in the original disclosure of the Applicant's patent. Thus, claims 211, 213, 215, and 217 recite a portion of each of the Friel claims that is recited. Claims 212, 214, 216, and 218 correspond to claims 211, 213, 215, and 217 in scope and meaning, and only vary therefrom in terminology. The variation in terminology is considered a matter of semantics. The dispersant and the coalescent additives are provided at least by the dispersant thickening premixed composition as set forth in column 3, lines 13-24. These and the remaining elements recited in claims 24, 27, 28, and 30 of the Friel patent are well known substitutes for the corresponding element recited in the Applicant's patent.

Claim 219 is a copy of claim 32 of the Friel patent. Claim 220 corresponds to claim 219 in scope and meaning, and only varies therefrom in terminology. The substitute terminology of claim 220 neither adds to or removes meaning relative to claim 219, and the differences between claims 219 and 220 are semantic. Applicant's original disclosure has relative volume solids content for the high resin composition in the range from about 25% to about 70% as has been calculated from the relative ingredient weight percentage contents of the original disclosure. Furthermore, the amounts of water and resin in the high and low resin compositions can be varied as set forth in column 3, lines 41-43, thus providing further variation of the volume solids content.



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ON PETITION

In re Application of  
C. Daniel McClain, et al.  
Application No. 09/578,001  
Filed: May 24, 2000  
Attorney Docket No. ROWL-9955

This is in response to a petition under 37 CFR 1.313(c)(2), filed October 8, 2003 in the above-identified application. Since the original petition was not properly forwarded to the appropriate deciding official in the Office of Petitions, a copy of the petition was provided by facsimile transmission on October 22, 2003. A decision on the petition to withdraw the above-identified application from issue after payment of the issue fee follows.

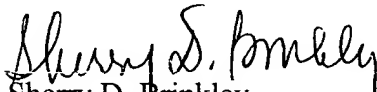
The petition is **GRANTED**.

The above-identified application is withdrawn from issue for consideration of a submission under 37 CFR 1.114 (request for continued examination). See 37 CFR 1.313(c)(2).

*Petitioner is advised that the issue fee paid on August 11, 2003, in the above-identified application cannot be refunded. If, however, the above-identified application is again allowed, petitioner may request that it be applied towards the issue fee required by the new Notice of Allowance.*<sup>1</sup>

Telephone inquiries relating to this decision should be directed to the undersigned at (703) 305-9220.

After receipt in the Office of Petitions, the application will be forwarded to Technology Center AU 1755 for further processing of the request for continued examination under 37 CFR 1.114.

  
Sherry D. Brinkley  
Petitions Examiner  
Office of Petitions  
Office of the Deputy Commissioner  
for Patent Examination Policy

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TC 1700

<sup>1</sup>The request to apply the issue fee to the new Notice may be satisfied by completing and returning the new Issue Fee Transmittal Form PTOL-85(b), which includes the following language thereon: "Commissioner for Patents is requested to apply the Issue Fee and Publication Fee (if any) or re-apply any previously paid issue fee to the application identified above." Petitioner is advised that, whether a fee is indicated as being due or not, the Issue Fee Transmittal Form **must** be completed and timely submitted to avoid abandonment. Note the language in bold text on the first page of the Notice of Allowance and Fee(s) Due (PTOL-85).

Docket No.: ROWL-9955

Inventor: McClain Examiner: Wood, E.

Serial No: 09/578,001 Filed On: 05/24/00 Art Unit: 1755

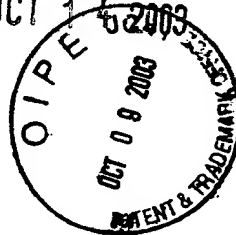
Law Firm: Schmeiser, Olsen & Watts LLP

Title: **METHOD AND APPARATUS FOR PRODUCING  
AN AQUEOUS PAINT COMPOSITION FROM A  
PLURALITY OF PREMIXED COMPOSITIONS**

ENCLOSED PLEASE FIND:

1. Postcard;
2. Transmittal Letter;
3. Petition for Withdrawal From Issue;
4. Interference;
5. Exhibits;
6. Associate Power of Attorney(s) forms;
7. Request for Continued Examination; and
8. Check enclosed for \$3,133.00 total fees.

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Sent via First Class Mail on October 7, 2003.

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## Response Transmittal

In re application of: McClain

Serial No.: 09/578,001

Filed: 05/24/00

For: **METHOD AND APPARATUS FOR PRODUCING AN  
AQUEOUS PAINT COMPOSITION FROM A  
PLURALITY OF PREMIXED COMPOSITIONS**

Mail Stop 313(c)  
Commissioner of Patents  
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Sir:

Transmitted herewith for filing in the above-identified Application is a:

1. Petition for Withdrawal from Issue
2. Interference;
3. Exhibits;
4. Associate Power of Attorney(s) forms; and
5. IDS with copies of cited art.

☐ CERTIFICATION OF FACSIMILE TRANSMISSION

I hereby certify that this paper is being facsimile transmitted to the Patent and Trademark Office on the date shown below.

☒ CERTIFICATE OF MAILING

I hereby certify that I am depositing the enclosed or attached correspondence with the United States Postal Service as first class mail in an envelope addressed to Mail Stop 313(c), Commissioner of Patents, P.O. Box 1450, Alexandria, VA 22313-1450,

on October 7, 2003

*Heather Clark*  
Heather Clark

☒ The fee has been calculated as shown below:

(Col. 1)	(Col. 2)	(Col. 3)
CLAIMS REMAINING AFTER AMENDMENT		HIGHEST NO. PREVIOUSLY PAID FOR
TOTAL 241	MINUS	60 = 181
INDEPENDENT 29	MINUS	6 = 23
<input checked="" type="checkbox"/> PETITION TO WITHDRAWAL FROM ISSUE		
<input checked="" type="checkbox"/> REQUEST FOR CONTINUED EXAMINATION		

Small Entity	
RATE	ADDITIONAL FEE
x \$ 9.00=	\$1,629.00
x \$43.00=	\$ 989.00
\$130.00	\$ 130.00
\$385.00	\$ 385.00
Total	\$ 3,133.00

☒ ☒ A check in the amount of \$3,133.00 to cover fees is enclosed.☒ The Commissioner is hereby authorized to charge payment of the following fees associated with this communication or credit any overpayment to Deposit Account No. 19-0513. A duplicate copy of this sheet is enclosed.☒ ☒ Any additional filing fees required under 37 C.F.R. §1.16.☒ ☒ Any patent application processing fees under 37 C.F.R. §1.17.

Date: October 7, 2003

Respectfully submitted,

Schmeiser, Olsen & Watts LLP  
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By *Kenneth C. Booth*  
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January 22, 2004

Examiner Elizabeth Wood  
Mail Stop Mail 313(c)  
P.O. Box 1450  
Alexandria, VA 22313-1450

**Re: Interference of 09/578,001; Our Docket No.: ROWL-9955**

Dear Elizabeth:

Per your phone conversation with my assistant on January 21, 2004, the PTO has still been unable to locate the original interference documents we filed. Therefore, enclosed please find a copy of the interference and associated documents as filed. Also enclosed is a copy of the postcard from the PTO confirming the original documents were received.

Please transfer the interference as soon as possible and call me with the transfer's name. You can contact me at 480-655-0073. Thank you.

Very truly yours,

SCHMEISER, OLSEN & WATTS

*David E. Allred*

David E. Allred

DEA/hc  
Enclosure

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**JAN 28 2004**  
**TC 1700**

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# REQUEST FOR CONTINUED EXAMINATION (RCE) TRANSMITTAL

Address to:  
Mail Stop RCE  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Application Number	09/578,001
Filing Date	05/24/2000
First Named Inventor	McClain
Art Unit	1755
Examiner Name	Elizabeth Wood
Attorney Docket Number	ROWL-9955

**This is a Request for Continued Examination (RCE) under 37 CFR 1.114 of the above-identified application.**

Request for Continued Examination (RCE) practice under 37 CFR 1.114 does not apply to any utility or plant application filed prior to June 8, 1995, or to any design application. See Instruction Sheet for RCEs (not to be submitted to the USPTO) on page 2.

## 1. Submission required under 37 CFR 1.114

Note: If the RCE is proper, any previously filed unentered and amendments enclosed with the RCE will be entered in the order in which they were filed unless applicant instructs otherwise. If applicant does not wish to have any previously filed unentered amendment(s) entered, applicant must request non-entry of such

- a. ☐ Previously submitted. If a final Office action is outstanding, any amendments filed after the final Office action may be considered as a submission even if this box is not checked.
- i. ☐ Consider the arguments in the Appeal Brief or Reply Brief previously filed on \_\_\_\_\_
- ii. ☐ Other \_\_\_\_\_

## b. ☒ Enclosed

- i. ☐ Amendment/Reply      iii. ☒ Information Disclosure Statement (IDS)
- ii. ☐ Affidavit(s)/Declaration(s)      iv. ☒ Other Interference, Petition, Assoc Power of Atty

## 2. Miscellaneous

- a. ☐ Suspension of action on the above-identified application is requested under 37 CFR 1.103(c) for a period of \_\_\_\_\_ months. (Period of suspension shall not exceed 3 months; Fee under 37 CFR 1.17(i) required)
- b. ☐ Other \_\_\_\_\_

## 3. Fees

The RCE fee under 37 CFR 1.17(e) is required by 37 CFR 1.114 when the RCE is filed.

- a. ☒ The Director is hereby authorized to charge the following fees, or credit any overpayments to Deposit Account No. 19-0513
- i. ☒ RCE fee required under 37 CFR 1.17(e)
- ii. ☐ Extension of time fee (37 CFR 1.136 and 1.17)
- iii. ☒ Other \$130 for Petition and \$2,618 for extra claims
- b. ☒ Check in the amount of \$ 3,133.00 enclosed
- c. ☐ Payment by credit card (Form PTO-2038 enclosed)

**WARNING:** Information on this form may become public. Credit card information should not be included on this form. Provide credit card information and authorization on PTO-2038.

## SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT REQUIRED

Name (Print / Type)	Kenneth C. Booth	Registration No. (Attorney / Agent)	42,342
Signature	<i>Kenneth C. Booth</i>	Date	October 7, 2003

## CERTIFICATE OF MAILING OR TRANSMISSION

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to: Mail Stop RCE, Commissioner For Patents, P.O. Box 1450, Alexandria, VA 22313-1450 or facsimile transmitted to the U.S. Patent and Trademark Office on the date shown below.

Name (Print / Type)	Heather Clark	Date	October 7, 2003
Signature	<i>Heather Clark</i>		

This collection of information is required by 37 CFR 1.114. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.14. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing the burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop RCE, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

If you need assistance in completing the form, call 1-800-PTO-9199 and select option 2.

**Associate Power Of Attorney Or Agent (37 CFR 1.34)  
(For Representation Related To A Patent Application)**

Docket No.  
**ROWL-9955**

In Re Application Of: **McClain, et al.**

Serial No.  
**09/578,001**

Filing Date  
**05/24/2000**

Examiner  
**Elizabeth D. Wood**

Group Art Unit  
**1755**

Invention: **METHOD AND APPARATUS FOR PRODUCING AN AQUEOUS PAINT COMPOSITION FROM A PLURALITY OF PREMIXED COMPOSITIONS**

**TO THE COMMISSIONER FOR PATENTS:**

Please recognize the following as ☐ Associate Attorney ☒ Associate Agent in this application.

Name: **David E. Allred**

Reg. No.: **47,254**

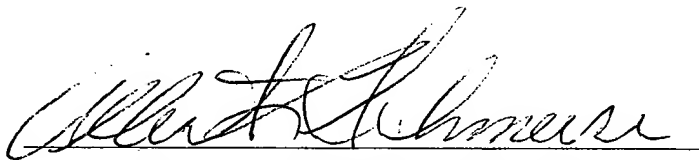
Address: **SCHMEISER, OLSEN & WATTS LLP  
18 E. University Dr. #101  
Mesa, AZ 85201**

Tel. No. **480-655-0073**

**RECEIVED**

**JAN 27 2004**

**OFFICE OF PETITIONS**



*Signature of Principal Attorney or Agent of Record*

**Albert L. Schmeiser  
Reg. No. 30,681  
SCHMEISER, OLSEN & WATTS LLP  
18 E. University Dr. #101  
Mesa, AZ 85201  
480-655-0073**

*Registration Number & Address of Principal Attorney or Agent of Record*

Dated: **October 3, 2003**

I certify that this document is being deposited on  
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class mail under 37 C.F.R. 1.8 and is addressed to the  
Commissioner for Patents, P.O. Box 1450, Alexandria, VA  
22313-1450.



*Signature of Person Mailing Correspondence*

**Heather Clark**

*Typed or Printed Name of Person Mailing Correspondence*

**Associate Power Of Attorney Or Agent (37 CFR 1.34)  
(For Representation Related To A Patent Application)**

Docket No.  
**ROWL-9955**

In Re Application Of: **McClain, et al.**

Serial No.  
**09/578,001**

Filing Date  
**05/24/2000**

Examiner  
**Elizabeth D. Wood**

Group Art Unit  
**1755**

Invention: **METHOD AND APPARATUS FOR PRODUCING AN AQUEOUS PAINT COMPOSITION FROM  
A PLURALITY OF PREMIXED COMPOSITIONS**

**TO THE COMMISSIONER FOR PATENTS:**

Please recognize the following as ☒ Associate Attorney ☐ Associate Agent in this application.

Name: **Kenneth C. Booth**

Reg. No.: **42,342**

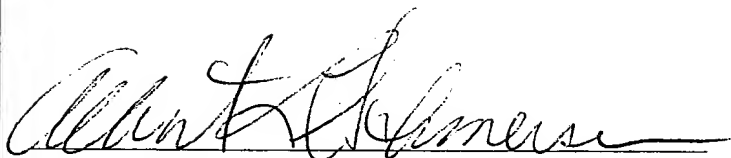
Address: **SCHMEISER, OLSEN & WATTS LLP  
18 E. University Dr. #101  
Mesa, AZ 85201**

Tel. No. **480-655-0073**

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**OFFICE OF PETITIONS**



*Signature of Principal Attorney or Agent of Record*

**Albert L. Schmeiser  
Reg. No. 30,681  
SCHMEISER, OLSEN & WATTS LLP  
18 E. University Dr. #101  
Mesa, AZ 85201  
480-655-0073**

*Registration Number & Address of Principal Attorney or Agent of Record*

Dated: **October 3, 2003**

I certify that this document is being deposited on  
**10/7/03** with the U.S. Postal Service as first  
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Commissioner for Patents, P.O. Box 1450, Alexandria, VA  
22313-1450.



*Signature of Person Mailing Correspondence*

**Heather Clark**

*Typed or Printed Name of Person Mailing Correspondence*

Practitioner's Docket No. ROWL-9955

**PATENT**

**RECEIVED**

**JAN 27 2004**

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In re application of: McClain et al.

Serial No.: 09/578,001

Group No.: 1755

Filed: May 24, 2000

Examiner: Elizabeth D. Wood

For: METHOD AND APPARATUS FOR PRODUCING AN AQUEOUS PAINT COMPOSITION FROM A PLURALITY OF PREMIXED COMPOSITIONS

Date of mailing "Notice of Allowance and  
Base Issue Fee Due" July 28, 2003

Batch No. \_\_\_\_\_

**Mail Stop 313(c)  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450**

*NOTE: Petitions to withdraw patent applications from issue (37 C.F.R. 1.313, M.P.E.P. § 1308) are decided by the Deputy Assistant Commissioner of Patents. M.P.E.P. § 1002(b). Letters requesting that the application be withdrawn from issue for purposes of interference with a patent (see M.P.E.P. § 1101.02(f) require the approval of the Group Director. M.P.E.P. § 1003.*

*WARNING: Papers requesting that an application be withdrawn from issue after the issue fee is paid, and any papers associated with the petition, including papers necessary for filing a continuing application, may be addressed as above or be hand-carried to the Office of Petitions, at Two Crystal Park, Suite 913. April 14, 1993, 1150 T.M.O.G. 27-28.*

**PETITION FOR WITHDRAWAL FROM ISSUE (37 C.F.R. 1.313)**

**PETITION**

1. Applicant hereby petitions for the immediate withdrawal of this application from issue under either 37 C.F.R. 1.313(c).

---

**CERTIFICATE OF MAILING/TRANSMISSION (37 C.F.R. 1.8(a))**

I hereby certify that, on the date shown below, this correspondence is being:

**MAILING**

X deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to the Commissioner for Patents, Alexandria, VA 22313.

**FACSIMILE**

☐ transmitted by facsimile to the Patent and Trademark Office.

Date: October 7, 2003

  
Signature

Heather Clark  
(type or print name of person certifying)

**PATENT ISSUE FEE**

**RECEIVED**

**JAN 27 2004**

**OFFICE OF PETITIONS**

2. The issue fee for this case

*(complete (a) or (b))*

- (a) ☐ has NOT been paid, but is due for payment on \_\_\_\_\_.  
(b) ☒ has been paid on August 8, 2003.

*(complete the following, if known)*

This application is scheduled to

- ☐ issue on \_\_\_\_\_  
☐ as patent \_\_\_\_\_.

**NOTE:** "While the specific time period varies, an allowed application generally receives a patent number and issue date within two weeks after the issue fee is received in the Patent and Trademark Office." M.P.E.P. 1308.

**REASON(S) FOR WITHDRAWAL REQUEST**

**NOTE:** "When the issue fee has been paid, the application will not be withdrawn from issue for any reason except: (1) A mistake on the part of the Office; (2) A violation of § 1.56, or illegality in the application; (3) Unpatentability of one or more claims; or (4) For interference." 37 C.F.R. 1.313(b).

3. The reason for the request for withdrawal from issue is:

*(check applicable item(s) below)*

- (a) ☐ there has been a mistake on the part of the Office.  
(b) ☐ there has been a violation of Section 1.56, or illegality in the application.  
(c) ☐ one or more of the claims are unpatentable.  
(d) ☒ for purposes of declaring an interference.  
(e) ☐ other.

Further details as to the reason(s) for this withdrawal request are set forth on the attached   1   sheet(s).

## PETITION FEES

*NOTE: The fee need only be paid, if the reason for withdrawal is not the fault of the Office. 37 C.F.R. 1.313(a).*

4. The petition fee (37 C.F.R. 1.17(i)) is paid as follows:

- ☒ Enclosed is a check in the sum of \$130.00.  
☐ Charge Account 19-0513 the sum of \$130.00.  
A duplicate of this petition is attached.

  
Signature of Practitioner

Reg. No.: 42,342

Kenneth C. Booth  
(type or print name of practitioner)

Tel. No.: (480) 655-0073

18 E. University Drive, Suite 101

Customer No.: ROWL-9955

Mesa, Arizona 85201-5946

Plus 1 Added Page

**PETITION FOR WITHDRAWAL FROM ISSUE (37 C.F.R. 1.313)**

**ADDED PAGE FOR REASON(S)**

Applicants request immediate withdrawal of the present application from issue under 37 C.F.R. 1.313(c) even though the issue fee has been paid because Applicants were not aware that an interference should have been provoked with interfering claims. Due to information, noted below, that has recently come to Applicants' attention, withdrawal of the present application from issue by the Patent Office under the initiative of the Applicants is hereby requested.

1. Applicant became aware of U.S. Patent No. 6,531,537 B2 having claims to the same invention as the present application.

A. The patent was issued March 11, 2003 (less than a year ago as required by 35 USC 135(a))

B. The present application was filed on May 24, 2000, before the pre-grant publication of the patent, which occurred on January 10, 2002. (Thus, the requirements of 35 USC 135(b) do not pertain to this application.)

C. Unless an Interference is provoked between the present application, with its May 24, 2000 filing date, and the issued claims of U.S. Patent No. 6,531,537 B2, Applicants will be significantly limited in their ability to provoke an interference with that patent because 35 USC 135(b) will impose significant restrictions on the claims that can be made in any other related application.

2. The issued claims in the patent could have been claimed in the present application.

A. Although Applicants have an earlier priority date by more than 1 year for the subject matter claimed by Patent No. 6,531,537 B2, the claims of the patent provide rights in that invention to another. Applicants' disclosure, though it uses slightly different language, discloses the same examples for its components and those in the issued patent.

3. There are no other related application(s) in which the patent claims could be presented without changing the thrust of those related applications. Furthermore, Applicants may be restricted from presentation of claims having the same or substantially the same subject matter in any related application under 35 USC 135(b) because all such related applications were filed or will be filed after the publication date of the patent. Alternatively stated, the present application is the only application that can avoid the requirement of 35 USC 135(b) by virtue of its filing date. In view of the nature and scope of the patent claims having an effective filing date more than one year after the effective filing date of the same subject matter in Applicants' application, Applicants need to provoke an interference in the present application with its 5/24/00 filing date.

Hence, Applicants hereby petition the commissioner to withdraw the present application from issue.

*(use additional pages, if necessary)*

Added Page 1

**INFORMATION DISCLOSURE STATEMENT PURSUANT TO**

**37 C.F.R. §§1.97-1.99**

**RECEIVED**

**JAN 27 2004**

***PATENT APPLICATION***

**OFFICE OF PETITIONS**

Applicant: McClain, et al.

Docket No.: ROWL-9955

FOR: METHOD AND APPARATUS FOR PRODUCING AN AQUEOUS PAINT  
COMPOSITION FROM A PLURALITY OF PREMIXED COMPOSITIONS

Commissioner for Patents  
Mail Stop 313(c)  
P.O. Box 1450  
Alexandria, VA 22313-1450

Sir:

In accordance with the duty of disclosure under 37 C.F.R. §1.56 and pursuant to 37 C.F.R. §§1.97-1.99, Applicant(s) hereby notifies the U.S. Patent and Trademark Office of the documents listed on the attached Form PTO-1449. One copy of each cited document is submitted herewith. Applicant respectfully submits that all pending claims are patentable over the foregoing references, alone or in combination. The Examiner is requested to initial the enclosed Form PTO-1449 and return a copy thereof to the undersigned.

The submission of the listed documents is not intended as an admission that any such document constitutes prior art against the claims of the present application. Applicant reserves the right to dispute any of the listed documents as prior art during examination. Further, Applicant does not waive any right to take any action that would be appropriate to antedate or otherwise remove any listed document as a competent reference against the claims of the present application. Furthermore, the submission of this Information Disclosure Statement is not to be

construed as a representation that a search has been made or that no other material information may exist.

Respectfully submitted,

By Kenneth C. Booth

Date: October 7, 2003

Enclosures: PTO-1449  
Patent copies

Form PTO-1449 U.S. DEPARTMENT OF COMMERCE (REV. 8-83) PATENT AND TRADEMARK OFFICE				ATTY. DOCKET NO. ROWL-9955		SERIAL NO.		
<b>INFORMATION DISCLOSURE CITATION</b>				APPLICANT McClain, et al.				
(Use several sheets if necessary)				FILING DATE		GROUP		
<b>U. S. PATENT DOCUMENTS</b>								
EXAMINER INITIAL	REF	DOCUMENT NUMBER	DATE	NAME	CLASS	SUB- CLASS	FILING DATE IF APPROPRIATE	
		4,243,430	01/1981	Sperry, et al.				
		4,403,866	09/1983	Falcoff, et al.				
		4,436,845	03/1984	Kitano				
		5,078,302	01/1992	Hellenberg				
		5,129,551	07/1992	Gott				
		5,527,853	06/1996	Landy et al.				
		5,672,649	09/1997	Brock et al.				
		5,823,670	10/1998	Rushing et al.				
		5,842,641	12/1998	Mazzalveri				
		5,922,398	07/1999	Hermes et al.				
		6,013,721	01/2000	Schall et al.				
		6,308,499	10/2001	Takada et al.				
<b>FOREIGN PATENT DOCUMENTS</b>								
	REF	DOCUMENT NUMBER	DATE	COUNTRY	CLASS	SUB- CLASS	TRANSLATION	
	CA	935 255	10/1973				YES	NO
	DE	39 10 472	10/1990					
	DE	197 14 577	10/1998					
	EP	0 614 951	9/1994					
	EP	0 706 543 B1	4/1996					
	EP	1 094 096	4/2001					
	IT	PS98A000005	2/1998					
	IT	PS98A000005	8/1999					
	WO	94/25238	11/1994					
	WO	95/29960	11/1995					
	WO	98/05417	2/1998					
	WO	00/37568	8/2000					
	WO	00/44834	8/2000					
	IE	940666	8/1994					
<b>OTHER DOCUMENTS (Including Author, Title, Date, Pertinent Pages, Etc.)</b>								
		Patton, "Latex Critical Pigment Volume Concentration (LCPVC)", <i>Paint Flow and Pigment Dispersion</i> , 1979, p. 193.						
		Forsius, "Paint Production by Component Mixing", <i>Faerg Lack Scand.</i> , 1997, 43(2), 5-6.						
		Dutheillet, "Integrated Solution to Build Batch Processing Plants for Blending & Formulation Industries", <i>Chemical Engineering World</i> , 1997 32(5), 37-44.						

		Orcun, et al., "Scheduling of Batch Processes: An Industrial Application in Paint Industry", <i>Computers Chem. Enng.</i> , 1997, 21, S673-S678.
		"Component Mixing - A New Approach to Customized Paint Production", <i>High Technology Finland</i> , 2000, 156-157.
		Helander, "Benefits of delayed product differentiation", <i>Reprinted from PPCJ</i> , 1999.
		Helander, "Impact of Form Postponement on Channel Members' Performance in Paint Business: A Theoretical Approach", <i>LTA</i> , 1999, p. 225-237.
<b>EXAMINER</b>		<b>DATE CONSIDERED</b>
<p><b>*EXAMINER:</b> Initial if citation considered, whether or not citation is in conformance with MPEP 609; Draw line through citation if not in conformance and not considered. Include copy of this form with next communication to applicant.</p>		

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JAN 27 2004

**IN THE UNITED STATES PATENT AND  
TRADEMARK OFFICE**

OFFICE OF PETITIONS

***AMENDMENT***

Applicant:	McClain	Docket No.:	ROWL-9955
Serial No.:	09/578,001	Group Art Unit:	1755
Filed:	05/24/2000	Examiner:	Wood, Elizabeth D.
TITLE:	METHOD AND APPARATUS FOR PRODUCING AN AQUEOUS PAINT COMPOSITION FROM A PLURALITY OF PREMIXED COMPOSITIONS		

**REQUEST BY APPLICANT FOR INTERFERENCE PURSUANT  
TO 37 C.F.R. § 1.604 & § 1.607  
AND AMENDMENT**

Mail Stop 313(c)  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Dear Sir:

This paper serves three purposes, namely: (1) to serve as a request for continued examination; (2) to amend the claims pending in the application; and (3) to request an Interference by Applicant pursuant to 37 C.F.R. § 1.604 and § 1.607. This paper is being filed in response to Applicants' becoming aware of interfering claims in an issued patent and in a pending application as set forth below. This amendment is accompanied by a petition to

withdraw the application from issue, and a request for continued examination for the same purpose. Applicants respectfully request entry of the amendment prior to further examination.

Applicants also request that the application be forwarded to the **Office of Petitions** to promptly begin the interference proceedings. An associate power of attorney making additional individuals of record is also included.

The following Table of Contents will aid the Examiner in identifying the various portions of this paper.

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III.	Request for Interference under 37 C.F.R. § 1.604 & § 1.607.....	page 5
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B.	Friel's Patent (U.S. Patent No. 6,531,537)	
C.	Friel's Application (U.S. Publication No. 2002/0016405)	
D.	Excerpts from the Paint Dictionary	
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F.	Excerpts from the Chemical Dictionary	
G.	Table of Claims in Parallel Columns with Highlighted Corresponding Terminology	
H.	Table of Claims Using Original Terminology	

### **I. NOTICE OF PETITION TO WITHDRAW FROM ISSUE**

A separate paper filed herewith includes a petition to withdraw from issue pursuant to 37 CFR 1.114 (c). The required fee of \$130.00 is included with this petition and amendment.

### **II. REQUEST FOR CONTINUED EXAMINATION UNDER 37 § CFR 1.114**

Applicants hereby request continued examination of the above referenced application under 37 CFR 1.114 (c) for the purpose of provoking an interference. The required fee of \$385.00 for the RCE and an additional fee of \$2,618.00 for additional claims. These fees together with the petition fee of \$130.00 for the accompanying petition require the total payment of \$3,133.00 included herewith.

### **III. REQUEST FOR INTERFERENCE**

Applicants hereby request the Office to provoke an interference proceeding between the above referenced application, U.S. patent No. 6,531,537 to Friel et al., and U.S. patent application publication No. 2002/0016405 pursuant to 37 CFR 1.607. Priority dates and other pertinent information are provided in the remarks section below.

#### **IV. AMENDMENTS TO THE SPECIFICATION**

Please substitute the following paragraphs for the paragraphs indicated by page and line number as follows:

On page 1, the paragraph beginning at line 13:

The traditional manufacture of paint has utilized processes which continuously fill containers with a neutral or base color at the central facility. The containers are transported to the point of use or point of sale and stored until use or resale. The transport and storage in the individual containers adds significantly to the cost of the sold product for it is necessary to inventory a wide variety of paints having different finish characteristics to satisfy consumer demand. For example, the finishes offered for sale range from the traditional flat paint through varying resin compositions up to a high gloss finish. Inventory is maintained for all the different finishes at the point of sale by the merchant.

On page 2, the paragraph beginning at line 11:

The present invention is directed to the provision of prepaints, which are fluid prepaint compositions or premixed aqueous compositions which can be used to provide a paint mixture of varying finish characteristics at the point of sale. Thus, the merchant distributing the paint composition made from the subject premixed compositions need only maintain inventory of four compositions. The particular compositions which are the subject of the invention exhibit stable characteristics during storage in their respective reservoirs.

On page 3, the paragraph beginning at line 15:

A method of producing an aqueous paint composition or fluid prepaint is also provided. The method includes storing a first premixed composition in a first supply reservoir. The first composition may be any one of four compositions, the four compositions including a pigment composition, a dispersant thickening agent, a high resin content binder, and a low resin content binder. The apparatus also includes a second supply reservoir containing a second premixed composition that is another of the four compositions. The method also includes storing a second premixed composition that is another of the four compositions in a second supply reservoir. The method determines a first predetermined amount of the first premixed composition and a second predetermined amount of the second premixed composition. The first premixed composition is supplied from the first supply reservoir to a receiving reservoir, and the second premixed composition is supplied from the second supply reservoir to the receiving reservoir. A first flow amount of the first premixed composition supplied from the first supply reservoir to the receiving reservoir and a second flow amount of the second premixed composition supplied from the second supply reservoir to the receiving reservoir are measured. Supply of the first premixed composition is ceased when the first flow amount equals the first predetermined amount and supply of the second premixed composition is ceased when the second flow amount equals the second predetermined amount.

On page 6, the paragraph beginning at line 19:

The pigment-containing constituent or premixed pigment composition preferably contains titanium dioxide finely ground in an amount residing within the range of 40 to 50 percent by weight of the pigment. The titanium dioxide is an opacifying pigment. The ground titanium dioxide is a commercially available product used in a wide variety of paint compositions and its preparation techniques are well-known in the industry. The titanium dioxide is added to water which comprises about 25 percent of the resultant pigment composition. During the blending process, a mixture of calcined clay and silica in an amount of 15 percent by weight is added to maintain the titanium dioxide in suspension. A viscosity controlling agent is also added in an amount of about 10 percent of the resultant dispersion or pigment composition.

On page 8, the paragraph beginning at line 20:

The dispersant-thickener agent is preferably used in formulating all paint compositions with the exception of a high gloss finish paint composition. The third and fourth compositions available for mixing are the resin-containing compositions. The low resin composition or extender prepaint is preferably about 50 percent resin by weight and about 28 percent water. However, the percentage of resin by weight can be as low as 10 percent. To this mixture of resin and water is added diatomaceous earth as a flattening agent or an extender pigment in the amount of about 7 percent and a combination of ground limestone and calcined clay at about 11 percent and about 3.5 percent respectively. The ground limestone, or calcium carbonate, is another example of an extender pigment. The combination of a dispersant and thickener are added in the aggregate amount of about 1.2 percent to promote the same long shelf life characteristic of the pigment composition.

On page 9, the paragraph beginning at line 5:

The high resin component preferably contains resin in an amount of about 80 percent, water at about 15 percent and a commercially-available coalescent at about 2 percent. However, the percentage of resin by weight can be as high as about 90 percent. The amount of resin and water in the low and high resin compositions can be varied to achieve different finish characteristics. The resin utilized in the paint products formulated from the different combinations and found to provide the desired results is a 100 percent acrylic acrylon resin, such as the resin sold under the trademark 6183 by BASF. This resin is polymeric and inherently produces a latex paint composition. However, it is to be noted that other commercially available resins can be used if desired.

On page 10, the paragraph beginning at line number 1:

The four compositions can also be varied to produce varying quality levels and to produce paint compositions that are suitable for either interior or exterior use and paint compositions having various color bases so that they are suitable for use as different types of colors. As is well known, a plurality of paint compositions or a paint line includes two or more different paint compositions in which the dried films differ materially from each other in at least one measurable property.

On page 11, the paragraph beginning at line 6:

All the foregoing examples are typical for retail quality paints suitable for exterior use with pastel colors. As can be appreciated from the disclosure provided herein, paint compositions may be provided by combining a set of two or more premixed compositions or prepaints.

## **V. AMENDMENTS TO THE CLAIMS**

Please cancel claims 1-86 and add the following new claims:

### **COUNT 1 - (Product –Prepaints and Paint Composition)**

- 1 87. (new) A set of different, but mutually compatible fluid prepaints, sufficient to form at least  
2 one paint line, which set comprises:
- 3 (i.) at least one opacifying prepaint comprising at least one opacifying pigment;  
4 (ii.) at least one extender prepaint comprising at least one extender pigment; and  
5 (iii.) at least one binder prepaint comprising at least one latex polymeric binder.
- 1 88. (new) A set of different, but mutually compatible aqueous prepaint compositions, sufficient  
2 to form at least one set of paint products, which set comprises:
- 3 (i.) at least one pigment prepaint composition comprising at least one opacifying  
4 pigment;  
5 (ii.) at least one extender prepaint composition comprising at least one extender agent; and  
6 (iii) at least one binder prepaint composition comprising at least one polymeric binder.
- 1 89. (new) A plurality of varied, but compatible premixed aqueous compositions, sufficient to  
2 form a variety of paint compositions, which plurality comprises:
- 3 (i) at least one premixed pigment composition provided as an aqueous solution  
4 comprising an opacifying pigment;  
5 (ii) at least one premixed low resin composition provided as an aqueous solution  
6 comprising a flattening agent; and  
7 (iii) at least one premixed a high resin composition provided as an aqueous solution  
8 comprising a resinous binder.
- 1 90. (new) The set of prepaints of claim 87, wherein the number of prepaints is 3 or more.

- 1 91. (new) The set of aqueous prepaint compositions of claim 88, wherein the number of  
2 prepaint compositions is 3 or more.
- 1 92. (new) The plurality of premixed aqueous compositions of claim 89, wherein the number of  
2 premixed compositions is 3 or more.
- 1 93. (new) The set of prepaints of claim 87, wherein the opacifying prepaint further comprises at  
2 least one particulate polymeric binder adsorbed onto the opacifying pigment.
- 1 94. (new) The set of aqueous prepaint compositions of claim 88, wherein the at least one  
2 pigment prepaint composition further comprises at least one particulate polymeric binder  
3 adsorbed onto the opacifying pigment.
- 1 95. (new) The plurality of premixed aqueous compositions of claim 89, wherein the premixed  
2 pigment composition further comprises at least one particulate resinous binder adsorbed onto the  
3 opacifying pigment.
- 1 96. (new) The set of prepaints of claim 87, wherein the extender prepaint further comprises at  
2 least one particulate polymeric binder absorbed onto the extender pigment.
- 1 97. (new) The set of aqueous prepaint compositions of claim 88, wherein the at least one  
2 extender prepaint composition further comprises at least one particulate polymeric binder  
3 absorbed onto the extender agent.
- 1 98. (new) The plurality of premixed aqueous compositions of claim 89, wherein the premixed  
2 low resin composition further comprises at least one particulate resinous binder absorbed onto  
3 the flattening agent.
- 1 99. (new) The set of prepaints of claim 87, wherein the extender prepaint has a PVC of about  
2 35% to about 100%.

100. (new) The set of aqueous prepaint compositions of claim 88, wherein the extender composition has a PVC of about 35% to about 100%.

101. (new) The plurality of premixed aqueous compositions of claim 89, wherein the premixed low resin composition has a PVC of about 35% to about 100%

102. (new) A paint line produced by a process which comprises the steps of:

(a.) providing a set of different, but mutually compatible, fluid prepaints, which set comprises:

- (i.) at least one opacifying prepaint comprising at least one opacifying pigment,
  - (ii.) at least one extender prepaint comprising at least one extender pigment, and
  - (iii.) at least one binder prepaint comprising at least one latex polymeric binder;
- and

(b.) dispensing a predetermined amount of each of the prepaints into containers to form the paint line.

103. (new) A paint line produced by a process which comprises the steps of:

(a) providing a set of different, but mutually compatible, prepaints compositions, which set comprises:

- (i) at least one pigment prepaint composition as an aqueous solution comprising an opacifying pigment;
- (ii) at least one low resin prepaint composition as an aqueous solution comprising a extender agent; and
- (iii) at least one high resin prepaint composition as an aqueous solution comprising a polymeric binder; and

(b) dispensing a predetermined amount of each of the prepaint compositions into containers to form an aqueous paint composition of the paint line.

1 104. (new) A plurality of aqueous paint products produced by a process which comprises the  
2 steps of :

3 (a) providing a plurality of varied, but compatible premixed pigment compositions as an  
4 aqueous solution, which plurality of compositions comprises;

5 (i) at least one premixed pigment composition as an aqueous solution comprising  
6 an opacifying pigment;

7 (ii) at least one premixed a low resin composition as an aqueous solution  
8 comprising a flattening agent;

9 (iii) at least one premixed high resin composition as an aqueous solution  
10 comprising a resinous binder; and

11 (b) dispensing a predetermined amount of each of the premixed compositions into  
12 containers to form an aqueous paint product of the plurality of paint products.

1 105. (new) A set of different, but mutually compatible, fluid prepaints sufficient to formulate at  
2 least one paint line useful for forming pigmented and clear coatings, which set comprises:

3 (i) at least one prepaint comprising at least one opacifying pigment; and

4 (ii) at least two prepaints each of which comprises at least one latex polymeric binder.

1 106. (new) An plurality of different, but compatible fluid prepaint compositions sufficient to  
2 formulate a plurality of aqueous paint compositions useful for forming pigmented and clear  
3 coatings, which plurality of prepaint compositions comprising:

4 (i) at least one prepaint composition comprising an opacifying pigment; and

5 (ii) at least two prepaint compositions each of which comprises at least one polymeric  
6 binder.

1 107. (new) A plurality of different but compatible aqueous premixed compositions sufficient to  
2 formulate a plurality of paint products useful for forming pigmented coatings, which plurality of  
3 premixed compositions comprising:

4 (i) at least one premixed composition as an aqueous solution having an opacifying  
5 pigment;

6 (ii) at least two premixed compositions as aqueous solutions each of which comprises at  
7 least one resin containing binder.

1 108. (new) A method of forming at least one paint line, which method comprises the steps of:

2 (a) providing the set of prepaints of claim 105; and

3 (b) dispensing a predetermined amount of each of the prepaints into containers or  
4 applicators to form the paint line.

1 109. (new) A method of forming a plurality of aqueous paint compositions, which method  
2 comprises the steps of:

3 (a) providing a plurality of the prepaint compositions of claim 106; and

4 (b) dispensing a predetermined amount of each of the prepaint compositions into  
5 containers to form the plurality of paint compositions.

1 110. (new) A method of forming a plurality of paint products, which method comprises the  
2 steps of:

3 (a) providing a plurality of the premixed compositions of claim 107; and

4 (b) dispensing a predetermined amount of each of the premixed compositions into  
5 containers to form the plurality of paint products.

## COUNT 2 (Method of Producing a Paint Line)

1 111. (new) A method of forming at least one paint line, comprising the steps of:

2 (a) providing a set of different, but mutually compatible, fluid prepaints, comprising:

3 (i) at least one opacifying prepaint, comprising at least one opacifying pigment;

4 (ii) at least one extender prepaint comprising at least one extender pigment; and

5 (iii) at least one binder prepaint comprising at least one latex polymeric binder; and

6 (b) dispensing a predetermined amount of each of the prepaints into containers or

7 applicator(s) to form the paint line.

1 112. (new) A method of forming a plurality of paint products, comprising the steps of:

2 (a) providing a set of varied, but mutually compatible aqueous prepaint compositions,  
3 comprising:

4 (i) at least one pigment prepaint composition comprising an opacifying pigment;

5 (ii) at least one extender prepaint composition comprising an extender agent; and

6 (iii) at least one, binder prepaint composition comprising a polymeric binder; and

7 (b) dispensing a predetermined amount of each of the prepaint compositions into

8 containers to form the plurality of paint products.

1 113. (new) A method of forming a plurality of paint products comprising the steps of:

2 (a) providing a plurality of varied, but compatible premixed aqueous compositions  
3 comprising:

4 (i) at least one premixed pigment composition comprising an opacifying pigment;

5 (ii) at least one premixed low resin composition comprising a flattening agent;

6 (iii) at least one premixed high resin composition comprising a resin containing

7 binder; and

8 (b) dispensing a predetermined amount of each of the premixed compositions into

9 containers to form the plurality of paint products.

1 114. (new) The method of claim 111, further comprising the step of mixing the prepaint before,  
2 while, or after they are dispensed into the containers.

1 115. (new) The method of claim 112, further comprising the step of mixing the prepaint  
2 compositions before, while, or after they are dispensed into the containers.

1 116. (new) The method of claim 113, further comprising the step of mixing the premixed  
2 compositions before, while, or after they are dispensed into the containers.

1 117. (new) The method of claim 111, further comprising the step of mixing the prepaint before  
2 or while they are dispensed into the applicator(s).

1 118. (new) The method of claim 112, further comprising the step of mixing the prepaint  
2 compositions before or while they are dispensed into the containers.

1 119. (new) The method of claim 113, further comprising the step of mixing the premixed  
2 compositions before or while they are dispensed into the containers.

1 120. (new) The method of claim 111, further comprising the step of adjusting the viscosity of  
2 the prepaints before, while, or after they are dispensed into the containers.

1 121. (new) The method of claim 112, further comprising the step of adjusting the viscosity of  
2 the prepaint compositions before, while, or after they are dispensed into the containers.

1 122. (new) The method of claim 113, further comprising the step of adjusting the viscosity of  
2 the premixed compositions before, while, or after they are dispensed into the containers.

1 123. (new) The method of claim 111, further comprising the step of adjusting the viscosity of  
2 the dispensed prepaints before or while they are dispensed into the applicator(s).

1 124. (new) The method of claim 112, further comprising the step of adjusting the viscosity of  
2 the prepaint compositions before or while they are dispensed into the containers.

- 1 125. (new) The method of claim 113, further comprising the step of adjusting the viscosity of  
2 the premixed compositions before or while they are dispensed into the containers.
- 1 126. (new) The method of claim 111, further comprising the step of adding at least one additive  
2 that enhances application or final performance of the paint.
- 1 127. (new) The method of claim 112, further comprising the step of adding at least one additive  
2 that enhances application or final performance of the paint products.
- 1 128. (new) The method of claim 113, further comprising the step of adding at least one additive  
2 that enhances application or final performance of the paint products.
- 1 129. (new) The method of claim 126, wherein the additive is a thickener.
- 1 130. (new) The method of claim 127, wherein the additive is a thickener.
- 1 131. (new) The method of claim 128, wherein the additive is a thickener.
- 1 132. (new) The method of claim 111, further comprising the step of adding at least one colorant  
2 to the prepaints.
- 1 133. (new) The method of claim 112, further comprising the step of adding at least one colorant  
2 to the prepaint compositions.
- 1 134. The method of claim 113, further comprising the step of adding at least one colorant to the  
2 premixed compositions.
- 1 135. (new) The method of claim 111, wherein the opacifying prepaint further comprises at least  
2 one particulate polymeric binder absorbed onto the opacifying pigment.

- 1 136. (new) The method of claim 112; wherein the pigment composition further comprises at  
2 least one particulate polymeric agent absorbed onto the opacifying pigment.
- 1 137. (new) The method of claim 113, wherein the pigment composition further comprises at  
2 least one particulate resin absorbed onto the opacifying pigment.
- 1 138. (new) The method of claim 111, wherein the extender prepaint further comprises at least  
2 one particulate polymeric binder absorbed onto the extender pigment.
- 1 139. (new) The method of claim 112, wherein the extender prepaint composition further  
2 comprises at least one particulate polymeric resin absorbed onto the extender agent.
- 1 140. (new) The method of claim 113, wherein the low resin composition further comprises at  
2 least one particulate resin binder absorbed onto the flattening agent.
- 1 141. (new) The method of claim 111, wherein the method is carried out at a paint manufacturing  
2 facility.
- 1 142. (new) The method of claim 112, wherein the method is carried out at a paint manufacturing  
2 facility.
- 1 143. (new) The method of claim 113, wherein the method is carried out at a paint manufacturing  
2 facility.
- 1 144. (new) The method of claim 111, wherein the number of prepaints is 4 or more.
- 1 145. (new) The method of claim 112, wherein the number of prepaint compositions is 4 or  
2 more.
- 1 146. (new) The method of claim 113, wherein the number of premixed compositions is 4 or  
2 more.

- 1 147. (new) The method of forming at least one paint line of claim 111 wherein the extender  
2 prepaint has a PVC of about 35% to about 100%.
- 1 148. (new) The method of forming a plurality of paint products claim 112, wherein the extender  
2 prepaint composition has a PVC of about 35% to about 100%.
- 1 149. (new) The method of forming a plurality of paint products claim 113, wherein the low resin  
2 composition has a PVC of about 35% to about 100%.
- 1 150. (new) The method of claim 111, wherein the method is carried out at the point-of-sale.
- 1 151. (new) The method of claim 112, wherein the method is carried out at the point-of-sale.
- 1 152. (new) The method of claim 113, wherein the method is carried out at the point-of-sale.
- 1 153. (new) The method of claim 111, wherein the method is carried out at the point-of-use.
- 1 154. (new) The method of claim 112, wherein the method is carried out at the point-of-use.
- 1 155. (new) The method of claim 113, wherein the method is carried out at the point-of-use.
- 1 156. (new) The method of claim 111, wherein the method is controlled by a computer.
- 1 157. (new) The method of claim 112, wherein the method is controlled by a computer.
- 1 158. (new) The method of claim 113, wherein the method is controlled by a computer.

1 159. (new) A method of forming a range of paints, the range comprising at least two paint lines,  
2 which method comprises the steps of:

3 (a) providing a set of different, but mutually compatible, fluid prepaints sufficient to  
4 formulate at least two paint lines, which set comprises:

5 (i) at least one opacifying prepaint, comprising at least one opacifying pigment;

6 (ii) at least one extender prepaint comprising at least one extender pigment;

7 (iii) at least one binder prepaint comprising at least one latex polymeric binder; and

8 (iv) at least one additional, different opacifying, extender, or binder prepaint selected  
9 from the group consisting of (i), (ii), and (iii); and

10 (b) dispensing a predetermined amount of each of the prepaints into containers or  
11 applicator(s) to form the range of paints.

1 160. (new) A method of forming a range of paint products, the range comprising variations in at  
2 least two of the paint products:

3 (a) providing a set of varied, but mutually compatible, aqueous prepaint compositions  
4 sufficient to formulate the at least two varied paint products, which set comprises:

5 (i) at least one pigment prepaint composition comprising an opacifying pigment;

6 (ii) at least one extender prepaint composition comprising an extender agent;

7 (iii) at least one, binder prepaint composition comprising a polymeric binder; and

8 (iv) at least one additional, different opacifying, extender, or binder prepaint

9 composition selected from the group consisting of (i), (ii), and (iii); and

10 (b) dispensing a predetermined amount of each of the prepaint compositions into  
11 containers to form the at least two of paint products.

1 161. (new) A method of forming a range of paint products, the range comprising variations in  
2 the plurality of the paint products:  
3 (a) providing a plurality of varied, but compatible premixed aqueous compositions  
4 sufficient to formulate the at plurality of varied paint products, which plurality comprises:  
5 (i) at least one premixed pigment composition comprising an opacifying pigment;  
6 (ii) at least one premixed low resin composition comprising a flattening agent;  
7 (iii) at least one premixed high resin composition comprising a resin containing  
8 binder; and  
9 (iv) at least one additional, different premixed pigment, low resin, or high resin  
10 composition selected from the group consisting of (i), (ii), and (iii); and  
11 (b) dispensing a predetermined amount of each of the premixed compositions into  
12 containers to form the plurality of paint products.

1 162. (new) The method of claim 159, further comprising the step of mixing the prepaint before,  
2 while, or after they are dispensed into the containers.

1 163. (new) The method of claim 160, further comprising the step of mixing the prepaint  
2 compositions before, while, or after they are dispensed into the containers.

1 164. (new) The method of claim 161, further comprising the step of mixing the premixed  
2 compositions before, while, or after they are dispensed into the containers.

1 165. (new) The method of claim 159, further comprising the step of mixing the prepaint before  
2 or while they are dispensed into the applicator(s).

1 166. (new) The method of claim 160, further comprising the step of mixing the prepaint  
2 compositions before or while they are dispensed into the containers.

1 167. (new) The method of claim 161, further comprising the step of mixing the premixed  
2 compositions before or while they are dispensed into the containers.

- 1 168. (new) The method of claim 159, further comprising the step of adjusting the viscosity of  
2 the prepaints before, while, or after they are dispensed into the containers.
- 1 169. (new) The method of claim 160, further comprising the step of adjusting the viscosity of  
2 the prepaint compositions before, while, or after they are dispensed into the containers.
- 1 170. (new) The method of claim 161, further comprising the step of adjusting the viscosity of  
2 the premixed compositions before, while, or after they are dispensed into the containers.
- 1 171. (new) The method of claim 159, further comprising the step of adjusting the viscosity of  
2 the dispensed prepaints before or while they are dispensed into the applicator(s).
- 1 172. (new) The method of claim 160, further comprising the step of adjusting the viscosity of  
2 the prepaint compositions before or while they are dispensed into the containers.
- 1 173. (new) The method of claim 161, further comprising the step of adjusting the viscosity of  
2 the premixed compositions before or while they are dispensed into the containers.
- 1 174. (new) The method of claim 159, further comprising the step of adding at least one additive  
2 that enhances application or final performance of the paint.
- 1 175. (new) The method of claim 160, further comprising the step of adding at least one additive  
2 that enhances application or final performance of the paint products.
- 1 176. (new) The method of claim 161, further comprising the step of adding at least one additive  
2 that enhances application or final performance of the paint products.
- 1 177. (new) The method of claim 174, wherein the additive is a thickener.
- 1 178. (new) The method of claim 175, wherein the additive is a thickener.

- 1 179. (new) The method of claim 176, wherein the additive is a thickener.
- 1 180. (new) The method of claim 159, further comprising the step of adding at least one colorant  
2 to the prepaints.
- 1 181. (new) The method of claim 160, further comprising the step of adding at least one colorant  
2 to the prepaint compositions.
- 1 182. The method of claim 161, further comprising the step of adding at least one colorant to the  
2 premixed compositions.
- 1 183. (new) The method of claim 159, wherein the opacifying prepaint further comprises at least  
2 one particulate polymeric binder absorbed onto the opacifying pigment.
- 1 184. (new) The method of claim 160, wherein the pigment composition further comprises at  
2 least one particulate polymeric agent absorbed onto the opacifying pigment.
- 1 185. (new) The method of claim 161, wherein the pigment composition further comprises at  
2 least one particulate resin absorbed onto the opacifying pigment.
- 1 186. (new) The method of claim 159, wherein the extender prepaint further comprises at least  
2 one particulate polymeric binder absorbed onto the extender pigment.
- 1 187. (new) The method of claim 160, wherein the extender prepaint composition further  
2 comprises at least one particulate polymeric resin absorbed onto the extender agent.
- 1 188. (new) The method of claim 161, wherein the low resin composition further comprises at  
2 least one particulate resin binder absorbed onto the flattening agent.
- 1 189. (new) The method of claim 159, wherein the method is carried out at a paint manufacturing  
2 facility.

- 1 190. (new) The method of claim 160, wherein the method is carried out at a paint manufacturing  
2 facility.
- 1 191. (new) The method of claim 161, wherein the method is carried out at a paint manufacturing  
2 facility.
- 1 192. (new) The method of claim 159, wherein the number of prepaints is 4 or more.
- 1 193. (new) The method of claim 160, wherein the number of prepaint compositions is 4 or  
2 more.
- 1 194. (new) The method of claim 161, wherein the number of premixed compositions is 4 or  
2 more.
- 1 195. (new) The method of forming at least one paint line of claim 159 wherein the extender  
2 prepaint has a PVC of about 35% to about 100%.
- 1 196. (new) The method of forming a plurality of paint products claim 160, wherein the extender  
2 prepaint composition has a PVC of about 35% to about 100%.
- 1 197. (new) The method of forming a plurality of paint products claim 161, wherein the low resin  
2 composition has a PVC of about 35% to about 100%.
- 1 198. (new) The method of claim 159, wherein the method is carried out at the point-of-sale.
- 1 199. (new) The method of claim 160, wherein the method is carried out at the point-of-sale.
- 1 200. (new) The method of claim 161, wherein the method is carried out at the point-of-sale.
- 1 201. (new) The method of claim 159, wherein the method is carried out at the point-of-use.
- 1 202. (new) The method of claim 160, wherein the method is carried out at the point-of-use.

1    203. (new)   The method of claim 161, wherein the method is carried out at the point-of-use.

1    204. (new)   The method of claim 159, wherein the method is controlled by a computer.

1    205. (new)   The method of claim 160, wherein the method is controlled by a computer.

1    206. (new)   The method of claim 161, wherein the method is controlled by a computer.

9

### COUNT 3 (A Pigmented Prepaint Composition)

1 207. (new) A fluid opacifying prepaint useful for formulating a one pack, pigmented latex paint  
2 having a volume solids content of about 30% to about 70% and a Stormer viscosity of about 50  
3 to about 250 KU, which prepaint contains other paint ingredients, which prepaint consists  
4 essentially of:

- 5 (i) at least one opacifying pigment,
- 6 (ii) at least one dispersant,
- 7 (iii) at least one thickener, and
- 8 (iv) water;

9 wherein the dispersant(s) and the thickener(s) are mutually compatible with the pigment(s) and  
10 with the other paint ingredients.

1 208. (new) A premixed aqueous pigment composition useful for formulating a one pack,  
2 pigmented aqueous paint composition having a volume solids content of about 30% to about  
3 70% and a Stormer viscosity of about 50 to about 250 KU, which premixed composition contains  
4 other paint ingredients, which premixed aqueous composition consists essentially of:

- 5 (i) at least one opacifying pigment,
- 6 (ii) at least one dispersant,
- 7 (iii) at least one thickener, and
- 8 (iv) water;

9 wherein the dispersant(s) and the thickener(s) are mutually compatible with the pigment(s) and  
10 with the other paint composition ingredients.

1 209. (new) The prepaint of claim 207, wherein the volume solids content is about 35% to about  
2 50% and the Stormer viscosity is about 60 to about 150 KU.

1 210. (new) The premixed aqueous pigment composition of claim 208, wherein the volume  
2 solids content is about 35% to about 50% and the Stormer viscosity is about 60 to about 150 KU.

1 211. (new) The prepaint of claim 207, wherein the opacifying pigment comprises titanium  
2 dioxide.

- 1 212. (new) The premixed aqueous pigment composition of claim 208, wherein the opacifying  
2 pigment comprises titanium dioxide.
- 1 213. (new) The prepaint of claim 207, wherein the dispersant comprises potassium  
2 tripolyphosphate.
- 1 214. (new) The premixed aqueous pigment composition of claim 208, wherein the dispersant  
2 comprises potassium tripolyphosphate.
- 1 215. (new) The prepaint of claim 207, wherein the thickener comprises a cellulosic.
- 1 216. (new) The premixed aqueous pigment composition of claim 208, wherein the thickener a  
2 cellulosic.
- 1 217. (new) The prepaint of claim 207, further consisting essentially of at least one additive  
2 comprising a coalescent, with the additive being present in an amount of less than about 10% by  
3 weight, based on the total weight of the prepaint.
- 1 218. (new) The premixed aqueous pigment composition of claim 208, further consisting  
2 essentially of at least one additive comprising a coalescent, with the additive being present in an  
3 amount of less than about 10% by weight, based on the total weight of the premixed aqueous  
4 pigment composition.
- 1 219. (new) A set of two different, but mutually compatible fluid prepaints useful for formulating  
2 a latex paint, which set comprises:  
3 (a) the opacifying prepaint of claim 207; and  
4 (b) a latex polymeric binder prepaint having volume solids content of about 25% to about  
5 70% or a Brookfield viscosity of less than about 100,000 centipoise at a shear rate of  
6 1.25 reciprocal seconds, which prepaint consists essentially of a water-borne latex  
7 polymeric binder having a Tg of about -430 degrees C. to about 70 degrees C. and  
8 water;  
9 wherein the prepaint ingredients are mutually compatible with each other and with the  
10 ingredients of the other prepaint in the set.

1 220. (new) A set of two different, but mutually compatible premixed aqueous compositions  
2 useful for formulating an aqueous paint composition, which set comprises:

3 (a) the premixed aqueous pigment composition of claim 208; and

4 (b) a premixed polymeric binder composition having volume solids content of about 25%  
5 to about 70% or a Brookfield viscosity of less than about 100,000 centipoise at a  
6 shear rate of 1.25 reciprocal seconds, which binder composition consists  
7 essentially of a water-borne resin containing binder having a Tg of about -430  
8 degrees C. to about 70 degrees C. and water;

9 wherein the ingredients of the premixed compositions are mutually compatible with each other  
10 and with the ingredients of the other premixed compositions in the set.

1 221. (new) The set of prepaints of claim 219, wherein the binder prepaint has a volume solids  
2 content of about 30 to about 65% and a Brookfield viscosity of about 100 to about 50,000  
3 centipoise at a shear rate of 1.25 reciprocal seconds, and consists essentially of a water-borne  
4 polymeric binder having a Tg of about -10 to about 60 degrees C.

1 222. (new) The set of premixed aqueous compositions of claim 220, wherein the premixed  
2 binder composition has a volume solids content of about 30 to about 65% and a Brookfield  
3 viscosity of about 100 to about 50,000 centipoise at a shear rate of 1.25 reciprocal seconds, and  
4 consists essentially of a water-borne resin containing binder having a Tg of about -10 to about 60  
5 degrees C.

1 223. (new) The set of prepaints of claim 219, wherein the binder prepaint further consists  
2 essentially of at least one additive comprising a coalescent, the additive being present in an  
3 amount of less than about 10% by weight, based on the total weight of the binder prepaint.

1 224. (new) The set of premixed aqueous compositions of claim 220, wherein the premixed  
2 binder composition further consists essentially of at least one additive comprising a coalescent,  
3 the additive being present in an amount of less than about 10% by weight, based on the total  
4 weight of the premixed binder composition.

1 225. (new) A set of three different, but mutually compatible, fluid prepaints, useful for  
2 formulating a latex paint, which set comprises:  
3 (a) the set of prepaints of claim 219; and  
4 (b) a fluid pigment extender prepaint which consists essentially of:  
5 (i) at least one mineral extender,  
6 (ii) at least one thickener,  
7 (iii) water, and  
8 (iv) optionally a polymeric binder;  
9 wherein the binder prepaint has a volume solids content of about 30% to about 70%, a PVC of  
10 about 35% to about 100%, and a Stormer viscosity of about 50 to about 250 KU.

1 226. (new) A set of three different, but mutually compatible, premixed aqueous compositions,  
2 useful for formulating a paint product, which set comprises:  
3 (a) the set of premixed compositions of claim 220; and  
4 (b) a premixed aqueous pigment extender composition which consists essentially of:  
5 (i) at least calcined clay,  
6 (ii) at least one thickener,  
7 (iii) water, and  
8 (iv) optionally a resin containing binder;  
9 wherein the premixed binder composition has a volume solids content of about 30% to about  
10 70%, a PVC of about 35% to about 100%, and a Stormer viscosity of about 50 to about 250 KU.

1 227. (new) The set of prepaints of claim 225, wherein the extender prepaint has a volume solids  
2 content of about 35% to about 65%, a PVC of about 40% to about 100% and a Stormer viscosity  
3 of about 60 to about 150 KU.

1 228. (new) The set of premixed aqueous compositions of claim 226, wherein the premixed  
2 aqueous extender composition has a volume solids content of about 35% to about 65%, a PVC of  
3 about 40% to about 100% and a Stormer viscosity of about 60 to about 150 KU.

1 229. (new) The set of prepaints of claim 219, wherein the binder prepaint further consists  
2 essentially of at least one additive comprising a coalescent, with the additive being present in an  
3 amount of less than about 20% by weight, based on the total weight of the binder prepaint.

1 230. (new) The set of premixed aqueous compositions of claim 220, wherein the premixed  
2 binder composition further consists essentially of at least one additive comprising a coalescent,  
3 with the additive being present in an amount of less than about 20% by weight, based on the total  
4 weight of the premixed binder composition.

1 231. (new) A fluid white opacifying prepaint having a volume solids content of about 30% to  
2 about 70%, a PVC of about 35% to about 100%, and a Stormer viscosity of about 50 to about  
3 250 KU, useful for formulating a one pack, pigmented latex paint containing other paint  
4 ingredients, which prepaint consists essentially of:

5 (i) at least one opacifying pigment,

6 (ii) at least one dispersant,

7 (iii) at least one thickener,

8 (iv) at least one film-forming or non-film-forming polymer, and

9 (v) water; wherein the dispersant(s), the thickener(s), and the polymer(s) are compatible

10 with the pigment(s) and with the other paint ingredients and wherein the prepaint is

11 stable to sedimentation.

1 232. (new) A premixed aqueous pigment composition having a volume solids content of about  
2 30% to about 70%, a PVC of about 35% to about 100%, and a Stormer viscosity of about 50 to  
3 about 250 KU, useful for formulating a one pack, pigmented aqueous paint product containing  
4 other paint ingredients, which premixed aqueous composition consists essentially of:

5 (i) at least one opacifying pigment,

6 (ii) at least one dispersant,

7 (iii) at least one thickener,

8 (iv) at least one film-forming or non-film-forming resin, and

9 (v) water; wherein the dispersant(s), the thickener(s), and the polymer(s) are compatible

10 with the pigment(s) and with the other premixed aqueous composition ingredients

11 and wherein the premixed aqueous composition is stable to sedimentation.

- 1 233. (new) The prepaint of claim 231, wherein the volume solids content is about 35% to about  
2 50%, the PVC is about 50 to about 100%, and the Stormer viscosity is about 60 to about 150 KU.
- 1 234. (new) The premixed composition of claim 232, wherein the volume solids content is about  
2 35% to about 50%, the PVC is about 50 to about 100%, and the Stormer viscosity is about 60 to  
3 about 150 KU.
- 1 235. (new) The prepaint of claim 231, wherein the polymer is adsorbed onto the opacifying  
2 pigment.
- 1 236. (new) The premixed resin composition of claim 232, wherein the resin is adsorbed onto the  
2 opacifying pigment.
- 1 237. (new) The prepaint of claim 231, wherein the opacifying pigment comprises titanium  
2 dioxide.
- 1 238. (new) The premixed composition of claim 232, wherein the opacifying pigment comprises  
2 titanium dioxide.
- 1 239. (new) The prepaint of claim 231, wherein the dispersant comprises potassium  
2 tripolyphosphate.
- 1 240. (new) The premixed composition of claim 232, wherein the dispersant comprises  
2 potassium tripolyphosphate.
- 1 241. (new) The prepaint of claim 231, wherein the thickener comprises a cellulosic.
- 1 242. (new) The premixed composition of claim 232, wherein the thickener comprises a  
2 cellulosic.
- 1 243. (new) The prepaint of claim 231, wherein the polymer comprises an acrylic polymer.
- 1 244. (new) The premixed composition of claim 232, wherein the resin comprises an acrylic  
2 resin.

1 245. (new) The prepaint of claim 231, further consisting essentially of at least one additive  
2 comprising a coalescent, with the additive being present in an amount of less than about 10% by  
3 weight, based on the total weight of the prepaint.

1 246. (new) The premixed composition of claim 232, further consisting essentially of at least one  
2 additive comprising a coalescent, with the additive being present in an amount of less than about  
3 10% by weight, based on the total weight of the premixed composition.

1 247. (new) A set of two different, but mutually compatible fluid prepaints useful for formulating  
2 a latex paint, which set comprises:

3 (a) the opacifying prepaint of claim 231; and

4 (b) a latex polymeric binder prepaint having volume solids content of about 25% to about  
5 70% or a Brookfield viscosity of less than about 100,000 centipoise at a shear rate  
6 of 1.25 reciprocal seconds, which binder prepaint consists essentially of a water-  
7 borne latex polymeric binder having a Tg of about -430 degrees C. to about 70  
8 degrees C. and water;

9 wherein the prepaint ingredients are mutually compatible with each other and with the  
10 ingredients of the other prepaint in the set.

1 248. (new) A set of two different, but mutually compatible premixed aqueous compositions  
2 useful for formulating a paint composition, which set comprises:

3 (a) the premixed pigment composition of claim 232; and

4 (b) a premixed polymeric binder composition having volume solids content of about 25%  
5 to about 70% or a Brookfield viscosity of less than about 100,000 centipoise at a  
6 shear rate of 1.25 reciprocal seconds, which premixed binder composition consists  
7 essentially of a water-borne resin containing binder having a Tg of about -430  
8 degrees C. to about 70 degrees C. and water;

9 wherein the ingredients of the premixed compositions are mutually compatible with each other  
10 and with the ingredients of the other premixed compositions in the set.

1 249. (new) The set of prepaints of claim 247, wherein the binder prepaint has a volume solids  
2 content of about 30 to about 65% and a Brookfield viscosity of about 100 to about 50,000  
3 centipoise at a shear rate of 1.25 reciprocal seconds, and consists essentially of a water-borne  
4 polymeric binder having a Tg of about -10 to about 60 degrees C.

1 250. (new) The set of premixed compositions of claim 248, wherein the premixed binder  
2 composition has a volume solids content of about 30 to about 65% and a Brookfield viscosity of  
3 about 100 to about 50,000 centipoise at a shear rate of 1.25 reciprocal seconds, and consists  
4 essentially of a water-borne resin containing binder having a Tg of about -10 to about 60 degrees  
5 C.

1 251. (new) The set of prepaints of claim 247, wherein the binder prepaint further consists  
2 essentially of at least one additive comprising a coalescent, the additive being present in an  
3 amount of less than about 10% by weight, based on the total weight of the binder prepaint.

1 252. (new) The set of premixed compositions of claim 248, wherein the premixed binder  
2 composition further consists essentially of at least one additive comprising a coalescent, the  
3 additive being present in an amount of less than about 10% by weight, based on the total weight  
4 of the premixed binder composition.

1 253. (new) A set of three different, but mutually compatible, fluid prepaints, useful for  
2 formulating a latex paint, which set comprises:

3 (a) the set of prepaints of claim 247; and

4 (b) a fluid pigment extender prepaint which consists essentially of:

5 (i) at least one mineral extender,

6 (ii) at least one thickener,

7 (iii) water, and

8 (iv) optionally a polymeric binder;

9 wherein the binder prepaint has a volume solids content of about 30% to about 70%, a PVC of  
10 about 35% to about 100%, and a Stormer viscosity of about 50 to about 250 KU.

1 254. (new) A set of three different, but mutually compatible, premixed aqueous compositions,  
2 useful for formulating a paint product, which set comprises:  
3 (a) the set of premixed compositions of claim 248; and  
4 (b) a premixed aqueous pigment extender composition which consists essentially of:  
5 (i) at least calcined clay,  
6 (ii) at least one thickener,  
7 (iii) water, and  
8 (iv) optionally a resin containing binder;  
9 wherein the premixed binder composition has a volume solids content of about 30% to about  
10 70%, a PVC of about 35% to about 100%, and a Stormer viscosity of about 50 to about 250 KU.

1 255. (new) The set of prepaints of claim 253, wherein the extender prepaint has a volume solids  
2 content of about 35% to about 65%, a PVC of about 40% to about 100% and a Stormer viscosity  
3 of about 60 to about 150 KU.

1 256. (new) The set of premixed aqueous compositions of claim 254, wherein the premixed  
2 extender composition has a volume solids content of about 35% to about 65%, a PVC of about  
3 40% to about 100% and a Stormer viscosity of about 60 to about 150 KU.

1 257. (new) The set of prepaints of claim 247, wherein the binder prepaint further consists  
2 essentially of at least one additive comprising a coalescent, with the additive being present in an  
3 amount of less than about 20% by weight, based on the total weight of the binder prepaint.

1 258. (new) The set of premixed aqueous compositions of claim 248, wherein the premixed  
2 binder composition further consists essentially of at least one additive comprising a coalescent,  
3 with the additive being present in an amount of less than about 20% by weight, based on the total  
4 weight of the premixed binder composition.

#### **COUNT 4 (A Pigment Extender Prepaint Composition)**

1 259. (new) A fluid pigment extender prepaint, useful for formulating a one pack, pigmented  
2 latex paint containing other paint ingredients, which prepaint consists essentially of:

3 (i) at least one mineral extender having a volume solids content of about 30% to about  
4 70%, a PVC of about 35% to about 100%, and a Stormer viscosity of about 50 to  
5 about 250 KU;

6 (ii) at least one thickener,

7 (iii) water, and

8 (iv) an optional polymeric binder; wherein the prepaint ingredients are compatible with  
9 each other and with the ingredients of the paint.

1 260. (new) A premixed aqueous pigment extender composition, useful for producing a  
2 pigmented aqueous paint product containing other paint ingredients, which premixed  
3 composition consists essentially of:

4 (i) at least one calcined clay having a volume solids content of about 30% to  
5 about 70%, a PVC of about 35% to about 100%, and a Stormer viscosity of about  
6 50 to about 250 KU;

7 (ii) at least one thickener,

8 (iii) water, and

9 (iv) an optional polymeric resin containing binder; wherein the premixed  
10 composition ingredients are compatible with each other and with the ingredients  
11 of the paint product.

**COUNT 1 - (Product –Prepaints and Paint Composition)**

1    261. A plurality of premixed aqueous compositions for forming an aqueous paint composition,  
2    the plurality of compositions comprising:  
3        a premixed pigment composition provided as an aqueous solution having an opacifying  
4        pigment;  
5        a premixed low resin composition provided as an aqueous solution having a flattening  
6        agent; and  
7        a premixed a binder composition provided as an aqueous solution having a resin;  
8    wherein mixing a portion of the pigment composition with a portion of at least one of the low  
9    resin composition and the binder composition produces the aqueous paint composition from the  
10   premixed compositions.

1    262. The plurality of premixed aqueous compositions of claim 261, wherein the number of  
2    premixed compositions is 3 or more.

1    263. The plurality of premixed aqueous compositions of claim 261, wherein the premixed  
2    pigment composition further comprises at least one resin adsorbed onto the opacifying pigment.

1    264. The plurality of premixed aqueous compositions of claim 261, wherein the premixed low  
2    resin composition further comprises at least one particulate resin absorbed onto the flattening  
3    agent.

1    265. The plurality of premixed aqueous compositions of claim 261, wherein the premixed low  
2    resin composition has a PVC of about 35% to about 100%.

- 1    266. An aqueous paint product made by a method comprising:  
2        premixing an pigment composition as an aqueous solution having an opacifying pigment;  
3        premixing a low resin composition as an aqueous solution having a flattening agent;  
4        premixing a binder composition as an aqueous solution having a resin; and  
5        mixing a portion of the pigment composition with a portion of at least one of the low  
6                resin composition and the binder composition to produce an aqueous paint  
7                composition from the premixed compositions.
- 1    267. An aqueous paint composition comprising:  
2        a premixed pigment composition as an aqueous solution having an opacifying pigment;  
3        a premixed low resin composition as an aqueous solution having a flattening agent;  
4        a premixed binder composition as an aqueous solution having a resin; and  
5        a portion of the pigment composition mixed with a portion of at least one of the low resin  
6                composition and the binder composition to produce the aqueous paint  
7                composition from the premixed compositions.
- 1    268. A method of forming a plurality of paint products, which method comprises the steps of:  
2        (a) providing a plurality of the premixed compositions of claim 267; and  
3        (b) dispensing a predetermined amount of each of the premixed compositions into  
4                containers to form the plurality of paint products.

## **COUNT 2 (Method of Producing a Paint Line)**

- 1 269. A method of producing a plurality of aqueous paint products, the method comprising:  
2 premixing an opacifying pigment composition as an aqueous solution having an  
3 opacifying pigment;  
4 premixing a low resin composition as an aqueous solution having a flattening agent;  
5 premixing a binder composition as an aqueous solution having a resin; and  
6 mixing a portion of the pigment composition with a portion of at least one of the low resin  
7 composition and the binder composition in containers to produce an aqueous paint product of the  
8 plurality of paint products from the premixed compositions.
- 1 270. The method of claim 269, further comprising the step of mixing the premixed compositions  
2 before, while, or after they are dispensed into the containers.
- 1 271. The method of claim 269, further comprising the step of mixing the premixed compositions  
2 before or while they are dispensed into the containers.
- 1 272. The method of claim 269, further comprising the step of adjusting the viscosity of the  
2 premixed compositions before, while, or after they are dispensed into the containers.
- 1 273. The method of claim 269, further comprising the step of adjusting the viscosity of the  
2 premixed compositions before or while they are dispensed into the containers.
- 1 274. The method of claim 269, further comprising the step of adding at least one additive that  
2 enhances application or final performance of the aqueous paint product.
- 1 275. The method of claim 274, wherein the additive is a thickener.
- 1 276. The method of claim 269, further comprising the step of adding at least one colorant to the  
2 premixed compositions.

- 1 277. The method of claim 269, wherein the opacifying pigment composition further comprises at  
2 least one resin absorbed onto the opacifying pigment.
- 1 278. The method of claim 269, wherein the low resin composition further comprises at least one  
2 resin absorbed onto the flattening agent.
- 1 279. The method of claim 269, wherein the method is carried out at a paint manufacturing  
2 facility.
- 1 280. The method of claim 269, wherein the number of premixed compositions is 4 or more.
- 1 281. The method of claim 269, wherein the low resin composition has a PVC of about 35% to  
2 about 100%.
- 1 282. The method of claim 269, wherein the method is carried out at the point-of-sale.
- 1 283. The method of claim 269, wherein the method is carried out at the point-of-use.
- 1 284. The method of claim 269, wherein the method is controlled by a computer.
- 1 285. A method of producing variations of a plurality of aqueous paint products, the method  
2 comprising:  
3 (i) premixing an opacifying pigment composition as an aqueous solution having an  
4 opacifying pigment;  
5 (ii) premixing a low resin composition as an aqueous solution having a flattening agent;  
6 (iii) premixing a binder composition as an aqueous solution having a resin; and  
7 (iv) premixing an additional different premixed composition from the group consisting  
8 of the compositions of (i), (ii), and (iii); and  
9 mixing a portion of the pigment composition with a portion of at least one of the low resin  
10 composition and the binder composition in containers to produce an aqueous paint product of the  
11 variations of the plurality of paint products from the premixed compositions.

1 286. The method of claim 285, further comprising the step of mixing the premixed compositions  
2 before, while, or after they are dispensed into the containers.

1 287. The method of claim 285, further comprising the step of mixing the premixed compositions  
2 before or while they are dispensed into the containers.

1 288. The method of claim 285, further comprising the step of adjusting the viscosity of the  
2 premixed compositions before, while, or after they are dispensed into the containers.

1 289. The method of claim 285, further comprising the step of adjusting the viscosity of the  
2 premixed compositions before or while they are dispensed into the containers.

1 290. The method of claim 285, further comprising the step of adding at least one additive that  
2 enhances application or final performance of the aqueous paint product.

1 291. The method of claim 290, wherein the additive is a thickener.

1 292. The method of claim 285, further comprising the step of adding at least one colorant to the  
2 premixed compositions.

1 293. The method of claim 285, wherein the opacifying pigment composition further comprises at  
2 least one resin absorbed onto the opacifying pigment.

1 294. The method of claim 285, wherein the low resin composition further comprises at least one  
2 resin absorbed onto the flattening agent.

1 295. The method of claim 285, wherein the method is carried out at a paint manufacturing  
2 facility.

1 296. The method of claim 285, wherein the number of premixed compositions is 4 or more.

1 297. The method of claim 285, wherein the low resin composition has a PVC of about 35% to  
2 about 100%.

1 298. The method of claim 285, wherein the method is carried out at the point-of-sale.

1 299. The method of claim 285, wherein the method is carried out at the point-of-use.

1 300. The method of claim 285, wherein the method is controlled by a computer.

### COUNT 3 (A Pigmented Prepaint Composition)

- 1 301. A premixed aqueous composition for forming an aqueous paint product, the premixed  
2 composition comprising:  
3 a premixed pigment composition provided as an aqueous solution having:  
4 an opacifying pigment;  
5 a dispersant-thickener comprising:  
6 a dispersant,  
7 a thickener; and  
8 water;  
9 wherein mixing a portion of the pigment composition with other paint ingredients provides the  
10 aqueous paint composition.
- 1 302. The premixed aqueous composition of claim 301, wherein the volume solids content is  
2 about 35% to about 50% and the Stormer viscosity is about 60 to about 150 KU.
- 1 303. The premixed aqueous composition of claim 301, wherein the opacifying pigment  
2 comprises titanium dioxide.
- 1 304. The premixed aqueous composition of claim 301, wherein the dispersant comprises  
2 potassium tripolyphosphate.
- 1 305. The premixed aqueous composition of claim 301, wherein the thickener comprises a  
2 cellulosic.
- 1 306. The premixed aqueous composition of claim 301, further consisting essentially of at least  
2 one additive comprising a coalescent, with the additive being present in an amount of less than  
3 about 10% by weight, based on the total weight of the premixed aqueous composition.

1 307. A plurality of different, but mutually compatible premixed aqueous compositions useful for  
2 formulating a paint product, which plurality comprises:

3 (a) the premixed opacifying aqueous composition of claim 301; and

4 (b) a premixed binder composition having volume solids content of about 25% to about  
5 70% or a Brookfield viscosity of less than about 100,000 centipoise at a shear rate  
6 of 1.25 reciprocal seconds, which binder composition consists essentially of a  
7 water-borne resin having a Tg of about -430 degrees C. to about 70 degrees C.  
8 and water;

9 wherein the ingredients of the premixed compositions are mutually compatible with each other  
10 and with the ingredients of the other premixed compositions of the plurality.

1 308. The set of premixed aqueous compositions of claim 307, wherein the premixed binder  
2 composition has a volume solids content of about 30 to about 65% and a Brookfield viscosity of  
3 about 100 to about 50,000 centipoise at a shear rate of 1.25 reciprocal seconds, and consists  
4 essentially of a water-borne resin having a Tg of about -10 to about 60 degrees C.

1 309. The set of premixed fluid compositions of claim 307, wherein the premixed binder  
2 composition further consists essentially of at least one additive comprising a coalescent, the  
3 additive being present in an amount of less than about 10% by weight, based on the total weight  
4 of the premixed binder composition.

1 310. A plurality of different, but mutually compatible, premixed compositions, useful for  
2 formulating a paint product, which plurality comprises:

3 (a) the plurality of premixed fluid compositions of claim 307; and

4 (b) a premixed aqueous pigment extender composition which consists essentially of:

5 (i) at least one flattening agent,

6 (ii) at least one thickener,

7 (iii) water, and

8 (iv) optionally a resin;

9 wherein the premixed extender composition has a volume solids content of about 30% to about  
10 70%, a PVC of about 35% to about 100%, and a Stormer viscosity of about 50 to about 250 KU.

1 311. The plurality of premixed compositions of claim 310, wherein the premixed extender  
2 composition has a volume solids content of about 35% to about 65%, a PVC of about 40% to  
3 about 100% and a Stormer viscosity of about 60 to about 150 KU.

1 312. The plurality of premixed compositions of claim 307, wherein the premixed binder  
2 composition further consists essentially of at least one additive comprising a coalescent, with the  
3 additive being present in an amount of less than about 20% by weight, based on the total weight  
4 of the binder composition.

1 313. A premixed aqueous pigment paint composition having a volume solids content of about  
2 30% to about 70%, a PVC of about 35% to about 100%, and a Stormer viscosity of about 50 to  
3 about 250 KU, useful for formulating an aqueous pigmented paint product containing other paint  
4 ingredients, the premixed pigment composition provided as an aqueous solution comprising:

5 a pigment;

6 a dispersant-thickener comprising:

7 a dispersant, and

8 a thickener;

9 a resin, and

10 water;

11 wherein mixing a portion of the pigment composition with the other paint ingredients provides  
12 the aqueous paint product.

1 314. The premixed aqueous composition of claim 313, wherein the volume solids content is  
2 about 35% to about 50%, the PVC is about 50 to about 100%, and the Stormer viscosity is about  
3 60 to about 150 KU.

1 315. The premixed aqueous composition of claim 313, wherein the resin is adsorbed onto the  
2 pigment.

1 316. The premixed aqueous composition of claim 313, wherein the pigment comprises titanium  
2 dioxide.

1 317. The premixed aqueous composition of claim 313, wherein the dispersant comprises  
2 potassium tripolyphosphate.

1 318. The premixed aqueous composition of claim 313, wherein the thickener comprises a  
2 cellulosic.

1 319. The premixed aqueous composition of claim 313, wherein the resin comprises acrylics.

1 320. The premixed aqueous composition of claim 313, further consisting essentially of at least  
2 one additive comprising a coalescent, with the additive being present in an amount of less than  
3 about 10% by weight, based on the total weight of the premixed aqueous composition.

1 321. A plurality of different, but mutually compatible premixed aqueous compositions useful for  
2 formulating a paint product, which plurality comprises:

3 (a) the premixed aqueous composition of claim 313; and

4 (b) a premixed binder composition having volume solids content of about 25% to about  
5 70% or a Brookfield viscosity of less than about 100,000 centipoise at a shear rate  
6 of 1.25 reciprocal seconds, which binder composition consists essentially of a  
7 water-borne resin having a Tg of about -430 degrees C. to about 70 degrees C.  
8 and water;

9 wherein the ingredients of the premixed compositions are mutually compatible with each other  
10 and with the ingredients of the other premixed compositions in the plurality.

1 322. The plurality of premixed aqueous compositions of claim 321, wherein the premixed binder  
2 composition has a volume solids content of about 30 to about 65% and a Brookfield viscosity of  
3 about 100 to about 50,000 centipoise at a shear rate of 1.25 reciprocal seconds, and consists  
4 essentially of a water-borne resin having a Tg of about -10 to about 60 degrees C.

1 323. The plurality of premixed aqueous compositions of claim 322, wherein the premixed binder  
2 composition further consists essentially of at least one additive comprising a coalescent, the  
3 additive being present in an amount of less than about 10% by weight, based on the total weight  
4 of the premixed binder composition.

1 324. A plurality of different, but mutually compatible, premixed aqueous compositions, useful  
2 for formulating an aqueous paint product, which plurality comprises:

3 (a) the plurality of premixed aqueous compositions of claim 322; and

4 (b) a premixed aqueous pigment extender composition which consists essentially of:

5 (i) at least one flattening agent,

6 (ii) at least one thickener,

7 (iii) water, and

8 (iv) optionally a resin;

9 wherein the premixed binder composition has a volume solids content of about 30% to about  
10 70%, a PVC of about 35% to about 100%, and a Stormer viscosity of about 50 to about 250 KU.

1 325. The plurality of premixed aqueous compositions of claim 324, wherein the premixed  
2 extender composition has a volume solids content of about 35% to about 65%, a PVC of about  
3 40% to about 100% and a Stormer viscosity of about 60 to about 150 KU.

1 326. The plurality of premixed aqueous compositions of claim 321, wherein the premixed binder  
2 composition further consists essentially of at least one additive comprising a coalescent, with the  
3 additive being present in an amount of less than about 20% by weight, based on the total weight  
4 of the premixed binder composition.

#### **COUNT 4 (A Pigment Extender Prepaint Composition)**

- 1    327. An aqueous solution having a premixed pigment extender composition, useful for producing  
2    a paint product containing other premixed compositions, the aqueous solution comprising:
- 3        (i) a flattening agent;
  - 4        (ii) a dispersant thickening dilutant composition having a thickener,
  - 5        (iii) water, and
  - 6        (iv) optionally a resin; wherein the premixed extender composition ingredients are  
7                compatible with each other.

## **VI. REMARKS**

### **A. Identification of Interfering Patent and Application and Establishing of Priority Dates**

Applicants' above captioned application, Serial No. 09/578,001, filed May 24, 2000 is a continuation-in-part of application Serial No. 09/221,332, filed December 23, 1998, which issued as U.S. Patent No. 6,221,145 on April 24, 2001 (hereinafter "the Applicant's patent," Exhibit A).

Claims 87-327 appear in the present application for the Examiner's review and consideration. Previously pending claims 52-86 have been canceled.

Claims 87-327 have been added for the purpose of provoking an interference with unexpired U.S. Patent No. 6,531,537 to Friel et al. (hereinafter "the Friel patent," Exhibit B), which issued on March 11, 2003, and with U.S. Patent application Serial No. 2002/0016405 to Friel et al. (hereinafter "the Friel application," Exhibit C), which was published February 7, 2002.

New claims 87, 90, 93, 96, 99, 102, 105, 108, 111, 114, 117, 120, 123, 126, 129, 132, 135, 138, 141, 144, 147, 207, 209, 219, 221, 225, 227, 231, 233, 235, 247, 249, 253, 255, and 259 correspond exactly or substantially to claims 1-4, 49, 38, 45, 48, 5, 7-11, 13-18, 50, 19-20, 32-33, 35, 36, 21-23, 25, 32, 33, 35, 36, and 31 of the Friel patent. See Exhibit G for a direct comparison between currently pending claims and the claims of the Friel patent.

New claims 150, 153, 156 correspond exactly or substantially with claims 18, 19, and 20 of the Friel application. Claims 87, 90, 93, 96, 99, 102, 105, 108, 111, 114, 117, 120, 123, 126, 129, 132, 135, 138, 141, 144, 147, 207, 209, 219, 221, 225, 227, 231, 233, 235, 247, 249, 253, 255, and 259 also correspond exactly or substantially to claims 1-17 and 21-50 of the Friel application since many of the Friel application claims recite substantially the same elements as the Friel patent. See Exhibit G for a direct comparison between currently pending claims and the claims of the Friel application.

New claims 211, 213, 215, 217, 223, and 229 are partial copies of claims 24, 27, 28, 30, 34, and 37 of the Friel patent as they depend from claims 19. New claims 237, 239, 241, 243, 245, 251, and 257 are partial copies of claims 24, 27-30, 34, and 37 of the Friel patent as they depend on claim 21. See Exhibit G for a direct comparison between currently pending claims and the claims of the Friel patent.

The remaining new claims vary in terminology while claiming substantially the same inventions as recited in the Friel patent and the Friel application as can be appreciated from a comparison of the claims in parallel columns in Table 3 of Exhibit G and Table 4 of Exhibit H.

**B. Presentation of the Proposed Counts**

The Friel patent and the Friel application conflict with the present application on four counts. The first count corresponds to claims 1-4, 49, 38, 45, and 48, of the Friel patent and corresponding claims to the same matter in the Friel application. The second count corresponds to claims 5, 7-11, 13-18, and 50 of the Friel patent and claims to the same matter in the Friel application. The third count corresponds to claims 19-23, 32-33, 35, and 36 of the Friel patent and claims to the same matter in the Friel application. The fourth count corresponds to claim 31 of the Friel patent and claims to the same matter in the Friel application. Table 1 below is useful in showing which claims correspond to which counts. Since none of the counts corresponds exactly to a claim, each of the four counts is a phantom count. Furthermore, since most of the patent claims have been copied, the interference is an interference in fact.

**Table 1: Claims Corresponding to Counts**

	<b>General Descrip- tion of the Counts</b>	<b>Friel Patent Claims</b>	<b>Friel Applica- tion Claims</b>	<b>Copy or Substantially same as Friel Patent or Application Claims</b>	<b>Bridging Claims (Closer to Friel Patent)</b>	<b>Bridging Claims (Closer to Present Application)</b>	<b>Claims Supported Inherently or by Original Terminology</b>
<b>Count 1</b>	A set of prepaints	1-4, 38, 45, 48, and 49	1-4 and 44	87, 90, 93, 96, 99, 102, 105, and 108	88, 91, 94, 97, 100, 103, 106, and 109	89, 92, 95, 98, 101, 104, 107, and 110	261-268
<b>Count 2</b>	A method of formulating a paint	5-11, 13-18, and 50	5-11 and 13-21	111, 114, 117, 120, 123, 126, 129, 132, 135, 138, 141, 144, 147, 150, 153, 156, 159, 162, 165, 168, 171, 174, 177, 180, 183, 186, 189, 192, 195, 198, 201, and 204	112, 115, 118, 121, 124, 127, 130, 133, 136, 139, 142, 145, 148, 151, 154, 157, 160, 163, 166, 169, 172, 175, 178, 181, 184, 187, 190, 193, 196, 199, 202, and 205	113, 116, 119, 122, 125, 128, 131, 134, 137, 140, 143, 146, 149, 152, 155, 158, 161, 164, 167, 170, 173, 176, 179, 182, 185, 188, 191, 194, 197, 200, 203, and 206	269-300
<b>Count 3</b>	A pigmented prepaint	19-24, 27-30, and 32- 37	22-23, 27, 30-34, and 37-43	207, 209, 211, 213, 215, 217, 219, 221, 223, 225, 227, 229, 231, 233, 235, 237, 239, 241, 243, 245, 247, 249, 251, 253, 255, and 257		208, 210, 212, 214, 216, 218, 220, 222, 224, 226, 228, 230, 232, 234, 236, 238, 240, 242, 244, 246, 248, 250, 252, 254, 256, and 258	301-326
<b>Count 4</b>	An extender prepaint	31	35-36	259		260	327

Several Claims are considered to not correspond to any count for the purposes of the present interference, and therefore have not been copied. Other claims are considered to correspond in part to the present interference as shown in Table 2 below. An explanation of claims that are not exact copies is set forth in the explanation of how specific claims are supported below.

**Table 2: Claims that do not Correspond or that Correspond in Part**

	<b>Friel Patent</b>	<b>Friel Application</b>
<b>Claims Not Corresponding to a Count</b>	12, 25, 39-44, and 46-47	12, 28, and 45-48
<b>Claims Corresponding in Part to a Count</b>	24, 27-30, 34, and 37	27, 30-34, 39, and 43

**C. Interference Necessary with *THIS* Application**

The petition for withdrawal of the present application from issue is made under the exception of 37 CFR 1.313 (c) (2), wherein a request for continued examination under 37 CFR 1.114 is being made concurrently. Applicants have requested immediate withdrawal of the present application from issue under 37 C.F.R. 1.313(c) even though the issue fee has been paid because Applicants were not aware that an interference should have been provoked with interfering claims in this application. Due to information, noted below, that has recently come to Applicants' attention, withdrawal of the present application from issue by the Patent Office under the initiative of the Applicants has been requested.

1. Applicants became aware of U.S. Patent No. 6,531,537 B2 having claims to the same invention as the present application.

A. The patent was issued March 11, 2003 (less than a year ago as required by 35 USC 135(a))

B. The present application was filed on May 24, 2000, before the pre-grant publication of the patent, which occurred on January 10, 2002. (Thus, the requirements of 35 USC 135(b) do not pertain to this application.)

C. Unless an Interference is provoked between the present application, with its May 24, 2000 filing date, and the issued claims of U.S. Patent No. 6,531,537 B2, Applicants will be significantly limited in their ability to provoke an interference with that patent because 35 USC 135(b) will impose significant restrictions on the claims that can be made in any other related application.

2. The issued claims in the patent could have been claimed in the present application.

A. Although Applicants have an earlier priority date by more than 1 year for the subject matter claimed by Patent No. 6,531,537 B2, the claims of the patent provide rights in that invention to another. Applicants' disclosure, though it uses slightly different language, discloses the same examples for its components as those in the Friel patent and application.

3. There are no other related application(s) in which the patent claims could be presented without changing the thrust of those related applications. Furthermore, Applicants may be restricted from presentation of claims having the same or substantially the same subject matter in any related application under 35 USC 135(b), and from provoking an interference in fact, because all such related applications were filed or will be filed after the publication date of the patent. Alternatively stated, the present application is the only application that can avoid the requirement of 35 USC 135(b) by virtue of its filing date. In view of the nature and scope of the patent claims having an effective filing date more than one year after the effective filing date of the same subject matter in Applicants' application, Applicants need to provoke an interference in the present application with its 5/24/00 filing date.

Hence, Applicants have petitioned the commissioner to withdraw the present application from issue.

**D. Meets the Requirements for an Interference Under 35 U.S.C. 135**

In accordance with the requirements of 35 USC 135 (a), the claims of the Friel Patent and the Friel application interfere with Applicant's application claims. Applicant's application has an effective filing date that is prior to that of the Friel patent and the Friel application. These facts can be verified by reviewing the following explanations and the filing dates of the pertinent applications and patents supplied in the accompanying Exhibits A-C.

In accordance with 35 USC 135 (b) (1), the Friel patent claims have been copied and submitted herewith as an amendment to the present application. The Friel patent was issued March 11, 2003. Therefore, the copied claims present the same invention and are being submitted less than one year after the Friel patent was issued.

The requirements of 35 USC 135 (b) (2) does not pertain to the present application because Applicant's application was filed before the Friel patent and the Friel Application. Furthermore, the effective filing date of the relevant subject matter for the Applicants application is before the effective filing date of the relevant material in the Friel patent and the Friel application.

The patent claims clearly conflict with the Applicants' claimed inventions presented in the present application as can be seen in the explanation of differing terms for the same features provided herein. These claims are supported by the original disclosure of the Applicants, which is senior to the Friel patent and senior to the Friel application. Furthermore, it is presumed that the Friel patent claims are patentable since they were deemed so by the Office during examination and issuance. As such, the patentee has obtained patent rights that belong to the present Applicants. Therefore, an interference proceeding is needed to obtain judgment on the interfering claims.

**E. Ownership is Not Common**

Ownership of the present application is not the same as the ownership of the Friel patent and the Friel application. All rights title and interest of the present application and the parent application to which it claims priority belong to MicroBlend Technologies, Inc. of Chandler Arizona. All rights title and interest of the Friel patent and the Friel application appear to belong to Rhom & Haas Company of Philadelphia, Pennsylvania, and do not belong to MicroBlend Technologies, Inc.

**F. The Present Application has an Earlier Effective Filing Date for the Claimed Matter**

The Friel patent (Exhibit B) was filed on February 16, 2001 and has an effective filing date for at least some of its matter dating back to February 18, 2000. The Friel application has a filing date of February 16, 2001. All of the filing dates and effective filing dates of the Friel patent (Exhibit B) and the Friel application are later by more than one year after the effective filing date (December 23, 1998) of the Applicant's patent (Exhibit A), which is a parent of the present continuation-in-part application. Consequently, any claim of the present application that is supported by the specification of the parent case under 35 U.S.C. 112 should be allowed in light of the fact that the Friel patent (Exhibit B) was allowed and because the present application is entitled to the benefit of an earlier effective filing date. Support for the currently claimed matter in the Applicant's patent is provided as set forth in greater detail below.

**G. Application Discloses the Same Invention using Different Terminology;  
Patent Terminology Is Supported by Applicant's Prior Disclosure According to the  
Definitions of the Terms**

Applicant's original disclosure inherently describes the same invention described and claimed in both the Friel patent and the Friel application. As shown below, the terms used in the Friel patent and the Friel application correspond directly to the terms used in the Applicant's original disclosure. Therefore, the inventions claimed by Friel are supported by the Applicant's disclosure.

The term “opacifying prepaint” finds antecedent basis in Applicant’s patent (Exhibit A) in column 2, lines 25-28 wherein Applicants disclose the use of titanium dioxide as the pigment. A paint dictionary entitled “Coatings Encyclopedic Dictionary” edited by Stanley LeSota and published in 1995, (copied pages of which, showing pertinent excerpts are included herewith as Exhibit D) (hereinafter “Paint Dictionary”), states that titanium dioxide is a “high opacity bright pigment”. It is commonly known in the paint industry that titanium dioxide is added to paint mixtures as a pigment for its opacity. Support for the term “prepaint” is provided in part by taking this term in the context in which it is presented in the Friel patent. In this case, “prepaint” means a composition formed in a process prior to forming an actual functional paint and used in conjunction with other compositions in order to form a functional paint. In this sense, the “pre” of “prepaint” is analogous to the “pre” of “premix”, which by definition from the Paint Dictionary is: “an admixture of several ingredients designed to be incorporated in a formulation or process as a group as opposed to individually.” (See Exhibit D.) Hence, “prepaint” means a premixed composition. Applicant’s patent (Exhibit A) clearly provides several prepaint compositions or “prepaints” as set forth in column 1, lines 47-50 of the patent.

The term “extender prepaint” is provided for in the Applicant’s patent (Exhibit A) by the description of the constituents of the low resin content prepaint composition. The low resin prepaint composition in Applicant’s patent (Exhibit A) includes ground limestone as set forth in column 3, lines 33-34. Limestone or “natural calcium carbonate” is defined as a “white extender pigment” in the Paint Dictionary. (See Exhibit D.) Therefore, the prepaint composition that includes limestone or calcium carbonate is an extender pigment prepaint composition by definition.

The term “latex polymeric binder” is inherent in the aqueous acrylic resin based binder prepaint compositions of Applicant’s patent. Applicants disclose that their resin can be resin 6183 made by BASF. BASF’s convention for 6183 resin has been changed at BASF so that this material is now referred to by the designation 220 BASF. Furthermore, a more common designation associated with 6183 is Acronal TM DS 6183, (also made by BASF.) See Exhibit E for a description of 6183 BASF/Acronal 220. This material is an acrylic resin, which is also a polymer commonly used in latex paints. Applicant refers to the high and low resin content

compositions as binders in column 1, lines 50-51. Therefore, Applicant's patent has support for a "latex polymeric binder"

As additional support for Applicant's resin being a latex polymer, "Hawley's Condensed Chemical Dictionary - Eleventh Edition" published in 1995, (copied pages of which, showing pertinent excerpts are included herewith as Exhibit F) (hereinafter "Chemical Dictionary") defines "binder" as: "the film-forming ingredient in paint, usually either an oil or a polymeric substance." Furthermore, the Chemical Dictionary further provides a definition for the term "resin", (which includes acrylic resins), as a "high polymer". Thus, by the terms "resin", "binder", and by the description of the specific material "6183" used, Applicant's resin is "polymeric". The term "latex", as provided by the above referenced Paint Dictionary, means: "a stable dispersion of a polymeric substance in an essentially aqueous medium." (See Exhibit D.)

Applicant's patent (Exhibit A) clearly has the "resin" or "binder" in an essentially aqueous medium in accordance with this definition as described in column 3, lines 38-41. One thrust of the present invention is to provide the premixed compositions as stable dispersions that do not separate during storage over long periods of time. Therefore, Applicant's high resin composition or binder composition is, by definition, a latex polymeric binder. Additional details of how Applicant's patent supports the specific claims are provided below.

In accordance with the above known meanings of words, Applicants have placed terms in the Specification of the present application as alternative terms for the same elements that were previously supported. Accordingly, Applicants have not entered new matter by the present amendments.

#### **H. Identification of Correspondence of the Terms in the Claims**

Exhibit G includes Table 3, which is a table of newly presented claims 87-260 in three parallel columns showing correspondingly similar claims in a side-by-side relationship. The table also has the counts grouped so that all of the first count claims come at the top of the table,

under the heading “Count 1”, all of the second count claims come below, under the heading of “Count 2”, and so forth. This parallel column format is intended to aid the Examiner in seeing the bridge in terminology that is readily supported by the original disclosure of the Applicant’s patent. The pertinent terminology has been highlighted to facilitate the comparison. Corresponding Friel patent (P) and application (A) claim numbers have also been indicated in the far right column.

Column 1 of Table 3 (Exhibit G) shows claims 87, 90, 93, 96, 99, 102, 105, 108, 111, 114, 117, 120, 123, 126, 129, 132, 135, 138, 141, 144, 147, 150, 153, 156, 159, 162, 165, 168, 171, 174, 177, 180, 183, 186, 189, 192, 195, 198, 201, 204, 207, 209, 211, 213, 215, 217, 219, 221, 223, 225, 227, 229, 231, 233, 235, 237, 239, 241, 243, 245, 247, 249, 251, 253, 255, 257 and 259 which are copies, or which recite substantially similar material in terms similar to the claims in the Friel patent and the Friel application. Column 2 shows claims 88, 91, 94, 97, 100, 103, 106, 109, 112, 115, 118, 121, 124, 127, 130, 133, 136, 139, 142, 145, 148, 151, 154, 157, 160, 163, 166, 169, 172, 175, 178, 181, 184, 187, 190, 193, 196, 199, 202, and 205 utilizing some terminology from the present application as originally filed and some terminology originating in the Friel patent (Exhibit B) and the Friel application (Exhibit C). Column 3 shows claims 89, 92, 95, 98, 101, 104, 107, 110, 113, 116, 119, 122, 125, 128, 131, 134, 137, 140, 143, 146, 149, 152, 155, 158, 161, 164, 167, 170, 173, 176, 179, 182, 185, 188, 191, 194, 197, 200, 203, 206, 208, 210, 212, 214, 216, 218, 220, 222, 224, 226, 228, 230, 232, 234, 236, 238, 240, 242, 244, 246, 248, 250, 252, 254, 256, 258, and 260, utilizing mostly terminology that was originally recited in the present application.

Exhibit H includes Table 4, which is a table of the newly presented claims 261-327 in a left column and the corresponding Friel claim(s) and claim numbers in the right column in a side-by-side relationship. The table also has the counts grouped so that all of the first count claims come at the top of the table, under the heading “Count 1”, all of the second count claims come below, under the heading of “Count 2”, and so forth. This parallel column format is intended to aid the Examiner in seeing that the newly presented claims recite substantially the same invention as the Friel patent and the Friel application, while utilizing terminology that is

either expressly recited or inherent in the Applicant's original disclosure. The pertinent terminology has been highlighted to facilitate the comparison.

**I. How Various Specific Claims are Supported by the Original Disclosure**

***Count 1, Claims 87-110 and 261-268***

Claim 87 is a copy of claim 1 of the Friel patent. Claims 88 and 89 correspond to claim 87. Claims 88 and 89 vary from claim 87 only in terminology, which progresses in claims 88 and 89 from terminology used in the Friel patent to terminology found in Applicant's original disclosure. In particular, Claim 87 utilizes the term "set of different" when referring to the "prepaints". Applicant's original disclosure refers to the same thing as a "plurality of premixed compositions" in the title and elsewhere in the Applicant's patent. The term "different" does not appear in applicant's original disclosure with reference to the "premixed compositions", but has a basis by the description of how each of the compositions differs in ingredients from the others. Thus, the term "different" has been placed in the present application by this amendment without adding or removing meaning whatsoever therefrom. The term "varied" has a similar basis in the Applicant's patent. Furthermore, the term varied appears in the Applicant's patent (Exhibit A) in column 3, lines 42-43 and throughout the Specifications with reference to providing materially different premixed compositions and resulting paint compositions. The term "set" is also supported by the Applicant's original disclosure in that Applicant refers to specific numbers in the range of 2 or more "premixed compositions". Thus, the term "set" has also been placed in the present application without addition or loss of meaning.

As can be noted from the added claims, (and from the copy of added claims in parallel columns in Exhibit G), claims 87 and 88 use the term "set of different" while claim 89 uses the term "plurality of varied". Each of these terms refers to the same thing so that the distinction between the claims becomes merely a matter of semantics. Likewise, claim 87 uses the term "fluid" whereas claims 88 and 89 employ the term "aqueous" for the same feature of the invention. Claim 87 recites a "paint line". While this term is not in applicant's original disclosure, "line" is a well known term referring to a set or variety of a specific genus of products. For example, there are product lines of cars, carpets, televisions, etcetera. Thus,

Applicant's original disclosure that a variety of paint compositions or products can be formulated from the premixed compositions provides support and a basis for recitation of a "paint line". On the other hand, claims 87, 88, and 89 recite "paint line", "set of paint products", and "a variety of paint compositions" for the same claim element. These terms mean the same thing so that there is no addition or loss of meaning from one claim to another.

The term "prepaint" in claim 87 corresponds to the term "prepaint composition" in claim 88 and the term "premixed composition" of claim 89, all of which refer to the same claim element. The similar meaning of "premixed composition" and "prepaint" is set forth in section G above with reference to known meanings of words in the terms. Similarly, a progression of the terms "opacifying prepaint", "pigment prepaint composition", and "premixed pigment composition" is provided in claims 87, 88, and 89 respectively. These terms likewise refer to the same thing. For example, titanium dioxide is specifically disclosed as the pigment in both the "premixed pigment composition" of Applicant's patent and the "prepaint" of the Friel patent. A similar progression is provided for the terms "extender prepaint", "extender prepaint composition", and "premixed low resin composition". As disclosed in column 3, lines 29-38 of the Applicant's patent (Exhibit A), the "premixed low resin composition" has well known extenders including diatomaceous earth, ground limestone, and calcined clay. Hence the three terms refer to the same extender prepaint, and the variation in terminology is merely a matter of semantics. The same is true of the terms "extender pigment" of claim 87, "extender agent" of claim 88, and "flattening agent" of claim 89.

A similar progression in terms from "binder prepaint" to "binder prepaint composition" to "premixed high resin composition" in claims 87-89, respectively, is provided. The "high resin composition" contains a "resin" as set forth in column 3, lines 39-40 of the Applicant's patent. The term "resin" in claim 89 corresponds to the term "polymeric binder" of claims 87 and 88. Resins are generally polymeric and the Applicant's patent refers to the high resin composition as a "high resin binder". Furthermore, applicant's specific example of the resin is a polymeric binder as set forth in section G above. Hence, claims 87, 88, and 89 claim the same invention using different terms that mean the same thing, and the differences are merely semantic.

Claim 90 is not a copy of claim 2 of the Friel patent because the original disclosure of the Applicant's patent does not provide a specific statement of the upper limit recited in claim 2 of

the Friel patent. However, the Applicant's original disclosure has a basis for claiming a number of prepaints more broadly. Specifically, the Applicant's patent (Exhibit A) states that paint products can be formed from a plurality of aqueous compositions in column 1, lines 47-49. An example using two to four compositions is disclosed in column 1, lines 50-54. Two, three, and four premixed compositions is shown in the table of column 4, and three compositions is specifically disclosed in column 3, lines 54-57. It would be an obvious modification to merely include more prepaints in the set. Therefore, the range of three or more recited in claim 90 is a broad yet supported recitation. Claims 91 and 92 correspond to claim 90 except for the alternate terms "aqueous prepaint compositions" and "plurality of premixed aqueous compositions" respectively, which replace "set of prepaints" in claim 90 without addition or loss of meaning as explained above.

Claims 93 and 96 are copies of claims 3 and 4 respectively of the Friel patent. While the adsorption and absorption of a particulate polymeric binder onto the opacifying pigment and onto the extender pigment as recited in these claims is not expressly stated in the Applicant's original disclosure, this feature of the invention is inherent in combining the resin compositions with the pigment and extender pigment compositions. That is, adsorption and absorption as recited will occur in the compositions and paint products of the present invention. Claims 94-95 and 97-98 have the alternative terms discussed with regard to the base claims above, but otherwise correspond to claims 93 and 96 respectively.

Claim 99 is a copy of claim 49 of the Friel patent. This claim recites that the extender prepaint has a pigment volume concentration (PVC) is in a range from about 35% to about 100%. Applicants' relative quantities of the various ingredients are disclosed as weight percentages. However, the weight percentages converted to PVC provide the extender prepaint PVC within the claimed range. In further support, Applicant's patent (Exhibit A) states in column 3, lines 41-44 that the amount of resin in the low resin composition can be varied to achieve different finish characteristics. Therefore, there is further support for the potential of the PVC's in the claimed range. Claims 100 and 101 correspond to claim 99 except for the substitute terminology that has been explained as equivalent in meaning to the terms in the copied claims as set forth in the remarks above.

Claim 102 is a copy of independent claim 38 of the Friel patent. This claim is a product by process claim that utilizes the same basic terminology as the copied base claim 87 discussed above. Claims 103 and 104 correspond to claim 102 except for the omission of the term "applicators" in the alternative, and the substitute terminology similar to that discussed above with respect to independent claims 87-89. The substitute terminology can be readily viewed in side-by-side relation in Exhibit G for ease of comparison. The substitute terminology is fully supported by the original disclosure and does not add or remove meaning therefrom. Applicants also hold that the containers into which the premixed compositions are dispensed, may include applicators. Furthermore, it is considered that the "applicators" of Friel may not include substantively more than the "containers" claimed in the alternative in Claim 38 of the Friel patent because the Friel patent does not further define the term "applicator".

Claim 105 is a copy of claim 45 of the Friel patent. Most of the terminology of claim 105 has been discussed above as being supported by the original disclosure of the Applicant's patent. Claims 106 and 107 have substitute terminology that is equivalent to that of claim 105 as has also been discussed above. The similarities can be readily seen by comparison of claims 105-107 in the parallel columns of Exhibit G. The additional term "clear coatings" appears in the preamble of claims 105-106. The term "clear coatings" is not expressly stated in the original disclosure of the Applicant's patent. However, the Applicant discloses of neutral color in column 1, lines 11-12 and high gloss in column 2, lines 18-24, which provide a basis for formulating "clear coatings". Thus, "clear coatings" is within the scope of the original disclosure. On the other hand, the body of each of claims 105 and 106 does not breathe life and meaning into the term "clear coatings" since the claims recites an "opacifying pigment", which does not correspond to clear coatings. In any case, claims 105-107 are considered to be fully supported by the original disclosure and to be substantially equivalent to each other for the reasons set forth above.

Claim 108 is a copy of claim 48 of the Friel patent. Claims 109 and 110 correspond to claim 108 in scope and meaning, but utilize the substitute terminology similar to that discussed above with regard to other claims. Claims 109 and 110 omit the term "applicators" similar to claims 103 and 104, but considered to still be similar in scope to claim 108 for the same reasons set forth in the remarks regarding claims 102-104. Thus, claims 108-110 are considered to vary

from each other only semantically and are supported by the original disclosure of the Applicant's patent.

Each of claims 87-110 is considered to be supported by the original disclosure of the Applicant's patent for purposes of 35 USC 112 1st paragraph. Furthermore, the variations in corresponding claims are considered to be a matter of semantics such that each of three claims in a set of corresponding claims, (the claim copied from the Friel patent and two others), is equivalent to the other claims in the set. This may be readily seen by a comparison in side by side relation with the varied terms highlighted as shown in Exhibit G.

Claims 1-4 and 44 of the Friel application are duplicates of claims 1-4 and 38 of the Friel patent. Therefore, the above explanation of differences and support apply equally to claims 1-4 and 44 of the Friel application.

Claims 261-268 correspond to claims 1-4, 49, 38, 45, 48 of the Friel patent and the corresponding claims of the Friel application. Hence, the same general remarks for each of the corresponding claims above applies to claims 261-268. However, claims 261-268 have been made to include only language that was expressly or inherently provided by the original disclosure of the Applicant's patent. The terminology of claims 261-268 is considered to vary from the terminology of the Friel patent and the Friel application only semantically. Since the terminology and language is supported completely by Applicant's original disclosure, none of the amendments to the specification are required to support claims 261-268. Yet as can be readily seen in the parallel columns of Table 4, claims 261-268 recite the same basic invention as the Friel patent and the Friel application.

#### ***Count 2, Claims 111-158 and 269-300***

Claim 111 is a copy of claim 5 of the Friel patent. Claims 112 and 113 correspond in scope and meaning to claim 111. Claims 112 and 113 omit the term "applicator(s)" that is recited in the alternative in claim 111. However, claims 112 and 113 are considered to be similar in scope to claim 111 for the reasons set forth in the remarks regarding claims 102-104 and 108-110 above. Claim 111 is an independent claim that incorporates many of the same terms that are in base claims 87, 102, and 105. These terms have been shown to be supported in the

Applicant's patent and to be equivalent to terms originally relied upon therein as set forth above. A comparison of claims 111, 112, and 113 in the parallel columns of Exhibit G will permit the Examiner to note that the progression of terminology refers to the same claim elements, and that differences between claims 111, 112, and 113 are merely a matter of semantics.

Claim 114 is a copy of claim 7 of the Friel patent. Claims 115 and 116 correspond to claim 114 in scope and meaning, and vary only in terminology similar to other claims discussed above.

Claim 117 is a copy of claim 8 of the Friel patent. Claims 118 and 119 correspond generally in scope and meaning, but wherein the term "applicator(s)" has been replaced by the term "containers". This variation is considered to be inconsequential for reasons set forth in the remarks regarding claims 102-104 above. Otherwise, claims 118 and 119 vary only in term of the substitute terminology, which is considered to neither add nor remove meaning as set forth above.

Claims 120-134 similarly have sets of three corresponding claims with the first in each set being a copy of claims 9, 10, 11, 13, and 14 of the Friel patent, respectively. The second and third of each set varies only by the substitute terminology, if at all. For example, the first, second, and third claims 129, 130, and 131 are copies of claim 13 of the Friel patent.

Claim 135 is a copy of claim 15 of the Friel patent. Claims 136 and 137 correspond in scope and meaning to claim 135, but vary in terminology. In this case, the substitute term "resin" of claim 137 is recited in column 3, lines 1 of the original disclosure of the Applicant's patent. On the other hand, the substitute term "polymeric agent" is used in claim 136 since resins are polymeric. Furthermore, the Applicant's original disclosure provides support for the copied claim 135 terminology of "polymeric binder" since polymeric materials, including resins, are binders.

Claim 138 is a copy of claim 16 of the Friel patent. Claims 139 and 140 correspond in scope and meaning to claim 138, and vary only in terminology as has been set forth above for the particular terms in these claims. Thus, the variations between claims 138, 139, and 140 are considered to be semantic only.

Claims 141, 142, and 143 are each a substantial copy of claim 17 of the Friel patent.

Claim 144 is similar to claim 18 of the Friel patent and differs therefrom because the original disclosure of the Applicant's patent does not expressly recite the specific upper limit of the range of prepaints recited in claim 18. However, the original disclosure provides support for a plurality of prepaints and specifically recites 2, 3, 4, or more prepaints as set forth in the remarks regarding claims 90-92 above. Therefore claim 144 recites 4 or more prepaints. Claims 145 and 146 correspond in scope and meaning to claim 144, and vary only in terminology similar to other claims set forth above.

Claim 147 is a copy of claim 50 of the Friel patent and is considered to be supported by the Applicant's original disclosure for the same reasons set forth in the remarks regarding claim 99 above. Claims 148 and 149 correspond in scope and meaning to claim 147, and vary only in terminology as discussed with regard to other claims above.

Claims 150, 151, and 152 are substantial copies of claim 18 of the Friel application.

Claims 153, 154, and 155 are substantial copies of claim 19 of the Friel application. The Applicant's original disclosure does not expressly recite that "the method is carried out at the point-of-use" as do claims 153, 154, and 155. However, the Friel application fails to particularly define the "point-of use". For example, on page 5, paragraph [0066] of the publication of the Friel application, Friel et al. fail to define what is meant by "buyer". Therefore, the "buyer" as disclosed includes the buyer of the prepaints, who then becomes the user of the prepaints and the manufacturer of the paints. Likewise, Friel et al. fail to define "contractor" as used in the same paragraph. Thus, "contractor" in the Friel application could mean an entity that has contracted to buy and mix paints from the prepaints. Furthermore, these terms are not correlated so as to provide definition by correlation. Hence, the term "point-of-use" could mean the location at which a manufacturer or any individual uses the prepaints to formulate a paint. Therefore, point-of-use should not be restricted to a meaning outside of the Applicant's own disclosure. That is, the Applicant discloses using "premixed compositions" or "prepaints" to make "paint products", and the place at which the "premixed compositions" are thus used can be termed a "point-of-use".

Claims 156, 157, and 158 are substantial copies of claim 20 of the Friel application. The term "controlled by a computer" of claims 156, 157, and 158 is supported by the original disclosure of column 4, lines 1-13 of the Applicant's patent. On line 1, the Applicant statement

that the “compositions [are] suitable for programmed dispensing” refers to computer controlled dispensing as is evidenced by the precise weight percentages required in the Table of lines 6-13.

Claims 5, 7-17, and 21-22 of the Friel application correspond to claims 5 and 7-18 of the Friel patent. Therefore, claims 5, 7-17, and 21-22 have the same relationship to the copied claims and the corresponding claims incorporating substitute terminology discussed above.

Claims 269-300 correspond to claims 5, 7-11, 13-18, 6, and 50 of the Friel patent and claims 5, 7-11, 13-21, 6, 7-11, and 13-21 of the Friel application. Hence, the same general remarks for each of the corresponding claims above applies to claims 269-300. However, claims 269-300 have been made to include only language that was expressly or inherently provided by the original disclosure of the Applicant’s patent. The terminology of claims 269-300 is considered to vary from the terminology of the Friel patent and the Friel application only semantically. Since the terminology and language is supported completely by Applicant’s original disclosure, none of the amendments to the specification are required to support claims 269-300. Yet as can be readily seen in the parallel columns of Table 4, claims 269-300 recite the same basic invention as the Friel patent and the Friel application.

### ***Count 3, Claims 207-257 and 301-326***

Claim 207 is a copy of claim 19 of the Friel patent. Claim 208 corresponds in scope and meaning to claim 207. Claims 207 and 208 vary only in semantics of their terminology. In particular, the substitution of “aqueous” for “fluid” and the substitution of “aqueous paint composition” for “latex paint” is considered to neither add nor remove meaning from claim 208. Please note the definition of “latex” as it relates to paints in section G above. With regard to the preamble, Applicants’ pigmented latex paint has been calculated to have a volume solids content of about 30% to about 70%. Although the relative quantities of the various ingredients are set forth in weight percentages in Applicant’s original disclosure, these values can be converted to volume solids content and shown to reside in the claimed range based on weights and percentages shown in the table in column 4 and the maximum and minimum values of pigment and binder resin. (See column 2, lines 25-37 and column 3, lines 29-41.) The recited range of Stormer viscosity recited is a broad range comparable to a range from the viscosity of water to that of hardened concrete. This range is considered to be met inherently since the materials in

the pigment composition present in their suggested percentages will fall within this range of viscosity. Therefore, claims 207 and 208 are supported by the original disclosure of the Applicant's patent.

Claim 209 is a copy of claim 20 of the Friel patent. The narrower range of volume solids content of about 35% to about 50% has been calculated and is also supported by the original disclosure of the Applicant's patent. The Stormer viscosity of about 60 to about 150 KU is also inherent since the typical viscosity for the paint of the present invention is around 90 to 100 KU, but may vary depending upon the mixture. Claim 210 corresponds in scope and meaning to claim 209, and merely varies in terminology. The substitute terminology of claim 210 is considered to neither add or remove meaning from claim 210 relative to the copied claim 209.

Claims 211, 213, 215, and 217 are only partial copies of corresponding claims 24, 27, 28, and 30 of the Friel patent. Claims 24, 27, 28, and 30 of the Friel patent recite lists that are not expressly recited in the original disclosure of the Applicant's patent. Thus, claims 211, 213, 215, and 217 recite a portion of each of the Friel claims that is recited. Claims 212, 214, 216, and 218 correspond to claims 211, 213, 215, and 217 in scope and meaning, and only vary therefrom in terminology. The variation in terminology is considered a matter of semantics. The dispersant and the coalescent additives are provided at least by the dispersant thickening premixed composition as set forth in column 3, lines 13-24. These and the remaining elements recited in claims 24, 27, 28, and 30 of the Friel patent are well known substitutes for the corresponding element recited in the Applicant's patent.

Claim 219 is a copy of claim 32 of the Friel patent. Claim 220 corresponds to claim 219 in scope and meaning, and only varies therefrom in terminology. The substitute terminology of claim 220 neither adds to or removes meaning relative to claim 219, and the differences between claims 219 and 220 are semantic. Applicant's original disclosure has relative volume solids content for the high resin composition in the range from about 25% to about 70% as has been calculated from the relative ingredient weight percentage contents of the original disclosure. Furthermore, the amounts of water and resin in the high and low resin compositions can be varied as set forth in column 3, lines 41-43, thus providing further variation of the volume solids content.

Claim 221 is a copy of claim 33 of the Friel patent. Claim 222 corresponds in scope and meaning to claim 221, and only varies from claim 221 in terminology. The range of volume solids content for the “binder prepaint” or “premixed binder composition” is met by the solids percentage in the high resin composition as described in the remarks regarding claims 219 and 220 above.

Claim 223 is a partial copy of claim 34 of the Friel patent. Claim 34 of the Friel patent includes a list of additives only part of which is expressly recited by the original disclosure of the Applicant’s patent. Specifically, the coalescent is provided in the dispersant thickener premixed composition. The remaining elements recited by claim 34 of the Friel patent are well known substitutes for the coalescent disclosed in the Applicant’s patent. Claim 224 corresponds to claim 223 in scope and meaning, and only varies therefrom in terminology.

Claim 225 is a copy of claim 35 of the Friel patent. The volume solids content of the “extender prepaint” of claim 225 has been calculated to be in a range from about 30% to about 70% based on the weight percentages disclosed in the Applicant’s original disclosure. Furthermore, Applicant’s patent states that the resin content of the low and high resin compositions can be varied as set forth above. Claim 226 corresponds to claim 225 in scope and meaning, and varies only in terminology. The substitute terminology is considered to be merely a matter of semantics.

Claims 227 and 229 are copies of claims 36 and 37 respectively, of the Friel patent. Claims 228 and 230 correspond in scope and meaning to claim 227 and 229 respectively. Claims 228 and 230 vary from claims 227 and 229 respectively only in terminology.

Claim 231 is a copy of claim 21 of the Friel patent. Claim 232 corresponds to claim 231 in scope and meaning, and varies therefrom only in terminology. The substitute terminology of claim 232 does not add to or remove meaning relative to claim 231.

Claim 233 is a copy of claim 22 of the Friel patent. The Applicant’s volume solids content of the “opacifying prepaint” has been calculated to be in the recited range from about 35% to about 50% as recited in claim 233, and the remaining recitation of claim 233 is inherent in the prepaint. Claim 234 corresponds to claim 233 in scope and meaning, and varies therefrom only in terminology.

Claim 235 is a copy of claim 23 of the Friel patent. Adsorption of the polymer or resin onto the opacifying pigment is inherent in combining the ingredients of the “prepaints” or “premixed compositions”. Claim 236 corresponds to claim 235 in scope and meaning, and varies therefrom only in terminology.

Claims 237-242 and 245-258 are the same as claims 211-216 and 217-230 respectively, except for dependency on different independent claims. Therefore, the explanation of differences and inherencies in claims 237-242 and 245-258 is the same as that set forth for claims 211-230 above.

Claim 243 is a partial copy of claim 29 in the Friel patent. Claim 244 corresponds to claim 243 in scope and meaning and varies therefrom only in terminology, which terminology is equivalent between claims 243 and 244.

Claims 22-31 of the Friel application are the same as claims 19-28 of the Friel patent and claims 22-31 of the Friel application have the same relationship with the copied claims and the claims corresponding thereto discussed above. Similarly claims 32 and 33 of the Friel application recite the same matter as claim 29 of the Friel patent and claims 35 and 36 recite the same subject matter as claim 30 of the Friel patent. Hence the remarks regarding copied and corresponding claim utilizing different terminology apply equally to the corresponding Friel application claims. Claims 37-38 of the Friel application are substantially the same as claims 32 and 33 of the Friel patent, with only minor variations of an added or omitted phrase. Therefore, the arguments regarding claims 32-33 above apply equally to the Friel application claims 32 and 33. Claim 39 of the Friel application is a duplicate of claim 34 of the Friel patent. Therefore, the remarks regarding claim 34 above apply equally to claim 39 of the Friel application. Claims 40 and 41 of the Friel application recite the same material as the claim 35 of the Friel patent. Copied claims 219 and 247 are copies more closely aligned with the format of claims 40 and 41 of the Friel application. Claims 42 and 43 of the Friel application are close to being the same as claims 36 and 37 of the Friel patent. In an attempt to present more proper and consistent claims in the present amendment a comparison of several of the claims has been made to incorporate claim elements in claims 225-230 and 253-258 terms that appeared to be copies of what was intended in claims 35-37 of the Friel patent. In any case, the arguments regarding claims 225-230 and 253-258 apply equally to claims 40-43 of the Friel application.

Claims 301-326 correspond to claims 19-20, 24, 27, 28, 30, 32-37, 21-24, 27-30, and 32-37 of the Friel patent and corresponding claims of the Friel application. Hence, the same general remarks for each of the corresponding claims above applies to claims 301-326. However, claims 301-326 have been made to include only language that was expressly or inherently provided by the original disclosure of the Applicant's patent. The terminology of claims 301-326 is considered to vary from the terminology of the Friel patent and the Friel application only semantically. Since the terminology and language is supported completely by Applicant's original disclosure, none of the amendments to the specification are required to support claims 301-326. Yet as can be readily seen in the parallel columns of Table 4, claims 301-326 recite the same basic invention as the Friel patent and the Friel application.

***Count 4, Claims 259-260 and 327***

Claim 259 is a copy of claim 31 of the Friel patent. The volume solids content of the extender prepaint has been calculated to be within the recited range from about 30% to about 70 percent as set forth in the remarks regarding claim 225 above. Claim 260 corresponds in scope and meaning to claim 259, and varies only in terminology. Thus, the difference in claims 259 and 260 is merely a matter of semantics.

Claims 35 and 36 of the Friel application claim the same matter as does claim 31 of the Friel patent. Therefore, claim 260 presented herewith corresponds in scope and meaning to claims 35 and 36 of the Friel application and the differences are considered to be merely semantic.

Claim 327 corresponds to claim 31 of the Friel patent and claims 35-36 of the Friel application. Hence, the same general remarks for each of the corresponding claims above applies to claim 327. However, claim 327 has been made to include only language that was expressly or inherently provided by the original disclosure of the Applicant's patent. The terminology of claim 327 is considered to vary from the terminology of the Friel patent and the Friel application only semantically. Since the terminology and language is supported completely by Applicant's original disclosure, none of the amendments to the specification are required to support claim 327. Yet as can be readily seen in the parallel columns of Table 4, claim 327 recites the same basic invention as the Friel patent and the Friel application.

**J. Amendment to the Specification**

Some amendments to the Specification have been made to provide express recitation of claim terminology in the presented claims. The amendments have been made in the alternative to indicate that the added terms are merely alternative terms for the same subject matter. Hence, no new matter has been added. Furthermore, as set forth above, the support for the newly presented claims already existed, although in other terminology. Thus, the present amendment to the Specification simply includes alternative terminology to provide support for present claim terminology.

**K. Information Disclosure Statement**

An information Disclosure Statement is submitted herewith. All of the references cited in Friel patent are listed thereon and copies of the references not previously cited are provided.

**L. Other Applications**

Applicants also wish to bring to the Examiner's attention certain applications that are related or apparently related to the Friel patent and the Friel application. One of these applications is Serial No. 09/785,389, filed February 16, 2001, and issued as patent No. 6,613,832 on September 2, 2003. This application is directed to preparing adhesives and caulks from premixes. Another application is application Serial No. 09/785,637, also filed February 16, 2001, and published as Publication No. 2001/0050030 December 13, 2001. This application is directed to preparing road paint from prepaints. Each of these applications has an effective filing date later than the present application. While the present application does not specifically disclose preparing "road paint", "adhesive", and "caulk", these are obvious extensions of the present disclosure and invention. Therefore, a review of these applications in light of the Applicants' disclosure will make it clear that the Applicants' disclosure is extremely material to

the patentability of the pending related application(s) and any application that is related to the issued patent.

#### **Regarding Doctrine of Equivalents**

Applicants hereby declare that any amendments herein that are not specifically made for the purpose of patentability are made for other purposes, such as clarification, and that no such changes shall be construed as limiting the scope of the claims or the application of the Doctrine of Equivalents.

#### **CONCLUSION**

If any fees, including extension of time fees or additional claims fees, are due as a result of this response, please charge Deposit Account No. 19-0513. This authorization is intended to act as a constructive petition for an extension of time, should an extension of time be needed as a result of this response.

Claims 87-251 are believed to be in condition for allowance and early notice thereof is respectfully solicited. Should the Examiner determine that additional issues remain which can be resolved by a telephone conference or which would in any way advance prosecution of the case, the examiner is invited to telephone Applicants' undersigned attorney.

Respectfully submitted,

Date: October 7, 2003

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